DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 1, 5, 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: Proposed rule.

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

DATES: Submit comments on or before January 26, 2004.

ADDRESSES: Submit comments:

1. By electronic mail to *BPAI.Rules@uspto.gov.*

2. By mail to Mail Stop Interference, Director of the United States Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313–1450.

3. By facsimile to 703–308–7953.

See the **SUPPLEMENTARY INFORMATION** for further information about submitting comments.

FOR FURTHER INFORMATION CONTACT:

Appeals: Jeffrey V. Nase or William F. Smith, 703–308–9797.

Otherwise: Richard Torczon, 703–308–9797.

SUPPLEMENTARY INFORMATION:

Relationship to Announced Rule Makings

This notice combines two rule makings previously announced in the Unified Agenda as 0651–AB27 (Appeals) and 0651–AB32 (Interferences).

Filing Comments on This Proposed Rule

To the extent reasonably possible, the Office will make the comments available at *http://www.uspto.gov/web/offices/dcom/bpai/.* To facilitate this goal, the Office strongly encourages the submission of comments electronically, in either ASCII format or ADOBE® portable document format (pdf). Regardless of which submission mode you select, write only ''Consolidated Board Rules'' in the subject line to ensure prompt consideration of your comments.

Since the comments will be made available to the public, the comments should not include information that the submitter does not wish to have published. Comments that include confidentiality notices will not be entered into the record.

The Board of Patent Appeals and Interferences (Board) has significantly overhauled its operations to address concerns about the duration of proceedings before the Board. Improvements include an increase in the number of administrative patent judges, outreach programs to educate parties and examiners about Board operations, and restructuring of Board procedures. This rule making proposes to revise the rules governing Board proceedings to better reflect these new procedures. Consistent with these improvements, the rules are also consolidated and simplified to ease use. Finally, the rules address case law and legislative changes that have occurred since the last significant revision of the Board's rules.

Explanation of Proposed Changes

In keeping with long-standing patent practice, existing rules are denominated ''Rule x'' in this supplementary information. The proposed rules are denominated ''proposed § 41.x'' to help readers distinguish between existing and proposed rules.

Rules 1(a)(1)(iii), 5(e), 6(d)(9), 8(a)(2)(i)(B) and (a)(2)(i)(C), and 11(e), and subpart E of part 1, would be removed to consolidate interference information in proposed part 41, subparts D and E.

Rules 4(a)(2); 9(g); 36; 59(a)(1); 103(g); 112; 113(a); 114(d); 131(a)(1); 136(a)(1) and (a)(2); 181(a)(3); 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); and 993 would be revised to change cross-references to Board proceedings.

Rule 14(e) would be revised to eliminate references to Board actions. An analogous rule for Board actions is proposed in § 41.6(a). The Office previously proposed a similar change to Rule 14(e). See ''Changes to Implement Electronic Maintenance of Official Patent Application Records'', 68 FR 14365 (25 March 2003), in which the paragraph in question was numbered Rule 14(f). The Office received two comments that were specific to then-proposed Rule 14(f). See *http://www.uspto.gov/web/offices/pac/dapp/opla/comments/efw/aipla.pdf* and *http://www.uspto.gov/web/offices/pac/dapp/opla/comments/efw/neifeld.pdf.* To avoid confusion with this proposed rule making, no change was adopted to the language of the rule beyond renumbering it as Rule 14(e). 68 FR 38611, 38612, 38620 (30 June 2003). In the present proposal, the language of the rule has been simplified to avoid some of the criticisms in one comment, but the suggestion in the comments to relax the standards for publishing decisions is not being proposed. Proposed Rule 14(e)(1) would continue to state that publicly available materials are publicly available. Such materials may be published without notification to or permission from the applicant or patent owner.

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

Rule 48(a)–(c) and (i) would be 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) would be revised to eliminate the cross-references to Board rules.

Rule 116 would be 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 proposed § 41.31 or § 41.61. Amendments after appeal currently treated under Rule 116 would be moved to proposed §§ 41.33 and 41.63. Rule 116(d) would be 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 proposed § 41.77(b)(1). Rule 116(e) would be 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 (proposed § 41.31 or proposed § 41.61). The proposed 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) would be 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 proposed § 41.77(b)(1).

Rule 191 would be amended to direct appellants under 35 U.S.C. 134(a) or (b) to proposed part 41, subpart B. Rules 192–196 would be removed and reserved.

Rule 197 would be 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 current paragraph (b) would be moved to proposed § 41.52 and the subject matter of current paragraph (c) would be moved to proposed paragraph (b) of this section. In addition, paragraph (a) would be amended to return of jurisdiction of the involved application or patent under ex parte reexamination proceeding to the examiner.

Rule 198 would be 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.

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

Rule 959 would be revised to direct inter partes reexamination participants to proposed part 41, subpart C, for information about appeals in such proceedings.

Rules 961–977 would be removed to consolidate inter partes reexamination appeal information in proposed part 41, subpart C.

Rule 979 would be 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) would be moved to proposed §§ 41.79, 41.81 and 41.83. Paragraph (a) would be 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) would be amended to state that upon termination of the appeal before the Board of Patent Appeals and Interferences (proposed § 41.83), 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. 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 received by the Office.

Rule 981 would be 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.

Section 3 of part 5 provides that no interference will be declared with an application under a national secrecy order. In part, this is because the application cannot issue while the secrecy order is in place so the completion requirement of proposed § 41.102 is not met. Cf. Case v. CPC Int'l, Inc., 730 F.2d 745, 750, 221 USPQ 196, 200 (Fed. Cir. 1984) (the Director declares an interference to determine whether the application may issue). The proposed revision to Rule 5.3 would remove the reference to a patent because an interference may be provoked with an application as well (proposed § 41.202(a)(1)). The proposed revision would also remove the requirement to place a notice in the file of the targeted patent. Since the Office will not act on the suggestion for an interference, the notice only serves to cast unexamined doubt on the claims of the patentee without providing any route of relief. An applicant intent on having an interference should take steps to have the secrecy order lifted.

Section 23(c)(7) of part 10 would be amended to change the cross-reference to the interference rules.

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

Proposed part 41 would better state the existing practice and should not be read to change the existing practice except as explicitly provided.

Proposed subpart A would state policies, practices, and definitions common to all proceedings before the Board.

Proposed § 41.1 would set forth general principles for proposed part 41. Proposed § 41.1(a) would define the scope of rules. Proposed § 41.1(b) would mandate 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. Proposed § 41.1(c) would explicitly extend the requirement for decorum under Rule 3 to Board proceedings, including dealings with opposing parties. Board officials are similarly expected to treat parties with courtesy and decorum.

Proposed § 41.2 would set forth definitions for Board proceedings under proposed part 41. The preamble to proposed § 41.2 is based on the preamble of Rule 601, which cautions that context may give a defined word a different meaning. For instance, although ''final'' would be defined for the purposes of identifying final agency actions of the Board, it would not change the meaning of ''final rejection'' in proposed § 41.37(c)(1)(iv), which refers to an action by an examiner.

The proposed definition of ''Board'' would cover three distinct situations. First, for the purposes of a final agency action committed to a panel of Board members, the definition would be identical in scope to 35 U.S.C. 6(b). Second, the definition would include action by the Chief Administrative Patent Judge in matters delegated in these proposed rules to the Chief Administrative Patent Judge. Third, the definition would recognize that non-final actions are often performed by officials other than a panel or the Chief Administrative Patent Judge. See Rule 610(a); cf. 37 CFR 2.127(c). This definition should not be read to authorize a final decision on patentability, priority, or United States Government ownership by anything other than a Board panel. Other than instances in which a panel is required by statute, the selection and authorization of an official to act on behalf of the Board would be entirely a matter of internal administration.

The definition of ''Board member'' would follow 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'' would include patent interferences (35 U.S.C. 135(a)) and proceedings with interference-based procedures (42 U.S.C. 2182 and 2457(d)). The existence of a contested case is a predicate for authorizing a subpoena under 35 U.S.C. 24. Although both appeals in inter partes reexaminations under 35 U.S.C. 134(c) and some petitions to the Chief Administrative Patent Judge, such as a petition for access under 35 U.S.C. 135(c), may involve more than one party, they are not considered contested cases for the purposes of proposed part 41.

Finality is required for judicial review. *Barton* v. *Adang,* 162 F.3d 1140, 1143, 49 USPQ2d 1128, 1131 (Fed. Cir. 1998). The term ''final'' would be defined pursuant to 5 U.S.C. 704 to assist parties in determining when a Board action is ripe for judicial review. In Barton, 162 F.3d at 1143, 49 USPQ2d at 1131, the Court of Appeals for the Federal Circuit held that an adverse judgment against a single party in a multi-party patent interference was a final agency action with respect to that party for the purposes of review under 35 U.S.C. 141. The proposed definition of ''final'' would follow Barton in linking the question of finality to whether an agency action on the merits is operative against the party seeking judicial review. Under 35 U.S.C. 6(b), a decision on the merits in an appeal or a contested case by any entity other than three Board members cannot be a final agency action. Affirming or reversing disposes of an issue on appeal on the merits; vacating or remanding does not. Entry of a new ground of rejection, by definition, does not dispose of an issue on the merits. A petition decision might not be final if, for instance, the decision is rendered without prejudice to take some further action. An issue in a non-final decision may usually be preserved for review in a final decision. See, *e.g.,* proposed § 41.125(c)(5) under which a party may request reconsideration by a panel.

The definition of ''hearing'' would reflect 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'' would reflect 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'' would set forth a generic term for entities acting in a Board proceeding.

The delegation of petition authority to the Chief Administrative Patent Judge in proposed § 41.3(a) would be new as a rule, but follows a delegation already published in the Manual of Patent Examining Procedure (MPEP) at § 1002.02(f). This delegation by rule would not prejudice the Director's prerogative to decide a petition or to delegate authority to decide a petition to another subordinate. The Chief Administrative Patent Judge could also delegate petition-deciding authority to an official, provided the delegation is stated in writing. Note that under proposed § 41.3(b)(1) decisions committed by statute to the Board would not be subject to petitions for supervisory review. Such decisions would include merits decisions in appeals and contested cases, and decisions on requests for rehearing. 35 U.S.C. 6(b). Review of such decisions would come through a request for rehearing or through judicial review. Proposed § 41.3(b)(2), which would provide for petitions in contested cases to be decided by other officials, would reflect 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). These actions would be considered routine motions or requests.

Proposed § 41.3(c) would reflect current practice in requiring payment of a standard petition fee. Matters that would be excluded from the scope of petitions in § 41.3(a)(2) would not be petitions and so would not require payment of a fee. Petitions seeking supervisory review of a discretionary matter would also not require payment of a petition fee. Compare Rule 181(a)(3) with Rules 182 and 183.

Proposed § 41.3(d) would reflect the current practice of not staying any action for a petition for supervisory review in Rule 181(f). Note that the Court of Appeals for the Federal Circuit has held that a request for rehearing may toll the time for seeking judicial review. In re Graves, 69 F.3d 1147, 1151, 36 USPQ2d 1697, 1700 (Fed. Cir. 1995).

Proposed § 41.3(e) would set times for filing petitions. As with Rule 181(f), failure to file a timely petition would be sufficient basis for dismissing or denying a motion.

Proposed § 41.4(a) and (b) would follow the requirements of Rules 136(b) and 645 in providing rules for extensions of time and for acceptance of untimely papers. Congress has authorized patent term adjustments for time spent in proceedings before the Board. 35 U.S.C. 154(b)(1)(C). Consequently, the Board must be mindful to avoid delays in its administration of its proceedings, including delays requested or caused by a party. The Board might set conditions on extensions to minimize the effects of any delay, including restriction under 35 U.S.C. 121 of claims directed to subject matter not involved in the Board proceeding. Proposed § 41.4(c) would point parties to timeliness rules that are related to Board proceedings, but not within the scope of the Board rules.

Proposed § 41.5 would set forth 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. It would generally be more efficient to have a Board official familiar with the specific proceeding decide questions of representation limited to the specific proceeding. Disqualification would be a case-specific suspension or exclusion from practice within the meaning of 35 U.S.C. 32. Under the terms of section 32, the official conducting the disqualification hearing would have to be an attorney.

Proposed § 41.5(b) would delegate to the Board the authority to conduct counsel disqualification proceedings while the Board has jurisdiction over a proceeding. It also would clarify counsel disqualification practice under Rule 613(c) by making explicit the fact that a final decision to disqualify is an exercise of the powers of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office under § 32, not the Board. The rule would delegate to the Chief Administrative Patent Judge the authority to make final a decision to disqualify counsel in a proceeding before the Board for the purposes of judicial review. This delegation would not derogate from the Director the prerogative to make such decisions, nor would it prevent the Chief Administrative Patent Judge from further delegating authority to an administrative patent judge, provided the delegation was stated in writing.

Proposed § 41.6(a) would relocate into part 41 the portions of Rule 14(e) that apply to the Board. Proposed § 41.6(a)(1) would continue to state that publicly available materials are publicly available. Such materials may be published without notification to or permission from the applicant. Proposed § 41.6(a)(2) would set forth the basis for making a determination under 35 U.S.C. 122(a) that the publication of a Board action constitutes a special

circumstance. Parties should note that disagreement with a holding is not an appropriate basis for challenging a special circumstance determination. Moreover, a party not entitled to confidentiality under section 122(a) would not have the standing to challenge publication under this paragraph. For instance, an involved patentee could not assert an opposing applicant's confidences as the basis for blocking a publication.

Proposed § 41.6(b) would generalize 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. It also recognizes pre-grant publication as a basis for making a file publicly available.

Proposed § 41.7 would adopt the current practice of Rule 618 regarding duplicate papers and the expunging of papers, but would generalize it to all Board proceedings. In recent decades, the typical size of files has increased significantly. The increase imposes burdens on the Office in managing the records and on users of the record. This rule would provide a tool for managing the size and complexity of the record and for preventing abuses that can occur in filing.

Proposed § 41.8(a) would reflect the current practice under Rules 192(c)(1) and 602 regarding disclosure of the real parties-in-interest. Federal officials must meet high ethical standards. A principal ethical concern is the avoidance of conflicts of interest for the officials, including even the appearance of a conflict. See *e.g., Stanek* v. *Dep't of Transp.,* 805 F.2d 1572, 1577 (Fed. Cir. 1986) (affirming dismissal of employee for appearance of a conflict of interest). In the case of the Board, a conflict would typically arise when an official has an investment in a company with a direct interest in a Board proceeding. Such conflicts could only be avoided if the parties promptly provide the information necessary to identify potential conflicts. The identity of a real party-in-interest might also affect the credibility of evidence presented in a proceeding. For instance, testimony from a source related to a real party-in-interest may be seen as misleading or self-serving compared to evidence from a completely independent source (*e.g., Refac Int'l, Ltd.* v. *Lotus Dev. Corp.,* 81 F.3d 1576, 1581–82, 38 USPQ2d 1665, 1669 (Fed. Cir. 1996) (failure to identify declarants as former co-workers was inequitable conduct)). Finally, in a contested case, the presence of a common real party-in-interest might reflect a lack of genuine adversity between the parties. Common ownership would ordinarily result in prompt termination of any proceeding between the commonly owned parties. Barton, 162 F.3d at 1143, 49 USPQ2d at 1131 (recognizing the practice while noting an exception). See proposed § 41.206.

The notice of judicial proceedings required in proposed § 41.8(b) would be important because a judicial decision in another case might be binding on the Board or a party. The Board might also use such information to determine the best pacing for a Board proceeding. Notice of other administrative proceedings might also be relevant. In the case of other Office proceedings, particularly other Board proceedings, notice might allow the Board to more efficiently allocate its limited resources and to avoid inconsistent outcomes. In re Berg, 140 F.3d 1428, 1435 nn.7&8, 46 USPQ2d 1226, 1231 nn.7&8 (Fed. Cir. 1998) (calling failure to identify a related application relevant to a double-patenting analysis ''misleading''). The ''affect or be affected by'' standard in proposed § 41.8(b) is derived from Federal Circuit Rule 47.5(b). The proposed rule would also follow Rule 660(d) in requiring notice to the Board of judicial review of the proceeding itself. In the absence of such timely notice, the Board would usually distribute records associated in the proceeding to other parts of the Office for further action. Failure to provide a timely mandatory notice under proposed § 41.8 might result in sanctions including disqualification of counsel and adverse judgment.

Proposed § 41.9 would follow Rule 643 regarding action by an assignee to the exclusion of an inventor, but would generalize it to all Board proceedings. Orders permitting an assignee of a partial interest to act to the exclusion of an inventor or co-assignee would rarely be granted outside of contested cases. Even in contested cases, such orders would typically issue only when the partial assignee was in a proceeding against its co-assignee. Ex parte Hinkson, 1904 Comm'r. Dec. 342.

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

Proposed subpart B would 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.

The preamble to proposed § 41.30 would be based on a similar provision in the preamble of Rule 601. The term ''proceeding'' would set 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'' would set 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'' would set forth a shorthand reference to the owner of the patent undergoing ex parte reexamination under Rule 510.

Proposed § 41.31 would generally incorporate the requirements of current Rule 191(a)–(d). Paragraph (a) would be subdivided into three parts to improve readability. Paragraph (d) would be 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, now provided in Rule 191(e), would be relocated to proposed §§ 41.37, 41.41, 41.47, 41.50 and 41.52.

Proposed § 41.33(a) and (b) would replace the requirements of current Rule 116 with a prohibition of amendments submitted after the date the proceeding has been appealed pursuant to proposed § 41.31(a)(1)–(a)(3), except amendments canceling claims or rewriting dependent claims into independent form and as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1). 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. Proposed § 41.33(c) would replace the requirements of Rule 195 with a prohibition on the admission of affidavits and other evidence submitted after the case has been appealed pursuant to proposed § 41.31(a)(1)–(a)(3), except as permitted by proposed §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1). This would replace 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 proposed § 41.31(a)(1)–(a)(3).

Proposed § 41.35 would generally incorporate the requirements of current

Rule 191(e). In addition, the section is proposed to be amended to make 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, it is proposed to permit the Board to take other appropriate action to complete the proceeding. For example, if the proceeding was not complete because one copy of the brief was missing, the Board may contact the appellant to obtain the missing copy.

Proposed § 41.37 would generally incorporate the requirements of Rule 192. In addition, it is proposed to:

(1) Change the title of the section from ''Appellant's brief'' to ''Appeal brief''.

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

(3) In paragraph (a), require the brief to be filed within two months from the date of the notice of appeal under proposed § 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), require a statement 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 amendment would provide appellant the necessary mechanism for complying with proposed § 41.8(a) in an appeal to the Board.

(5) In paragraph (c)(1)(ii), require identification 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 proposed § 41.8(b) in an appeal to the Board.

(6) In paragraph (c)(1)(iii), require 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.

(7) In paragraph (c)(1)(v), require a concise explanation of the invention defined in 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 claim involved in the appeal, it is proposed that every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, be identified and that 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 current 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 is not being followed in a great number of briefs before the Board. It is expected that the proposed requirements will be enforced by the examiner. Accordingly, any brief filed by an appellant who is represented by a registered practitioner that fails to set forth a summary which references the specification by page and line number, and to the drawing, if any, by reference characters or which fails to identify every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, would be in non-compliance with this section and would be handled as set forth in proposed paragraph (d) of this section.

(8) In paragraph (c)(1)(vi), require a concise statement listing each ground of rejection presented for review 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) Delete the current grouping of claims requirement set forth in Rule 192(c)(7). The general purpose served by Rule 192(c)(7) is addressed in proposed § 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 § 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), require that any arguments or authorities not included in the brief or a reply brief filed pursuant to proposed § 41.41 will be refused consideration by the Board, unless good cause is shown (requirement currently found in Rule 192(a)), and to require a separate heading 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. It is proposed that, 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, it is proposed to make explicit by rule that 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 Rule 192(c)(7) to require separate treatment of separately rejected claims). It is further proposed that 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. 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) In paragraph (c)(1)(vii), state that ''Merely pointing out differences in

what the claims cover is not an argument as to why the claims are separately patentable'', a statement that in slightly different form appears in Rule 192(c)(7).

(12) In paragraph (c)(1)(vii), eliminate subparagraphs (i) through (v) of Rule 192(c)(8) which relate to the manner in which arguments are to be made. Although they provide 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) Add paragraph (c)(1)(ix) 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) Add paragraph (c)(1)(x) 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) Add paragraph (c)(2) to exclude any new or non-admitted amendment, affidavit or other evidence from being included in the brief.

(16) Add paragraph (e) 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 currently appears in Rule 191(d), but would be more useful if provided in this section.

Proposed § 41.39 would generally incorporate requirements found in Rule 193(a).

Proposed § 41.39(a)(2) would permit a new ground of rejection to be included in an examiner's answer eliminating the current 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 proposed 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. Proposed paragraph (b) of this rule would specify the options available to an appellant who has received a new ground of rejection, including the option to request and have prosecution reopened before the examiner.

The proposed change to permit new grounds of rejection in examiner's answers would not be open-ended but is envisioned to 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 approved by a management official such as a Technology Center Director 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 would provide the appellant two options when a new ground of rejection in an examiner's answer is made, including the option of having prosecution reopened.

The following examples are set forth to provide guidance as to when the Office may or may not consider a factual scenario suitable for introducing new grounds of rejection in the examiner's answer. These examples are not considered an exhaustive list of situations that meet or do not meet the criteria for making a new ground of rejection in an examiner's answer:

Example 1: A new ground of rejection based upon prior art may be allowed if the 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 from claim 22 which depended from claim 13 which depended from independent claim 1. No rejection of claim 22 was set forth in the final rejection; however, the summary sheet of the final rejection indicated that claims 1, 13 and 27 were rejected. In this situation, the examiner would reject claim 22 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Y as a new ground of rejection in the answer.

Example 2: A new ground of rejection would not be allowed to reject a previously allowed or objected to claim even if the new ground of rejection would rely upon prior art already of record. In this instance, rather than making a new ground of rejection in an examiner's answer, if the basis for the new ground of rejection was approved by a supervisory patent examiner as currently set forth in MPEP 1208.02, the examiner would reopen prosecution.

Example 3: The proposed amendment is intended to continue to permit the examiner to include new grounds of rejection where appellant was advised that an amendment under Rule 116 would be entered for appeal purposes. The proposed rule would eliminate Rule 193(a)(2), which states that the filing of an amendment under Rule 116 represents applicant's consent when so advised that any appeal on that claim will proceed subject to any rejections set forth in an action from which appeal was taken. Proposed § 41.39(a)(2) broadens the situations in which an examiner can make a new ground of rejection to include circumstances currently covered by Rule 193(a)(2).

Paragraph (b) of § 41.39 would set forth the responses an appellant may make when an examiner's answer sets forth a new ground of rejection. Appellant would be 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 dismissed (*i.e.,* terminated) sua sponte.

Paragraph (c) of § 41.39 is proposed to be added to provide notice that the period set forth in proposed 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 currently appears in Rule 191(d), but it would be more useful if provided in this section.

Proposed § 41.41 would generally incorporate requirements found in Rule 193(b). In addition:

(1) Paragraph (a) would make explicit that a reply brief could not include any new or non-admitted amendment, affidavit or other evidence.

(2) Paragraph (b) would be 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) would be 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 currently appears in Rule 191(d), but would be more useful if provided in this section.

Proposed § 41.43 is proposed to be 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. It is proposed that a supplemental examiner's answer may not include a new ground of rejection. If a supplemental examiner's answer is furnished by the examiner, it is proposed to permit the appellant to file another reply brief under proposed § 41.41 within two months from the date of the supplemental examiner's answer.

The current prohibition against a supplemental examiner's answer in other than a remand situation would be 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 Rule 193(b)(2) would be removed.

Section 41.43(a)(1) as proposed would permit 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 proposed rule may petition for review of the decision under Rule 181. Possible 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 proposed § 41.43 would also set 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 will require approval from the supervisory patent examiner as currently set forth in MPEP 1208.02.

Paragraph (b) of proposed § 41.43 would permit 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 proposed § 41.43(c).

Proposed § 41.47 would generally incorporate the requirements of Rule 194. In addition:

(1) Paragraph (b) is proposed to be amended to require 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 or supplemental examiner's answer.

(2) Paragraph (d) is proposed to be 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, it is proposed that the requirement for notice to the primary examiner be 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) is proposed to be 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; (ii) the primary examiner may only rely on argument and evidence raised in the answer or a supplemental answer; 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) The substance of proposed paragraph (f) is found in 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.

(5) Paragraph (g) is proposed to be 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 currently appears in Rule 191(d), but would be more useful if provided in this section.

Proposed § 41.50 would generally incorporate the requirements of Rule 196. In addition:

(1) Paragraph (a)(1) would explicitly provide 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 Board

may also remand an application to the examiner.

(2) Paragraph (a)(2) would be 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 all claims under appeal. It is proposed that appellant must exercise one of the following two options to avoid such *sua sponte* dismissal of the appeal as to all claims under appeal: (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, and (ii) request that the appeal be maintained by filing a reply brief as provided in proposed § 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 proposed § 41.50(a)(2)(i). Any request that prosecution be reopened under this paragraph would be treated as a request to withdraw the appeal.

A first example of a remand from the Board to the examiner for further consideration of a rejection is a remand for the examiner to provide additional explanation as to how a reference anticipates a claim (*i.e.,* asking the examiner to set forth a *prima facie* case of anticipation). A second example of a remand from the Board to the examiner for further consideration of a rejection is a remand for the examiner to ascertain (*i.e.,* set forth) the differences between the claimed subject matter of the primary reference in an obviousness rejection and then to state why the claimed subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art (*i.e.,* asking the examiner to set forth a *prima facie* case of obviousness).

A first example of a remand from the Board to the examiner that is not for further consideration of a rejection is a remand for the examiner to consider an Information Disclosure Statement. A second example of a remand from the Board to the examiner that is not for further consideration of a rejection is a remand for the examiner to consider a reply brief.

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

(4) Paragraph (c) would provide 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) would provide 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) would be 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 currently appears in Rule 191(d), but it would appear to be more useful if provided in this section.

Proposed § 41.52 would generally incorporate the requirements of Rule 197(b). In addition, paragraph (a) is proposed to be amended to incorporate the matter being deleted from Rule 196(b)(2) relating to the request that the application or patent under ex parte reexamination be reheard. In addition, the rule as proposed 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 (b) is proposed to be 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 currently appears in Rule 191(d), but would be more useful if provided in this section.

Proposed § 41.54 would generally incorporate the requirements of Rule 197(a).

Proposed § 41.56 provides that an appeal under this proposed subpart is terminated by the dismissal of the appeal or when, after a final Board action a notice of appeal under 35 U.S.C. 141 is filed, a civil action under 35 U.S.C. 146 is commenced, or the time for seeking judicial review (Rule 304) has expired. Termination of an appeal under this proposed subpart is the cessation of the appeal proceeding before the Board and is distinct and separate from the termination of proceedings on an application (proposed Rule 197(b)) or the termination of proceedings on an ex parte reexamination proceeding which is concluded by the issuance of a certificate pursuant to Rule 570. A dismissal of an appeal results in a termination of the appeal proceeding before the Board. After dismissal of an appeal, an application is returned to the examiner to determine the proper course of action (*e.g.*, possible allowance and issuance if there are allowed claims; possible abandonment if there are no allowed claims) as set forth in sections 1214 to 1215.04 of the MPEP. After dismissal of an appeal, an ex parte reexamination proceeding is returned to the examiner to issue the appropriate certificate pursuant to Rule 570.

Proposed subpart C provides 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 proposed 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.

The preamble to proposed § 41.60 is based on a similar provision in the preamble of 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 proposed § 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 proposed § 41.68 to the appellant's brief of the owner, or the owner responding under proposed § 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'' are currently defined in Rule 962. The proposed 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.

Proposed § 41.61 would generally incorporate the requirements of current Rule 959 and the changes thereto proposed in ''Changes To Implement the

2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute'', 68 FR 22343 (28 April 2003) (RIN 0651–AB57).

Proposed § 41.63(a) and (b) would replace the requirements of current Rule 116 with a prohibition of amendments submitted after the date the proceeding has been appealed pursuant to proposed § 41.61, except for amendments permitted by proposed § 41.77(b)(1) and amendments canceling claims where such cancellation does not affect the scope of any other pending claim in the proceeding. Proposed § 41.63(c) would replace the requirements of Rule 975 with a prohibition on the admission of affidavits and other evidence submitted after the case has been appealed pursuant to proposed § 41.61 except as permitted by proposed § 41.77(b)(1). This would replace 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 proposed § 41.61.

Proposed § 41.64 would generally incorporate the requirements of 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.

Proposed § 41.66 would generally incorporate the requirements of Rule 963.

Proposed § 41.67 would generally incorporate the requirements of Rule 965 and the changes thereto proposed in ''Changes To Implement the 2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute'', 68 FR 22343 (28 April 2003) (RIN 0651–AB57). In addition, it is proposed:

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

(2) In paragraph (c)(1)(i), to require a statement 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 of complying with proposed § 41.8(a) in an appeal to the Board;

(3) In paragraph (c)(1)(ii), to require clear identification 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 proposed § 41.8(b) in an appeal to the Board.

(4) In paragraph (c)(1)(iii), to require 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.

(5) In paragraph (c)(1)(v), to require a concise explanation 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 claim involved in the appeal, it is proposed that every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, be identified and that 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. Any brief filed by an appellant who is represented by a registered practitioner that fails to provide a summary of the claimed subject matter which references the specification by page and line number, and to the drawing, if any, by reference characters or which fails to identify every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, would be in non-compliance with this section and would be handled as provided in proposed paragraph (d) of this section.

(6) In paragraph (c)(1)(vi), to require a concise statement 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) To delete the current grouping of claims requirement set forth in Rule 965(c)(7). The general purpose served by Rule 965(c)(7) is addressed in proposed § 41.67(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 § 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.

(8) In paragraph (c)(1)(vii), to set forth that any arguments or authorities not included in a brief permitted in this section or filed pursuant to proposed §§ 41.68 and 41.71 will be refused consideration by the Board, unless good cause is shown, and to require a separate heading 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, it is proposed to make explicit by rule that 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 Rule 192(c)(7) to require separate treatment of separately rejected claims). It is further proposed that 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) In paragraph (c)(1)(vii), to state 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 is in Rule 965(c)(7).

(10) In paragraph (c)(1)(vii), to eliminate subparagraphs (i) through (v) of Rule 965(c)(8), which relate to the manner in which arguments are 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 Rule 965(d).

(11) To add paragraph (c)(1)(ix) 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) To add paragraph (c)(1)(x) 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 proposed § 41.67(c)(1)(ii) so that the Board can take into consideration such decisions.

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

Proposed § 41.68 would generally incorporate requirements found in Rule 967 and the changes thereto proposed in ''Changes To Implement the 2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute'', 68 FR 22343 (28 April 2003) (RIN 0651–AB57), and changes similar to those proposed in § 41.67. In addition, it is proposed to add paragraph (b)(2) to exclude any new or non-admitted amendment, affidavit or other evidence from being included in a respondent's brief.

Proposed § 41.69 would generally incorporate requirements found in Rule 969.

Proposed § 41.71 would generally incorporate requirements found in Rule 971 and the changes thereto proposed in ''Changes To Implement the 2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute'', 68 FR 22343 (April 28, 2003) (RIN 0651–AB57).

Proposed § 41.73 would generally incorporate the requirements of Rule 973. In addition:

(1) Paragraph (b) would require 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) would be 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, it is proposed that the requirement for notice to the primary examiner be 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) would be 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; (ii) the primary examiner may only rely on argument and evidence relied upon in the answer; and (iii) that the Board will determine the order of the arguments presented at the oral hearing.

(4) The substance of proposed paragraph (f) is found in 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.

Proposed § 41.77 would generally incorporate the requirements of Rule 977 and the changes thereto proposed in ''Changes To Implement the 2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute'', 68 FR 22343 (April 28, 2003) (RIN 0651–AB57).

Proposed § 41.79 would generally incorporate the requirements of current Rule 979 concerning rehearing before the Board. Paragraph (b) is proposed to be amended to generally incorporate the requirements of current Rule 979(d). Paragraph (c) is proposed to be amended to generally incorporate the requirements of current Rule 979(b). Paragraph (d) is proposed to be amended to generally incorporate the requirements of current Rule 979(c). Paragraph (e) is proposed to be amended to generally incorporate the requirements of current Rule 979(g).

Proposed § 41.81 would generally incorporate the requirements of current Rule 979(e) and the changes thereto proposed in ''Changes To Implement the 2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute'', 68 FR 22343 (April 28 2003) (RIN 0651–AB57).

Proposed § 41.83 would incorporate some of the requirements found in current Rule 979(f) and would provide that an appeal by a party under this proposed subpart is terminated by the dismissal of that party's appeal, or when, after a final Board action, a notice of appeal under 35 U.S.C. 141 is filed or the time for seeking judicial review (Rule 983) has expired. Termination of an appeal by a party under this proposed subpart is the cessation of that appeal proceeding before the Board and is distinct and separate from the termination of proceedings on an inter partes reexamination proceeding which is concluded by the issuance of a certificate pursuant to Rule 997.

Proposed subpart D would provide rules for contested cases. 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). The proposed rules in this proposed subpart would be more general than the existing rules for three reasons. First, while three different statutory proceedings are currently conducted under ''interference rules'', the rules are only tailored to patent interferences. Second, the considerable detail of the current rules has fostered a tendency toward technical compliance with the rules rather than actually proving a case (*e.g.*, *Hillman* v. *Shyamala*, 55 USPQ2d 1220, 1221 (BPAI 2000)). Third, experience with the current rules suggests that attempts to codify the procedures for contested cases too precisely frustrates the policy of administering interferences in a fast, inexpensive, and fair manner. Consequently, the rules would be simplified to give parties adequate guidance about the procedures while permitting the Board to design an approach appropriate to each case. The proposed rules would also better describe the practice for most interferences declared since October 1998. A more complete understanding of existing practice as it relates to the current rules can be obtained from reading the Interference Trial Section's Standing Order, which can be found at *http://www.uspto.gov/web/offices /dcom/bpai/standing 2003May.pdf*.

Proposed § 41.100 would define two terms. The term ''business day'' would be 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 proposed rule would expressly define ''involved'' as designating any patent application, patent, or claim that is the subject of the contested case.

Proposed § 41.101 would follow the practice in Rule 611(a) and (b) for notifying parties of a contested case. As a courtesy, the Board would make reasonable efforts to provide notice to all parties. Note that failure to maintain a current correspondence address may result in adverse consequences. Cf. *Ray* v. *Lehman*, 55 F.3d 606, 610, 34 USPQ2d 1786, 1788–89 (Fed. Cir. 1995) (finding notice of maintenance fee provided to obsolete, but not updated, address of record to have been adequate).

Proposed § 41.102 would require completion of examination for most applications (and of reexamination for most patents) before the Board will institute a contested case. Contested

cases are generally much more expensive than ex parte proceedings. Consequently, it makes little sense to initiate a contested case before all patentability issues (other than those that are the subject of the contested case) have been resolved. *Brenner* v. *Manson*, 383 U.S. 519, 528 n.12 (1966) (rejecting the proposition that an interference must be declared when the applicant's interfering claims are unpatentable). The main exceptions would be title contests under 42 U.S.C. 2182 and 2457(d), where control of the examination may itself be a consideration.

Proposed § 41.103 would follow 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.

Proposed § 41.104(a) would follow the practice of Rule 610(e), which permits an administrative patent judge wide latitude in administering interferences. The waiver provision of proposed § 41.104(b) would be modeled on Rule 183 and would balance the ideal of precise rules for most proceedings against the need for flexibility to achieve reasonably fast, inexpensive, and fair proceedings. The decision to waive a procedural requirement would be committed to the discretion of the administrative patent judge. This provision would eliminate the need for repeatedly stating exceptions throughout proposed subpart D. For instance, the current rules have many instances where a time is set in a rule, but the rule also permits an administrative patent judge to adjust the time. Proposed § 41.104(c) would make clear that any default times set by rule may be changed by order. ''Times'' in paragraph (c) would include both dates and durations.

Proposed § 41.105 would codify existing practice prohibiting ex parte communications about a contested case with an official actually conducting the proceeding. Initiation of an ex parte communication might result in sanctions against the initiating party. The prohibition would include communicating with any member of a panel acting in the proceeding or seeking supervisory review in a proceeding without including the opposing party in the communication. In general, it is wisest to avoid substantive discussions of a pending contested case with a Board official. The prohibition on ex parte communications would not extend to (1) ministerial communications with support staff (for instance, to arrange a conference call), (2) hearings in which opposing counsel declines to participate, (3) informing the Board in one proceeding of the existence or status of a related Board proceeding, or (4) reference to a pending case in support of a general proposition (for instance, citing a published opinion from a pending case or referring to a pending case to illustrate a systemic problem).

Proposed § 41.106 would provide guidance for the filing and service of papers. Under proposed § 41.106(a), papers to be filed would be 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. Proposed § 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. *See* Standing Order ¶ 3.3. 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. Electronic filing might eventually render this preference moot.

Proposed § 41.106(b) would provide guidance specific to papers other than exhibits. Proposed § 41.106(b)(1) would codify current practices for the cover sheet of a paper. Standing Order ¶¶ 3.1, 3.5 and 3.6; cf. Fed. R. App. P. 32(a)(2). The caption aids in the prompt matching of the paper to its file. The header expedites communications between the Board staff and the party in the event that some prompt action, such as the correction of a filing defect, is necessary. The current practice of requiring a pink cover sheet aids in the processing and filing of papers at the Board and facilitates use of the administrative record by clearly indicating the beginning of each paper.

Proposed § 41.106(b)(2), which would require holes at the top of the paper, would codify the practice under Standing Order ¶ 3.4, which is based on Local Civil Rule 5.1(f) (1999) of the United States District Court for the District of Columbia. The proposed rule would facilitate entry of the paper in the administrative record.

The bar in proposed § 41.106(b)(3) against incorporation by reference and combination of papers would minimize the chance that an argument will be overlooked and would eliminate abuses that arise from incorporation and combination. In *DeSilva* v. *DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir 1999), the court rejected ''adoption by reference'' as ''a self-help increase in the length of the * * * brief'' and noted that ''incorporation is a pointless imposition on the court's time. A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.'' The same rationale applies to Board proceedings.

Proposed § 41.106(b)(4) would provide rules for the citation of authority. Parallel citation to a West Company reporter and to the United States Patents Quarterly, particularly for patent decisions of Federal courts, is the norm in patent law. *See* Federal Circuit Rule 28(e). Pinpoint citations, also called ''jump citations'', are the norm in legal practice. *See* The Bluebook: A Uniform System of Citation § 3.3(a) (Columbia L. Rev. Ass'n *et al.* 17th ed. 2000). The citation of secondary authority would be discouraged whenever primary authority exists. For instance, a citation to the MPEP is unhelpful if the MPEP itself is merely summarizing binding case law.

Proposed § 41.106(d) would provide additional guidance for special modes of filing. Proposed § 41.106(d)(1) would provide a mailing address. Note that the proposed rule would encourage the use of the EXPRESS MAIL® service of the United States Postal Service. Mail sent by other means would not be considered to have been filed until it is actually received. Cf. proposed § 41.106(e)(3), which would permit service by methods at least as fast and reliable as EXPRESS MAIL®. Proposed § 41.106(d)(2) would permit other modes of filing. For instance, the Board is currently working on a pilot program for electronic filing in contested cases. The diversity of possible filing forms and the varying ability of parties to cope with electronic filing requires a case-by-case determination of whether to place a proceeding in the pilot program. Practitioners permitted to file electronically are encouraged to agree to do so.

Proposed § 41.106(e)(1) would require papers to be served when they are filed if they have not already been served. Under current practice, the usual instance in which filing before service is authorized is the case of preliminary statements where prior filing is a mechanism for ensuring that a party states its priority case based on what it knows about its own proofs rather than on what it knows about what the other party intends to prove. Proposed § 41.106(e)(3) would provide for expedited service, which would place the parties on an equal footing by reducing the disparities that can arise from the use of different forms of delivery.

Proposed § 41.106(f) would provide rules for certificates of service. Proposed § 41.106(f)(1) would require the certificate to be incorporated into each paper other than exhibits. The filing of additional papers like certificates of service and transmittal letters as separate papers places a file maintenance burden on the Board. The filing of transmittal letters is strongly discouraged. Exhibits constitute the exception to the rule since the current practice permits the filing of most or all exhibits at one time. When the exhibits are filed at the same time, the certificate may be incorporated into the exhibit list. See proposed § 41.154(d).

Section 41.107 of proposed subpart D would be reserved. It is likely that rules for electronic filing and service will evolve in the next few years. When they are ready for codification, § 41.107 would be the natural place for them to appear.

Proposed § 41.108 would require each party to identify its counsel, if any. The proposed rule would also follow Rule 613(a), which permits the Board to require the appointment of a lead counsel.

Proposed § 41.109 would follow Rule 612 in permitting parties to obtain copies of certain Office files directly related to the contested case. Current practice is to make the necessary files available for copying immediately after the Board initiates the proceeding. Standing Order ¶ 6. After that initial opportunity passes, files typically become less available because they are often required in other parts of the Office. Proposed § 41.109(c) would require a party that has not received copies of a requested file to notify the Board of the problem promptly. A delay in receiving a file resulting from a failure to order a file promptly, or to notify the Board promptly that a file has not been received, would not justify a delay in the proceeding.

The proposed rule would depart from Rule 612 by eliminating the requirement for withholding declarations under Rule 131 and statements under Rule 608. One reason for withholding such papers is that they give the opponent an advanced view of the applicant's priority case, which is said to be unfair (and can enable fraud by the other party in stating its priority case). This practice, however, is asymmetric because the withholding only applies to applicants while a patentee's Rule 131 declaration is publicly available. Moreover, to the extent the applicant has relied on the declaration to obtain allowable claims, it is an important element in the prosecution history. On balance, the goals of examination are better served by permitting early access to such statements. Nothing in the proposed rule would prevent the Board from authorizing the withholding of such declarations on a showing of good cause.

Proposed § 41.110(a) would require a single clean set of the claims, analogous to the requirement for amendments ''in clean form'' in Rule 121. The annotated copy required in proposed § 41.110(b) would provide the opposing party and the Board with a clear understanding of how the party construes its own claim. The clean and annotated copies would provide everyone in the proceeding with a convenient reference and help to identify mistakes, such as amendments that were not entered or portions of the disclosure that were not printed, before the proceeding begins in earnest. Cf. *Southwest Software, Inc.* v. *Harlequin, Inc.,* 226 F.3d 1280, 1296, 56 USPQ2d 1161, 1173 (Fed. Cir. 2000) (critical portion of disclosure missing). Moreover, identically worded claims in separate applications claims can, when properly construed in view of the specification, have patentably distinct scopes. This possibility is particularly important for claims written in the form permitted under 35 U.S.C. 112[6], where identically worded means or steps might not correspond to equivalent structures, materials, or acts in the respective disclosures. For instance, a limitation requiring ''means for fastening'' might refer to rivets in one specification and glue in another, which on the facts of the case might not prove to be equivalent. Here is an example of the annotation that would be required (except the bracketed portion should also be shown in bold face): ''. . . means for fastening {Fig. 6, item 3; also page 17, lines 9–22} . . . .''

Proposed § 41.120 would provide for notice of requested relief and the basis for that relief in contested cases. Similar notices are already common in patent interferences, e.g., a preliminary statement, a statement under Rule 608, and a motions list currently required at the first status conference. These notices can be effective mechanisms for administering cases efficiently and for placing opponents on notice. Interferences suggested under proposed § 41.202(a) would already include a notice from at least one party, although the Board could require more detail.

Proposed § 41.120(b) would apply present Rule 629(e) regarding the effect of preliminary statements to notices generally. Preliminary statements are binding on the submitting party. The proposed rule would make other such notices presumptively binding because compliance with current notice practices is highly variable and can have the effect of prejudicing the party that complies most completely with a notice requirement. The filing party should not be allowed to hide behind an ambiguous notice. For instance, a notice that alleges a date of conception ''no later than 20 June 2000'' would be construed as limiting the submitting party to proving a date no earlier than 20 June 2000. Note that a notice is not evidence except to the extent it qualifies as a party-opponent admission. See Federal Rule of Evidence 801(d)(2). Proposed § 41.120(c) would permit correction of a notice after the time set for filing the notice, but would set a high threshold for entry of the correction.

Proposed § 41.121(a)(1) would redefine 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. Current practice often permits motions that have little to do with the point of the contest. For instance, a motion for unpatentability in an interference is not helpful if it does not result in a loss of standing, a change in the scope of the count, or a change in the accorded benefit.

Proposed § 41.121(a)(1)(iii) would permit 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. For instance, priority in interferences would be raised through motions. This departure from current practice would address a potential disadvantage to the senior party, which currently may have to make decisions about the junior party's priority case after the junior party has provided its evidence but before it explains the evidence. The prohibition on motions directed to priority and derivation in Rule 633(a) would be removed, although a decision on such motions would likely be contingent on decisions regarding the scope of the interference. Consequently, the Board might not authorize the filing of a priority or derivation motion until after scope issues have been resolved.

Proposed § 41.121(a)(2) and (a)(3) would modify the responsive motion and miscellaneous motion practice under Rules 633(i) and (j), 634, and 635 to ensure that the proceeding remains focused. For instance, current practice allows a motion to correct inventorship at any time (Rule 634). Under the proposed rules, a motion to correct inventorship could be an appropriate responsive motion in the face of a patentability attack or in view of a priority statement, but would not be permitted without some connection to an issue that must be resolved in the

contested case. The authorization requirement in proposed § 41.121(a)(2) would also provide a mechanism for limiting abusive practices, such as moving to add many more claims than are necessary to cure a problem. Proposed § 41.121(a)(3) would provide for miscellaneous motions, which would offer a mechanism for requesting relief on procedural issues and other issues tangential to patentability and priority. See proposed § 41.104. A miscellaneous motion would not be considered a petition; hence, no petition fee is required. See proposed § 41.3(b). Panel review of a decision on a miscellaneous motion would apply an abuse of discretion standard. See proposed § 41.125(c)(5); Rule 655(a).

Proposed § 41.121(b) would place the burden of proof on the moving party, following Rule 637(a). Since priority would be presented as a motion, this paragraph would change the allocation of burden of proof established in Rule 657(a). Cf. *Brown* v. *Barbacid,* 276 F.3d 1327, 1332, 61 USPQ2d 1236, 1239 (Fed. Cir. 2002) (construing Rule 657(a) to require the ultimate burden of proof on priority to remain on the junior party). A motion that fails to justify relief on its face could be dismissed or denied without regard to subsequent briefing.

Proposed § 41.121(c)(1) would follow 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 separate paper requirement would reduce the chances that an argument will be overlooked and would generally reduce the complexity of any given paper. The numbered paragraphs stating material facts in proposed § 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 proposed § 41.121(c)(1)(iii), sloppy motion drafting would be held against the moving party. A vague argument or citation to the record creates inefficiencies for the Board and is fundamentally unfair to the opposing party. Cf. *Winner Int'l Royalty Corp.* v. *Wang,* 202 F.3d 1340, 1351, 53 USPQ2d 1580, 1589 (Fed. Cir. 2000) (declining to scour the record to make out an argument for a party).

Proposed § 41.121(c)(2) would require the movant to make showings ordinarily required for the requested relief in other parts of the Office. Many actions, particularly corrective actions like changes in inventorship, filing reissue applications, and seeking a retroactive foreign filing license, are governed by other rules of the Office. By requiring the same showings, the proposed rule would keep practice uniform throughout the Office. The Board could temporarily release the affected file to the part of the Office usually responsible for administering the rule to ensure consistency or otherwise take advantage of that entity's expertise. See proposed § 41.103.

Proposed § 41.121(d) would provide authority comparable to Rule 641, which allows an administrative patent judge to raise questions of patentability. The proposed rule would be broader because it would permit the Board to inquire into other issues that may arise, such as whether there continues to be an interference-in-fact in view of a claim construction reached in deciding a motion. In this regard, it would be akin to an order to show cause under Rule 640(d)(1).

Proposed § 41.122 would address the perennial problem of new arguments or requests for relief creeping in at inappropriate times. The proposed rule would largely adopt the present practice in Standing Order ¶ 13.7, but would extend the practice to oppositions as well. Note that a movant need not anticipate all possible bases for opposition, but may be held accountable for positions apparently inconsistent with those taken by the movant during prosecution of an application. For instance, a motion to add a broad claim to an application in which the claims have been narrowed to avoid prior art should explain why the new claim is patentable, not only in terms of written description in the specification but also in terms of the previously applied prior art. The Board could expunge improper papers. See proposed § 41.7(a); *Winter* v. *Fujita*, 53 USPQ2d 1234, 1250 (BPAI 1999).

Proposed § 41.123(a) would maintain the practice of having the Board set the times for filing motions found in Rule 636, but would eliminate the default times provided in that rule. Proposed § 41.123(a)(1)–(3) would provide default times for filing an opposition, a reply, and a responsive motion, but would not themselves authorize the filing of an opposition, a reply, or a responsive motion.

Proposed § 41.123(b) would provide requirements for miscellaneous motions. A conference call would be required before the motion is filed because most relief requested in such motions can be granted (or denied) in a conference call. In other cases, the call would permit the setting of a schedule to accommodate full briefing of the issue. This telephone practice has greatly increased speed and reduced costs associated with miscellaneous motion practice.

A party is not entitled to an oral argument. In re Bose Corp., 772 F.2d 866, 869, 227 USPQ 1, 4 (Fed. Cir. 1985). Hence, a party could request an oral argument under proposed § 41.124(a), but requests would not be automatically granted. Factors considered in setting an oral argument might include the usefulness of an oral argument to the administrative patent judge or panel and the burden on an opponent of attending an oral argument. A corollary is that not all requested issues would necessarily be heard. Under proposed § 41.124(b), the parties would be required to file three working copies of the papers to be considered for the panel if the hearing is set for a panel. This requirement would be comparable to Rule 656(e) and Federal Circuit Rule 31(b).

Proposed § 41.124(c) would provide a default time of 20 minutes per party for oral arguments at the Board because they are not evidentiary hearings. This default time would be comparable to the 15 minutes typically provided for oral argument at the Court of Appeals for the Federal Circuit. Fed. Cir. R. 34, practice note (2001).

Proposed § 41.124(d) would permit the use of demonstrative exhibits. Visual aids requiring special equipment would be discouraged since the argument time would be short and cumbersome exhibits would tend to detract from the user's argument. The use of a compilation with each demonstrative exhibit separately tabbed would be encouraged, particularly when a court reporter is transcribing the oral argument because the tabs provide a convenient way to record which exhibit is being discussed. It is helpful to provide a copy of the compilation to each member of the panel hearing the argument.

Proposed § 41.124(e) would permit the transcription of the argument. The transcription would become part of the record and could be helpful to the panel in reaching its decision. See *Okajima* v. *Bourdeau*, 261 F.3d 1350, 1356, 59 USPQ2d 1795, 1798 (Fed. Cir. 2001) (noting the role of the transcript in the Board's decision). To be helpful, however, the transcript would have to be filed promptly.

Proposed § 41.125(a) would maintain the practice under Rule 640(b) of addressing issues in a manner that is both fair and efficient. Noted with approval in *Berman* v. *Housey*, 291 F.3d 1345, 1352, 63 USPQ2d 1023, 1028 (Fed. Cir. 2002). A decision on a motion might be logically contingent on the outcome of another motion even though

the motion is not expressly identified as a contingent motion. Moreover, efficient allocation of Office resources might require deferral of a motion or referral of a matter to another part of the Office. Given the great cost of contested cases for both parties and the Office, the Board will continue to focus on efficient administration consistent with the requirements of due process.

Proposed § 41.125(b) would clarify the current practice that a decision short of judgment is not final. It would also codify the current practice of having panel decisions bind further action during the proceeding. The practice of having panel decisions bind further proceedings has eliminated much of the uncertainty and added cost that results from deferring any final decision until the end of the proceeding. A party dissatisfied with an interlocutory decision on motions should promptly seek rehearing rather than waiting for a final judgment. A panel could, when the interests of justice require it, reconsider its decision at any time in the proceeding prior to final judgment. A belated request for rehearing would rarely be granted, however, because its untimeliness would detract from the efficiencies that have resulted from making interlocutory decisions binding.

Proposed § 41.125(c) would adopt the time for requesting rehearing from Rule 640(c) and the procedural requirements of the last two sentences of Rule 655(a). Since 35 U.S.C. 6(b) requires a panel decision for finality, a party should request rehearing by a panel to preserve an issue for judicial review. A panel will apply the deferential abuse-of-discretion standard to procedural decisions on rehearing.

Proposed § 41.126 would adopt the arbitration practice of Rule 690. Although parties may submit any issue to binding arbitration, the Board might independently decide any questions of patentability. The proposed rule would also clarify that the Board could independently determine questions like whether an interference-in-fact exists or what an Office rule means.

Proposed § 41.127(a)(1) would adopt the estoppel provision of Rule 658(c). Note that while the second sentence of the proposed paragraph would continue to focus on the losing party, a decision of no interference-in-fact could also estop a party from provoking an interference with the same opponent for the same subject matter under the first sentence. Cf. Rule 665, which cites Rule 658(c).

Proposed § 41.127(a)(2) restates the final disposal provision of Rule 663. Proposed § 41.127(b) would restate the conditions in Rule 662 under which the Board would infer a concession of the contest. Proposed § 41.127(c) would restate the recommendation provision of Rule 659.

The Director has authority to prescribe a time for seeking judicial review. 35 U.S.C. 142 and 146[1]. The prescribed time (2 months) is set in Rule 304(a)(1), but can be extended on petition under Rule 304(a)(3). Proposed § 41.127(d) would provide a time for requesting a rehearing and would delegate to the Board limited discretion to toll the time for seeking judicial review for the pendency of the request. Tolling the time for seeking judicial review would codify the result of In re Graves, 69 F.3d 1147, 1149–51, 36 USPQ2d 1697, 1698–1700 (Fed. Cir. 1995), but such tolling would not be automatic. The Board would not toll the time for seeking review where the request for rehearing appears to be a delaying tactic, for example if a party files requests serially.

Proposed § 41.128 would define the term ''termination'', which appears several times in 35 U.S.C. 135(c). Section 135(c) renders settlement agreements and patents involved in or resulting from the interference unenforceable if the parties fail to file the agreements prior to termination. The Office is required to provide notice of the requirement within a reasonable time before termination or else the agreement may be filed up to sixty days after notice is provided. The Office has generally tried to minimize the potential traps for the unwary by construing the requirements liberally. Over time, this has led to divergent constructions of ''termination''. In *Hunter* v. *Beissbarth,* 15 USPQ2d 1343, 1344 n.1 (Comm'r Pat. 1990), the question of when such agreements must be filed was liberally construed to extend the time until after judicial review was complete. In contrast, the question of what agreements are covered was limited to agreements reached during proceedings before the Board in *Johnston* v. *Beachy,* 60 USPQ2d 1584, 1588 (BPAI 2001). A third construction is possible in which the interference proceeding is tolled during the judicial proceeding such that both Hunter and Johnston are correct. In the proposed rule, the Director would construe section 135(c) to mean the interference terminates when the time for seeking judicial review under 35 U.S.C. 142 and 146[1] expires, whether such review is sought or not. This construction offers several practical benefits. First, by limiting the number of agreements covered, the risk of inadvertent failure to file is correspondingly limited. Second, although parties will have less time to file than they would under the Hunter construction, the outer bound for timely filing will be much closer to the date of all affected agreements, thus reducing the likelihood of an accidental failure to file. Finally, since the Director has authority to extend the time for seeking judicial review, sections 142 and 146[1], the proposed definition permits an additional route of relief when such relief, though otherwise unavailable, would be in the interests of justice.

Proposed § 41.128(a) would codify the holding of In re Graves, 69 F.3d 1147, 1151, 36 USPQ2d 1697, 1699–1700 (Fed. Cir. 1995), that whether the time for seeking judicial review has run or not, a timely notice of appeal on an appealable decision terminates further Board jurisdiction to act on the merits. Proposed § 41.128(b) would extend the same principal to the timely commencement of a district court action under 35 U.S.C. 146 seeking review of an appealable decision.

Proposed § 41.129(a) would restate Rule 616 on sanctions, but would expressly add the examples of misleading arguments and dilatory tactics to the list of reasons for sanctions. A party always has a duty of candor toward a tribunal. Hence, while the proposed rules no longer expressly require a movant to show the patentability of a proposed claim to the movant, the filing of a claim that the party knew or should have known to be unpatentable would be inconsistent with that duty of candor. The concern about dilatory tactics arises from the potential for abuse inherent in patent term adjustments for time spent in an interference provided in 35 U.S.C. 154(b)(1)(C).

Proposed § 41.129(b) would restate the list of sanctions provided in Rule 616, but would add terminal disclaimer as a sanction. Terminal disclaimer would be an appropriate sanction in cases where a party has caused needless delay. The sanction of expunging papers would be consistent with proposed § 41.7(a), under which unauthorized papers may be expunged. Neither the list of sanctionable acts nor the list of sanctions should be considered exhaustive.

Proposed § 41.150(a) would restate the present policy of limited discovery, consistent with the goal of providing contested proceedings that are fast, inexpensive, and fair. Proposed § 41.150(b) would provide for automatic discovery of materials cited in the specification of an involved or benefit disclosure. The proposed rule would place the parties on a level playing field since the party that relied on the requested materials in its disclosure

would ordinarily have easier access to such materials than the requester and would be in a better position to ensure that the requested material is the material cited. It would also eliminate many routine discovery requests and disputes. The requirement would not be a requirement for a party to create materials or to provide materials not cited. See *Scott* v. *Gbur,* 62 USPQ2d 1959 (BPAI 2002) (nonprecedential). Any request under proposed § 41.150(b) should come early in the proceeding to ensure that the requesting party will have timely access to such materials. Proposed § 41.150(c) would restate existing practice under Rule 687 regarding additional testimony.

Proposed § 41.151 would continue the practice under Rule 671(i) of making failure to comply with the rules a basis for challenging admissibility.

Proposed § 41.152 would continue the current practice of using the Federal Rules of Evidence in contested cases. Experience since this practice was implemented in 1984 has shown it to be beneficial without being unduly restrictive for either the parties or the Board. Moreover, the Federal Rules of Evidence embrace a well-developed body of case law and are familiar to the courts charged with reviewing Board decisions in contested cases. Minor changes to the rule have been made to conform the rule with amendments to the Federal Rules of Evidence since 1984.

No special provisions for electronic records are proposed beyond the provisions already in the Federal Rules of Evidence. See Fed. R. Evid. 1001(3). While electronic records appear to be of special concern because they often may be easily altered, the requirements already present in the Federal Rules of Evidence adequately addressed this concern. The Board's limited experience with electronic records in interferences has not suggested any unique admissibility problems requiring special provisions. Electronic records have been admissible in interferences on the same basis as other records.

Proposed § 41.153 would restate the practice under Rule 671(d) of admitting Office records that are available to all parties without certification. Cf. 28 U.S.C. 1744, which provides for the admissibility of certified Office records. Note that under proposed § 41.154(a), each Office record cited as evidence would have to be submitted as an exhibit, following the practice of Standing Order ¶ 14.5. In the case of application files and similar files, only the specific record cited should be submitted as an exhibit. Submitting the entire file when only discrete portions are cited would create a record-management problem for the Board and confusion about what the fact-finders must consider in reaching a decision. The Board might expunge such filings sua sponte.

Proposed § 41.154(a) would restate Rule 671(a), which sets the form of evidence, and would codify the existing practice that all evidence must be submitted as an exhibit. Proposed § 41.154(b) would restate Rule 647 regarding translation of foreign language evidence. Proposed § 41.154(c) would set forth additional formal requirements for exhibits consistent with current practice under Standing Order ¶ 14.8.1. An exhibit list would be required under proposed § 41.154(d), following the current practice under Standing Order ¶ 14.8.5.

Proposed § 41.155 would set forth rules for objecting to evidence and responding to objections. The current practice is to provide a time for filing motions to exclude. Under proposed § 41.155(b)(1), the default time for serving an objection to evidence other than testimony would be five business days. Since evidence would have to be served by EXPRESS MAIL® or comparably fast means, see proposed § 41.106(e)(3), five business days would ordinarily be adequate time to object.

Proposed § 41.155(b)(2) would permit 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) because the objection either might have been cured or might prove unimportant in light of subsequent developments. Proposed § 41.155(d) would provide for a motion in limine for a ruling on admissibility, following the practice of Standing Order ¶ 13.10.3.2.

Under 35 U.S.C. 23, the Director may establish rules for affidavit and deposition testimony. Under 35 U.S.C. 24[1], a party in a contested case may apply for a subpoena to compel testimony in the United States, but only for testimony to be used in the contested case. Proposed § 41.156(a) would require the party seeking a subpoena to first obtain authorization from the Board; otherwise the compelled evidence would not be used in the contested case. Proposed § 41.156(b) would impose 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. The Board would give weight to foreign deposition testimony to the extent warranted in view of all the circumstances, including the laws of the foreign country governing the testimony. Little, if any, weight might be given to deposition testimony taken in a foreign country unless the party taking the testimony proved, as a matter of fact, that knowingly giving false testimony in that country in connection with a Board proceeding is punishable under the laws of that country and that the punishment in that country for such false testimony is comparable to or greater than the punishment for perjury committed in the United States. Proposed § 41.156(c) would advise that the Board may rely on official notice and hearsay to determine the scope and effect of foreign law.

Proposed § 41.157 would restate existing practice regarding the taking of testimony. The time period for cross-examination set in proposed § 41.157(c)(2) would follow the current practice under Standing Order ¶ 14.3 and would set a norm for the conference held under proposed § 41.157(c)(1). A party seeking to push the deposition outside this period would have to be prepared to show good cause. Proposed § 41.157(c)(3) would clarify 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 proposed § 41.157(c)(3) would apply should rarely occur apart from compelled testimony.

Proposed § 41.157(d) would codify the existing requirement for a conference before a deposition with an interpreter. Board experience suggests that the complexity of foreign language depositions can be so great that in many cases the resulting testimony is not very useful to the fact-finder. To avoid a waste of resources in the production of an unhelpful record, the Board must approve of the deposition format in advance and may require that the testimony occur before the Board. Occasionally other testimony that particularly touches on the credibility of the witness, such as testimony about best mode, derivation, or inequitable conduct, will also be required to be taken before the Board so the Board may directly observe the demeanor of the witness.

Proposed § 41.157(e) would depart from the current rules in adopting ''officer'', the term used in 35 U.S.C. 23, to refer to the person qualified to administer testimony.

The certification of proposed § 41.157(e)(6)(vi) would substantially adopt the standard of Rule 674 for

disqualifying an officer from administering a deposition. The use of financial interest as a disqualification, however, would be broader than the employment interest currently barred. Payment for ordinary services rendered in the ordinary course of administering the deposition and preparing the transcript would not be a disqualifying financial interest. An interest acknowledged by the parties on the record without objection would not be a disqualifying interest.

Proposed § 41.157(e)(7) would require the proponent of the testimony to file the transcript of the testimony. If the original proponent of the testimony declined to file the transcript (for instance, because that party no longer intended to rely on the testimony), but another party wished to rely on the testimony, that party becomes the proponent and could file the transcript as its own exhibit.

Proposed § 41.157(f) would codify 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.

Proposed § 41.158 would codify the practice under Standing Order ¶¶ 14.9 and 14.10 regarding expert testimony and scientific tests and data. Opinions expressed without disclosing the underlying facts or data may be given little, if any, weight. *Rohm & Haas Co.* v. *Brotech Corp.,* 127 F.3d 1089, 1092, 44 USPQ2d 1459, 1462 (Fed. Cir. 1997). United States patent law is not an appropriate topic for expert testimony before the Board.

Proposed subpart E would provide rules specific to patent interferences. Proposed § 41.200(a) would specifically identify patent interferences as contested cases subject to the rules in proposed subpart D.

Proposed § 41.200(b) would continue 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. See *Rowe* v. *Dror,* 112 F.3d 473, 479, 42 USPQ2d 1550, 1554 (Fed. Cir. 1997) (explaining the change in practice). Claims in interferences are not to be treated any differently than any other claim before the Office. In this regard, the proposed rule would also clarify that claims are given their broadest reasonable interpretation in light of the associated specification. In re Van Geuns, 988 F.2d 1181, 1185, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (application claim in interference); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (application claim after interference); In re Etter, 756 F.2d 852, 858–59, 225 USPQ 1, 5–6 (Fed. Cir. 1985) (en banc) (patent claim in reexamination). The court in Etter noted that a patentee in reexamination can amend its claim, while a patentee in litigation ordinarily may not. A patentee in an interference can contingently narrow its claim by filing a reissue application. 35 U.S.C. 251; Rule 633(h) and (i); proposed § 41.121(a)(2). Indeed, a patentee may face an estoppel if it does not seek to amend its claim when necessary. Rule 658(c); proposed § 41.127(a)(1).

Proposed § 41.200(c) would set forth the policy now found in Rule 610(c) setting two years as the maximum normal pendency for patent interferences. New procedures adopted since October 1998 have permitted the Board to meet or exceed this goal in most interferences declared since that time. The cooperation of the parties has been a critical factor in this success. The proposed rules would build on this success by codifying procedures that have facilitated efficiency, removing procedures that delayed proceedings, and creating new opportunities for improvement.

Proposed § 41.201 would set forth definitions specific to patent interferences. The phrase ''accorded benefit'' would be defined as an act by the Board with regard to priority. Specifically, it would be the Board's recognition of an application as providing a proper constructive reduction to practice for a party. This recognition would create a presumption that is important for setting the burdens for proving priority. ''Accorded benefit'' in this proposed subpart would be a term of art limited to priority determinations under 35 U.S.C. 102(g). In this regard accorded benefit should be understood to be distinct from benefit under 35 U.S.C. 119, 120, 121, or 365(a), which impose additional requirements not directly relevant to a priority determination under section 102(g).

A definition would be set forth for the phrase ''constructive reduction to practice'' because this phrase would be used in the proposed rules instead of ''earliest effective filing date'' to explain more precisely how benefit would be accorded for the purpose of determining priority. ''Earliest effective filing date'' has proved confusing because the same term is used to discuss compliance with the disclosure requirements of 35 U.S.C. 119, 120, 121, and 365. Compliance with these statutes is important when considering most questions of patentability, but the question of benefit for priority under 35 U.S.C. 102(g) is narrower than full compliance with the disclosure statutes. Sections 119, 120, 121, and 365 focus on whether the full scope of a claim is adequately disclosed, while an interference is focused on whether at least one embodiment anticipates the interfering subject matter as defined in a count.

The phrase ''constructive reduction to practice'' would focus consideration on the value of a disclosure as a potentially anticipating reference under section 102(g). Only a single enabled embodiment is necessary for anticipation of the count. Note that abandonment of an application without a co-pending (section 120 and 121) or timely filed (sections 119 and 365) successor application can render an otherwise anticipating disclosure under section 102(g) ''inoperative for any purpose, save as evidence of conception.'' In re Costello, 717 F.2d 1346, 1350, 219 USPQ 389, 391 (Fed. Cir. 1983). The phrase ''earliest constructive reduction to practice'' would reflect this requirement for continuity in the disclosure of the anticipating embodiment under section 102(g).

The term ''count'' would be redefined to emphasize the relationship of the count to admissible proofs of priority under section 102(g). *Eaton* v. *Evans,* 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000) (priority cannot be established with a reduction to practice outside the count). There has been a theoretical debate in the interference bar about whether a count is necessary. Opponents hold that a count is an artificial construct that imposes significant administrative costs. It is true that the use of a count is the principal reason why interferences almost always proceed in two phases: a first phase to examine issues related to the scope of the count and a second phase to determine priority for the count. Moreover, use of a count might in some cases obscure the relationship between the priority proofs and the patentability of claims said to correspond to the count. Proponents, however, note that addressing the separate unpatentability of claims without the benefit of a count to focus the analysis also imposes extensive costs and uncertainties.

While a count may be theoretically unnecessary, experience with the current rules suggests that a count is desirable. The costs associated with the count are outweighed by the advantages flowing from having a single description of the interfering subject matter both for the purpose of determining priority and, perhaps more importantly, for the

purpose of claim correspondence. The Federal Circuit recently reached a similar conclusion regarding the use of a count in the context of interfering patents in 35 U.S.C. 291 proceedings. *Slip-Track Sys.* v. *Metal-Lite, Inc.,* 304 F.3d 1256, 1264, 64 USPQ2d 1423, 1428 (Fed. Cir. 2002) (requiring the use of a count). Note that the requirement that counts be separately patentable preserves the current practice of having genus and species counts in appropriate cases, e.g., *Hester* v. *Allgeier,* 687 F.2d 464, 215 USPQ 481 (CCPA 1982) because a generic invention and a specific invention are often patentably distinct.

The definition of ''involved claim'' would be based on a similar definition in Rule 601(f). This definition would be consistent with the definition of ''involved'' for contested cases in proposed § 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. Identification of the senior party is important because a presumption of priority attaches to the senior party under proposed § 41.207(a)(1).

The phrase ''threshold issue'' would be defined to include three specific issues that affect the standing of a party to participate in an interference. All three are of particular interest to the Board because they have been subject to abuse by parties using interferences as a type of opposition proceeding. An adverse decision on these issues with respect to all of a party's claims would ordinarily end the interference. The list would be open-ended and thus admit the possibility that another issue might qualify as a threshold issue on the particular facts of a specific case. Note that these threshold issues would exist in addition to the possibility that a junior party has failed to allege a prima facie sufficient case of priority. See proposed §§ 41.202(d) and 41.204(a).

The first identified threshold issue would be no interference-in-fact. Without an interference-in-fact, there would be no reason to place either party's claim in jeopardy in the context of an interference proceeding.

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], would be 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. Note that the section 135(b) bar and lack of written description address complementary problems: Under section 135(b) a claim may be supported but untimely, while a claim lacking written description may be timely but is unsupported. For the purposes of the proposed rule, provocation of an interference would be inferred from the circumstances, such as entry of a claim after publication of the movant's application or issuance of the movant's patent. It would not require any determination that the opponent had an intent to provoke the interference.

Proposed § 41.202(a) would restate the requirements of Rules 604, 607, and 608 for applicants provoking an interference. A showing of priority need not anticipate all possible bases for opposing the showing. For instance, when the applicant's earliest constructive reduction to practice of the interfering subject matter occurred before the apparent earliest constructive reduction to practice of a targeted patent, it would typically suffice for the applicant to show precisely where its earliest constructive reduction to practice was disclosed.

Proposed § 41.202(a)(5) would continue 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. *See Rowe* v. *Dror,* 112 F.3d 473, 479, 42 USPQ2d 1550, 1554 (Fed. Cir. 1997) (explaining the change in practice). It would also set forth a mechanism for weeding out frivolous attempts to provoke an interference. A protester under Rule 291 hoping to prompt an examiner to propose an interference could improve its chances of success by satisfying the requirements of proposed § 41.202(a)(1)–(a)(4) in its protest.

Proposed § 41.202(c) would restate the practice under Rule 605 of requiring an applicant to add a claim to provoke an interference. This requirement is an effective and sometimes necessary method for determining whether an interference actually exists between two parties. In re Ogiue, 517 F.2d 1382, 1390, 186 USPQ 227, 235 (CCPA 1975). The requirement may be used to obtain a clearer definition of the interfering subject matter or to establish whether the applicant will pursue claims to the interfering subject matter. While an applicant must add the claim or forfeit the subject matter of the claim, the applicant may contest the requirement and the examiner may withdraw the requirement. Where the requirement is based on a patent or a published application, the examiner should note the patent or application in making the requirement. In challenging the requirement, the applicant may point to another claim in the application that already claims the subject matter of the required claim. The applicant may also propose an alternative claim with an explanation of why the alternative claim would be better for the purpose of determining the interference. A common reason for proposing an alternative claim is that the applicant believes the required claim to be unpatentable at least to the applicant.

Proposed § 41.202(d) would set forth the basis for a summary proceeding when an applicant does not appear to be able to show it would prevail on priority. Proposed § 41.202(d)(1) would restate Rule 608, but would eliminate the distinction between Rule 608(a) and Rule 608(b). The requirement could be made under 35 U.S.C. 132 even when a rejection is not available. Failure to comply with the requirement would result in abandonment of the application under 35 U.S.C. 133. Proposed § 41.202(d)(2) would restate Rule 617 by providing a basis for a summary proceeding on priority when the applicant fails to make a sufficient showing of priority. To be sufficient, under proposed § 41.202(e), the showing would by itself, if unrebutted, have to warrant a determination of priority.

Proposed § 41.203(a) would state the standard for declaring a patent interference. The Director uses a two-way unpatentability test to determine whether claimed inventions interfere because, while a one-way test is only sufficient for rejecting a claim under 35 U.S.C. 102(g), a two-way test is necessary to ensure that the claims of both parties are directed to the same invention.

The case law provides that there is no interference-in-fact when there is patentable distinctness between the claims of the parties (e.g., *Case* v. *CPC Int'l, Inc.,* 730 F.2d 745, 221 USPQ 196 (Fed. Cir.1984); *Aelony* v. *Arni,* 547 F.2d 566, 192 USPQ 486 (CCPA 1977); *Nitz* v. *Ehrenreich,* 537 F.2d 539, 190 USPQ 413 (CCPA 1976)). Consequently, to declare an interference, the Director requires patentable indistinctness between the claimed subject matter of the parties. *Eli Lilly & Co.* v. *Bd. of Regents of Univ. of Washington,* 334 F.3d 1264, 67 USPQ2d 1161 (Fed. Cir. 2003). In practice this means that a claim of A and a claim of B interfere if the subject matter of A's claim would, if treated as prior art, have anticipated or rendered obvious (alone or in

combination with prior art) the subject matter of B's claim, and vice versa. This standard has recently come to be known as the ''two-way'' test because it concisely summarizes the analysis. If this test is not effectively satisfied there is no interference-in-fact, i.e., no priority question to be resolved, although there may be other applicable rejections.

Proposed § 41.203(b) would specifically delegate this discretion to an administrative patent judge. Proposed § 41.203(c) would similarly authorize an administrative patent judge to redeclare the interference sua sponte or in response to a decision on motions. An administrative patent judge could redeclare an interference sua sponte, for instance, when another interfering patent or application came to light. An interference is often redeclared after a motion is decided, particularly when there are changes in the scope of the count, in the order of the parties, or in the claims that would be affected by the judgment as the result of the decision.

Proposed § 41.203(d) would depart from current practice regarding adding files or declaring additional interferences. Rules 633(d), (e), and (h) treat the addition of a party's application or patent, or the declaration of an additional interference involving the parties, as substantive motions, while Rule 642 treats the addition of other patents or applications to the interference as an action more akin to the original declaration. The proposed rule would eliminate this difference in treatment and permit a suggestion, like an applicant's request for an interference, to have an administrative patent judge exercise discretion to declare a new interference or to redeclare the existing interference to accommodate such files. The net effect of these changes would be to unify the treatment and legal effect of declaring and redeclaring interferences.

Proposed § 41.204 would define notices of requested relief in interferences. Proposed § 41.204(a) would greatly simplify the formal requirements for the principal notice on priority, the preliminary statement (which is renamed a ''priority statement''). It would not specify the information that needs to be filed with a priority statement. Instead, the rule would require each party to state with particularity the facts on which it intends to rely. The requirement for filing documentary support would reflect the current practice under Rule 623(c) of filing first drawings and written descriptions. The requirement would be limited to documents under the control of a party because those documents are more susceptible to alteration in light of subsequent developments in the interference. Derivation would not be treated separately in the proposed rule since it is a type of attack on priority.

Proposed § 41.204(b) would codify the existing practice of requiring a list of motions, but under the proposed rule a party would ordinarily be limited to filing substantive motions consistent with its notice of requested relief. No default times would be set for statements in proposed § 41.204(c) because the time for filing such statements would be contingent on too many other variables to make default times useful. Generally, such statements would be required early in the interference because there would be very little discovery permitted so most motions will be based on information under the party's control. Subsequent developments in the proceeding, such as a change in the count, might justify corrections to a statement.

Proposed § 41.205 would restate practice under Rule 666 regarding the filing of settlement agreements and would implement the requirements of 35 U.S.C. 135(c).

Proposed § 41.206 would revise practice under Rule 602(a) to use the ''commonly owned'' test discussed in Barton, 162 F.3d at 1144, 49 USPQ2d at 1132. Common ownership in a contested case is a concern because it can lead to manipulation of the process. The proposed rule would be stated permissively because not all cases of overlapping ownership would be cause for concern. The cases of principal concern involve a real party-in-interest with the ability to control the conduct of more than one party.

Proposed § 41.207(a)(1) would adopt the presumption regarding order of invention from Rule 657(a). The presumption is based on the date of the earliest constructive reduction to practice and permits a different senior party for each count. Proposed § 41.207(a)(2) would adopt the evidentiary standards for proving priority stated in Rule 657(b) and (c), but would restate the standard of Rule 657(c) in terms of the date of the earliest constructive reduction to practice. The proposed rule would also add publication under 35 U.S.C. 122(b) as a reason for requiring proof of priority under a clear and convincing evidence standard.

Proposed § 41.207(b) would clarify claim correspondence practice and explicitly state the effect of claim correspondence. Proposed § 41.207(b)(1) would reflect the practice under In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993), for grounds of unpatentability other than priority, under which patentability must be determined for claims, not counts. The Board could rely, however, on claim grouping that is explicit in the arguments of the parties, see *e.g.,* In re Roemer, 258 F.3d 1303, 1307, 59 USPQ2d 1527, 1529 (Fed. Cir. 2001) (noting party concession to have claims stand or fall according to correspondence), or implicit from a logical relationship of the claims (*e.g.,* lack of written support for a limitation in a claim might also affect its dependent claims).

Under proposed § 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 Director proposes to use a one-way test for claim correspondence because correspondence is a provisional rejection based on 35 U.S.C. 102(g). The count defines the scope of admissible proofs for proving priority and thus, in theory, defines a single inventive concept based on the claims of the parties. An adverse determination of priority for the invention of the count would be the basis for the rejection under section 102(g) or section 103.

The claims that correspond to the count are the ''claims involved'' in the interference as that phrase is used in 35 U.S.C. 135(a). Claim correspondence identifies the parties' claims that are at risk in the event of an adverse judgment on priority such that they will be finally refused (involved application claims) or cancelled (involved patent claims) by virtue of the judgment as required under section 135(a). If a party loses on priority with respect to the subject matter of a count, the party would not be entitled to a claim that is anticipated by (section 102(g)) or obvious in view of (section 103) the subject matter of the lost count. Since correspondence is effectively a provisional rejection under section 102(g), only a one-way test is required to determine which claims would be at risk (*e.g.,* In re Saunders, 219 F.2d 455, 104 USPQ 394 (CCPA 1955) (generic claim unpatentable in view of lost count to species)).

The current rules use both count-based and claim-based correspondence. Compare Rules 603, 606, and 637(c)(2)(ii) (count based) with Rules 637(c)(3)(ii) and (c)(4)(ii) (claim based). The principal virtue of claim-based correspondence is that it clearly reflects the implicit rejection of the corresponding claim based on 35 U.S.C. 102(g). A rejection based on § 102(g) must look to the invention of another.

Ordinarily in proceedings before the Office, a determination of the invention must be based on what is claimed. 35 U.S.C. 112[2]. A claim is not a prerequisite for a rejection under section 102(g), however (*e.g., Apotex USA, Inc.* v. *Merck & Co., Inc.,* 254 F.3d 1031, 59 USPQ2d 1139 (Fed. Cir. 2001) (prior invention of another not based on a claim)). It has long been the practice to determine priority in an interference based on a count, which might not even be fully supported by the disclosure of either party, *Aelony* v. *Arni,* although other patentability determinations must be based on claims, In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The count is understood be the common inventive concept of the parties.

Both claim-based and count-based correspondence rest on the assumptions that the claim or count on which correspondence is based defines a single inventive concept and that any obviousness relationship between the proof of priority and a corresponding claim is not too attenuated. Either of these problems can be addressed by filing an appropriate motion regardless of the basis on which correspondence is determined.

In cases where the count is closely based on actual claims and where the number of claims is small, there is generally very little practical difference between claim-based and count-based correspondence. In cases involving very large numbers of claims, however, claim-based correspondence places a huge burden on a party seeking to have a claim designated as not corresponding because a comparison must be made with every single corresponding claim. Count-based correspondence would make analysis of claim correspondence easier by providing a single point of reference—the count—for determining correspondence. Moreover, by basing correspondence exclusively on the count, the proposed rule would make the basis for claim correspondence consistent with the basis for the priority determination.

The presumption in proposed § 41.207(c) would restate the presumption in Rule 637(a) that prior art cited against an opponent is presumed to apply against the movant's claims. Note that the proposed rule would clarify the current practice by not triggering the presumption unless the motion is granted with respect to an opponent's claim. Although the proposed rule would omit the reference to priority statements, a party could not rely on its notice of requested relief as evidence, see proposed § 41.120(b), so the repetition in this section would not be necessary.

The presumption of abandonment after one year in proposed § 41.207(d) would be new. It is modeled after the one-year statutory bars (*e.g.,* 35 U.S.C. 102(b), 102(d), and 135(b)) and other incentives for prompt filing (*e.g.,* 35 U.S.C. 119(a) and 273(b)(1)). The presumption is intended to encourage prompt filing of patent applications and to help parties facing the issue by simplifying the analysis of an apparent abandonment, suppression, or concealment. An invention, though completed, is deemed abandoned, suppressed, or concealed if, within a reasonable time after completion, no steps are taken to make the invention publicly known. For example, failure to file a patent application, to describe the invention in a publicly disseminated document, or to use the invention publicly, has been held to constitute abandonment, suppression, or concealment. *Correge* v. *Murphy,* 705 F.2d 1326, 1330, 217 USPQ 753, 756 (Fed. Cir. 1983). The case law does not give definitive guidance on when abandonment, suppression, or concealment has occurred. This uncertainty makes it harder to determine what evidence to present in order to show an abandonment, suppression or concealment; and to determine in close cases whether abandonment, suppression, or concealment has occurred. Although this presumption is designed to encourage prompt filing, it does not exclude rebuttal proofs of continuing activity other than filing, such as those listed in the Correge decision.

Proposed § 41.208(a) would focus substantive motions on the core questions of priority.

Proposed § 41.208(b) would place the burden of proof on the movant and would provide guidance on how to satisfy the burden of going forward.

Proposed § 41.208(c) would set forth some guidance to parties about specific motions, but would not attempt to list all possible substantive requirements for each motion, nor would it exhaustively list all possible kinds of motions. In practice, interference practice has proved too varied to permit an exhaustive list. The specific requirements of the analogous Rule 637 have proved both over-inclusive, see Chief Admin. Pat. J., ''Interference Practice—Interference Rules Which Require a Party to 'Show the Patentability' of a Claim'', 1217 Official Gaz. 17 (USPTO 1998) (limiting the scope of showings), and under-inclusive, see *Hillman* v. *Shyamala,* 55 USPQ2d 1220, 1221 (BPAI 2000) (holding the required showings to be insufficient). Ultimately, the movant would have to justify the relief sought substantively, which means compliance with statutes, rules, and case law that could never be fully replicated in a rule governing the content of motions.

Substantive motions in an interference essentially ask three questions. First, should the proceeding reach the question of priority at all? Second, what is the scope of the proofs necessary and proper for proving priority and what claims must be cancelled in the event of an adverse judgment? Third, which party will lose the determination of priority? While final judgment is possible on a wide array of issues, the fundamental purpose of an interference is to determine priority. Consequently, substantive motions without some nexus to an ultimate question of priority would not ordinarily be considered. For example, a motion that a claim is unpatentable might be dismissed if it does not affect a party's standing, the scope of the count, or the accorded benefit.

The first question implicates the three ''threshold issues'' that are ordinarily taken up early because they affect a party's standing in an interference. *Berman* v. *Housey,* 291 F.3d 1345, 1352, 63 USPQ2d 1023, 1028 (Fed. Cir. 2002) (endorsing the Board practice of early determination of threshold issues). These threshold issues are no interference-in-fact, repose under 35 U.S.C. 135(b), and lack of written description supporting claims added to provoke an interference. Threshold issues present a movant with an opportunity to escape the burdens of a full-scale interference. A party that failed to request such relief early would not ordinarily receive an early determination. The practice of deciding threshold issues early evolved to address abuses on the part of some applicants provoking interferences.

An attack on standing must necessarily be effective with respect to all of an opponent's claims on which the determination of interference-in-fact depends; otherwise, it would really be some other type of motion, such as a motion to change the count, claim correspondence, or accorded benefit. Occasionally, more than one threshold issue might need to be raised (in separate motions) to address all involved claims. For instance, an opponent's copied claims might lack written description, while its other corresponding claims would not in fact interfere. Issues other than threshold issues could also affect standing, but would rarely be taken up early because they have less connection with the

threshold determination of whether the Director is of the opinion that an interference exists.

Proposed § 41.208(c)(1) would set forth guidance on filing a motion for judgment of no interference-in-fact. The proposed rule would require a showing that the test for an interference under proposed § 41.203(a) is not met. The showing must be for all claims because a single claim of each party is sufficient to support the Director's opinion that an interference exists in fact.

Proposed § 41.208(c)(2) would set forth guidance on filing a motion for judgment that a patentee is entitled to repose under 35 U.S.C. 135(b). Section 135(b) has two aspects. It is a statute of repose, *Berman* v. *Housey,* 291 F.3d 1345, 1351, 63 USPQ2d 1023, 1027 (Fed. Cir. 2002), and a statutory bar, In re McGrew, 120 F.3d 1236, 1238–39, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997). As a statute of repose, it presents a threshold issue; otherwise, it is simply an attack on patentability. To be a threshold issue, the motion must satisfy two conditions. First, the party moving for repose must be the patentee or published applicant entitled to repose under the statute. Second, it must apply (possibly in combination with other threshold issues) to all of an opponent's involved claims; otherwise, the interference would continue whether the motion is granted or not. If either condition is not met, the motion would be treated as a motion for unpatentability, but not as a threshold issue.

Proposed § 41.208(c)(3) would set forth general guidance for attacking patentability. This guidance would apply to a non-threshold motion alleging unpatentability under 35 U.S.C. 135(b) in view of non-party's patent or published application. A motion attacking patentability could be a threshold issue (*e.g.,* an attack on the written description of a copied claim), an effort to change the count (by showing that claims within the scope of the count are not patentable over prior art), or a priority issue, depending on the claims attacked and the basis for the attack. Note that because counts would continue to be used, the Board would continue the practice of ordinarily either not authorizing the filing of, or deferring any decision on, a patentability motion that raises questions of priority or derivation during the first part of the interference. Generally motions attacking patentability under 35 U.S.C. 102(a), 102(e), 102(f), or 102(g) will be deferred, in whole or in part. This practice does not, however, relieve a party of its obligation to state these grounds as bases for relief when required.

The second set of substantive questions would involve changes to the scope of the count, claim correspondence, and accorded benefit. Motions under proposed § 41.208(c)(3) attacking the patentability of claimed subject matter within the scope of the count might also fall within this category if they have the effect of narrowing the count.

Proposed § 41.208(c)(4) would set forth guidance for some common motions to change the count. If the count changes, no change in accorded benefit will be presumed; it would have to be established in a contingent motion to change benefit. Proposed § 41.208(c)(4)(i) would restate the requirement of Rule 637(c)(1)(v) to show that counts are separately patentable. Proposed § 41.208(c)(4)(ii)(C) would codify the practice in *Louis* v. *Okada,* 59 USPQ2d 1073, 1076 (BPAI 2001), which required a movant seeking to broaden a count to cover its best proof of priority to proffer that proof so the Board could evaluate the merits of the motion.

Proposed § 41.208(c)(5) would set forth guidance for parties moving to change claim correspondence. Proposed § 41.208(c)(5)(i) would require that any added claim be patentable and correspond to the count. A motion to add a claim that did not correspond to the count would in effect be a request for an advisory action, which the Board would not ordinarily give. A patentee could not use a reissue application to circumvent this requirement that all claims in an interference must correspond to the count. *Winter* v. *Fujita,* 53 USPQ2d 1234, 1249 (BPAI 1999). The proposed rule could be used to compel an opponent to add a claim to its involved application or patent. Note that patentee cannot be literally compelled to file a reissue application for any reason, including to add a claim. *Green* v. *Rich Iron Co.,* 944 F.2d 852, 854, 20 USPQ2d 1075, 1076–77 (Fed. Cir. 1991). The consequence of an opponent's refusal to add a claim, however, may be a concession of priority with respect to the subject matter that the patentee refuses to add. See Rule 605(a); cf. In re Ogiue, 517 F.2d at 1390, 186 USPQ at 235 (an applicant surrenders the subject matter of a claim it refuses to copy); proposed § 41.202(c). The remainder of proposed § 41.208(c)(5) would restate the correspondence test in terms of a one-way test for patentability in which the subject matter of the count is used as the primary reference.

Proposed § 41.208(c)(6) would restate the test for according benefit of an application in terms of recognition for a constructive reduction to practice. In doing so, the test would avoid confusion with the related, but distinct, tests for benefit of a disclosure for the purposes of 35 U.S.C. 119, 120, 121, and 365. Note that a constructive reduction to practice relates to the count, not a claim. Moreover, the showing for a constructive reduction to practice would generally be narrower because only a single embodiment is necessary to anticipate a count. By contrast, § 120 incorporates the requirements of 35 U.S.C. 112[1], which include disclosure of sufficient embodiments to support the full scope of a claim. See *Cromlish* v. *D.Y.,* 57 USPQ2d 1318 (BPAI 2000) (discussing this difference).

Proposed § 41.208(c)(7) would permit the Board to require additional showings. For example if a party had copied a claim and during the interference proposed to argue that its opponent's claim was indefinite under 35 U.S.C. 112[2], the Board could require the movant to explain why its copied claim was not also indefinite.

Proposed § 41.208(d) would require the use of claim charts whenever a claim is being compared to something else. Claim charts are often the most effective way to present the comparison convincingly. Claim charts would not, however, be a substitute for argument since the comparison would generally require additional explanation. The proposed rule would refer to a ''paper'' rather than a ''motion'' because such comparisons can arise in oppositions and even replies.

Regulatory Flexibility Act

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 under the provisions of section 605(b) of the Regulatory Flexibility Act that this proposed rule making will not have a significant economic impact on a substantial number of small entities.

Executive Order 13132

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

Paperwork Reduction Act

This proposed 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 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 proposes to amend 37 CFR chapter I as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for Part 1 continues to read as follows:

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

§ 1.1 [Amended]

2. Remove and reserve § 1.1(a)(1)(iii).

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).

§ 1.6 [Amended]

5. Remove and reserve § 1.6(d)(9).

§ 1.8 [Amended]

6. Remove and reserve § 1.8(a)(2)(i)(B) and (a)(2)(i)(C).

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 § 1.14, revise paragraph (e) to read as follows:

§ 1.14 Patent applications preserved in confidence.

* * * * *

(e) *Decisions on petition.* (1) Any decision on petition is available for public inspection without applicant's or patent owner's permission if rendered in a file open to the public pursuant to § 1.11 or in an application that has been published in accordance with §§ 1.211 through 1.221. The Office may independently publish any decision that is available for public inspection.

(2) Any decision on petition not publishable under paragraph (e)(1) of this section may be published or made available for public inspection if the Director believes that special circumstances warrant publication and the applicant does not, within two months after being notified of the intention to make the decision public, object in writing on the ground that the decision discloses a trade secret or other confidential information and states that such information is not otherwise publicly available. If a decision discloses such information, the applicant shall identify the deletions in the text of the decision considered necessary to protect the information. If the applicant considers that the entire decision must be withheld from the public to protect such information, the applicant must explain why. The applicant will be given time, not less than twenty days, to request reconsideration and seek court review before any contested portion of a decision is made public over its objection. See § 2.27 for trademark applications.

* * * * *

9. In § 1.17, remove and reserve paragraphs (b)–(d), and revise paragraph (h) to read as follows:

§ 1.17 Patent application and reexamination processing fees.

* * * * *

(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 and return 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.

* * * * *

10. 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 the applicant for patent (§ 1.41(b)) or the assignee of the entire interest. 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(b)(2)(iii)), the practitioners so appointed will also be notified of the revocation of the power of attorney when the power of attorney to 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 may revoke previous powers and give another power of attorney as provided in § 1.32(b) of the assignee's own selection. See § 41.5 of this title for proceedings before the Board of Patent Appeals and Interferences.

(b) A registered patent attorney or patent agent who has been given a power of attorney pursuant to § 1.32(b) may withdraw 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 and insufficient time remains for the applicant to file a reply. See § 41.5(c) of this title for withdrawal in a proceeding before the Board of Patent Appeals and Interferences.

11. Amend § 1.48 to revise paragraphs (a)–(c) and (i), and to add 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.

12. 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.

* * * * *

13. 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 and returned, except as provided in paragraph (b) of this section or § 41.7(a) of this title.

* * * * *

14. 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.

15. 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).

16. 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 applicants, 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.

* * * * *

17. 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.

* * * * *

18. Revise § 1.116 to read as follows:

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

(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 with any appeal (§ 41.31 or § 41.61).

(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;

(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).

(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).

(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 with any appeal (§ 41.31 or § 41.61), 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).

(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).

19. 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 that claims interfering subject matter as defined in § 41.203(a) of this title, in which case an applicant may suggest an interference pursuant to § 41.202(a); or

* * * * *

20. 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.

* * * * *

21. 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.

* * * * *

22. 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, subpart B, of this title.

§§ 1.192–1.196 [Removed and reserved]

23. Remove and reserve §§ 1.192–1.196.

24. Revise § 1.197 to read as follows:

§ 1.197 Return of Jurisdiction from the Board of Patent Appeals and Interferences; termination of proceedings.

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

25. 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 without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

26. In § 1.248, revise paragraph (c) to read as follows:

§ 1.248 Service of papers; manner of service; proof of service in cases.

* * * * *

(c) See § 41.105(f) of this title for service of papers in contested cases before the Board of Patent Appeals and Interferences.

27. 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.

28. 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.

29. 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.

* * * * *

30. 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.

* * * * *

31. 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.

* * * * *

32. 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) of this title.

* * * * *

33. 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) of this title.

34. In § 1.324, revise paragraphs (a) and (c), and 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) of this title.

* * * * *

(c) For correction of inventorship in an application, see §§ 1.48 and 1.497, and in a contested case before the Board of Patent Appeals and Interferences, see § 41.121(a)(2) of this title.

(d) *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 a patent must be in the form of a motion under § 41.121(a)(2) of this title.

35. 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.

§§ 1.601–1.690 (Subpart E) [Removed and reserved]

36. Remove and reserve subpart E, consisting of §§ 1.601 through 1.690, of part 1.

37. 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;

* * * * *

38. 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 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.

* * * * *

39. 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;

* * * * *

40. 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, subpart C, of this title.

§§ 1.961–1.977 [Removed and reserved]

41. Remove and reserve §§ 1.961–1.977.

42. 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 termination of the appeal before the Board of Patent Appeals and Interferences (§ 41.83), 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.

43. 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 without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

44. 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

45. 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. 2751 *et seq.*; the Atomic Energy Act of 1954, as amended, 42 U.S.CX. 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 of the Commissioner (15 CFR 3701.10(j), 22 CFR 125.04, and 10 CFR 810.7).

45a. 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)), but the Office will not act on the request while the application remains under a secrecy order.

* * * * *

PART 10—REPRESENTATION OF OTHERS BEFORE THE PATENT AND TRADEMARK OFFICE

46. 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.

46a. 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.

* * * * *

47. Add part 41 to read as follows:

PART 41—PRACTICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Subpart A—General Provisions

Sec.

Authority: 35 U.S.C. 2(b)(2), 3(a)(2)(A), 21, 23, 32, 41, 134, 135.

Subpart A—General Provisions

§ 41.1 Policy.

(a) *Scope.* This 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 cited in this part 41.

(b) *Construction.* The provisions of this 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:

(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 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) 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.* 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.

(c) *Scope.* This section governs all proceedings before the Board, but does not apply to Board-related proceedings outside the Board, such as:

(1) *Seeking judicial review* (see §§ 1.301–1.304 of this title) or

(2) *Extensions during prosecution* (see § 1.136 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 patent 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.

(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.* The Board may refer a question arising under paragraphs (a) or (b) of this section to the Director of Enrollment and Discipline for action.

§ 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 through 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 termination of 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 §§ 1.211–1.221 of this title.

§ 41.7 Management of the record.

(a) The Board may expunge any paper 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.

§ 41.8 Mandatory notices.

In an appeal (§§ 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:

(a) Its real party-in-interest, and

(b) Each judicial or administrative proceeding that could affect, or be affected by, the Board proceeding, specifically including judicial review of the Board proceeding.

§ 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.

§ 41.20 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:

(i) By a small entity (§ 1.27(a) of this title)—$165.00.

(ii) 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:

(i) By a small entity (§ 1.27(a) of this title)—$165.00.

(ii) 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:

(i) By a small entity (§ 1.27(a) of this title)—$145.00

(ii) By other than a small entity—$290.00.

Subpart B—Ex parte Appeals to the Board

§ 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:

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.

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.

§ 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 or finally (§ 1.113 of this title) rejected, may appeal 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 or 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.

(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)–(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 submitted after the date the proceeding has been appealed pursuant to § 41.31(a)(1)–(a)(3) 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.

(b) All other amendments submitted after the date the proceeding has been appealed 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).

(c) Affidavits or other evidence submitted after the date the proceeding has been appealed 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).

§ 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 proceeding.

(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 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 claim involved in the appeal, 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 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, 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 with any appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of 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 §§ 41.31–41.37 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 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 with any appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of 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 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) 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. The primary examiner may only rely on argument and evidence relied upon in an answer or a supplemental answer.

(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 exercise one of the following two options to avoid sua sponte dismissal of the appeal as to all claims under appeal:

(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 (§ 41.56) as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or showing of facts not previously of record 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 §§ 41.31 through 41.56.

(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 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) Appellant may file a single request for rehearing within 2 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. Except for arguments responding to a new ground of rejection made pursuant to § 41.50(b), 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. 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.

(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.

§ 41.56 Termination of appeal.

An appeal under this subpart is terminated by the dismissal of the appeal or when, after a final Board action:

(a) A notice of appeal under 35 U.S.C. 141 is filed,

(b) A civil action under 35 U.S.C. 146 is commenced, or

(c) The time for seeking judicial review (§ 1.304 of this title) has expired.

Subpart C—Inter Partes Appeals to the Board

§ 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:

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 of this part.

Owner means the owner of the patent undergoing *inter partes* reexamination under § 1.915 of this title.

Requester means each party, other than the owner, who requested that the patent undergo *inter partes* reexamination under § 1.915 of this title.

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.

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.

Filing means filing with a certificate indicating service of the document under § 1.903 of this title.

§ 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 submitted after the date the proceeding has been appealed 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 submitted after the date the proceeding has been appealed pursuant to § 41.61 will not be admitted except as permitted by § 41.77(b)(1).

(c) Affidavits or other evidence submitted after the date the proceeding has been appealed 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 proceeding.

(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, the expiration of 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) A party's appeal shall stand dismissed upon failure of that party 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 claim involved in the appeal, 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 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, 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 with any appeal and § 41.63 for amendments, affidavits or other evidence after the date of 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 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, 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 with any appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of 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 §§ 41.61–41.68 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 with any appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of 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 with any appeal and § 41.63(c) for affidavits or other evidence filed after the date of 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)–(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 and 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) 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. The primary examiner may only rely on argument and evidence relied upon in an answer. The Board will determine the order of the arguments presented at the oral hearing.

(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, a showing of facts 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 showing of facts 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) 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 for arguments responding to a new ground of rejection made pursuant to § 41.77(b).

(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.

§ 41.83 Termination of appeal.

An appeal to the Board by a party under this subpart is terminated by the dismissal of that party's appeal or when, after a final Board action:

(a) A notice of appeal under 35 U.S.C. 141 is filed, or

(b) The time for seeking judicial review (§ 1.983 of this title) has expired.

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.

Except as the Board may otherwise authorize, before a contested case is initiated:

(a) Examination of each involved application and any pending reexamination of each involved patent must be completed, and

(b) Each involved application and patent must have at least one claim that:

(1) Is patentable, and

(2) Would be involved in the contested case.

§ 41.103 Jurisdiction over involved files.

The Board has jurisdiction over any involved file from the time the Board initiates a contested case until the termination of the 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.

§ 41.105 Ex parte communications.

An ex parte communication about a contested case with a Board member or a Board employee conducting the proceeding is not permitted.

§ 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) The ink must be black or must otherwise provide an equivalently permanent, dark, high-contrast image on the paper. The quality of the 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, 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 (¼inch) holes with centers 1 cm (½ inch) from the top of the page and 7 cm (2¾ 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) *Citation of authority.*

(i) Citations to authority must include:

(A) A *United States Reports* citation for any Supreme Court case.

(B) *Parallel citation of cases* to both the West Reporter System and to the United States Patents Quarterly whenever a case is published in both. Other parallel citations are discouraged.

(C) *Pinpoint citations* whenever a specific holding or portion of an authority is invoked.

(ii) 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 (c)(4)(i) of this section, a copy of the authority should be filed with the first paper in which it is cited.

(5) *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 by mail must be addressed to Mail Stop INTERFERENCE, Board of Patent Appeals and Interferences, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313–1450. 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 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® (an expedited-delivery service of the United States Postal Service) or by means at least as fast and reliable as EXPRESS MAIL®. Electronic service is not permitted without Board authorization.

(4) The date service is received 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 name of each paper served,

(ii) The date and manner of service, and

(iii) The name and address of every person served.

(4) A certificate made by a person other than a registered patent practitioner must be in the form of an affidavit.

§ 41.107 [Reserved]

§ 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).

§ 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 amend a claim or add a reissue claim must include an addendum containing a clean set of the claims and, where applicable, an addendum containing 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) 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, add, or cancel 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 in support of the motion in short numbered paragraphs, with specific citations to the portions of the record that support each fact, 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.

(4) *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 will be considered admitted.

(d) *Board-ordering briefings.* The Board may order briefing on any issue that could be raised by motion.

§ 41.122 New arguments in opposition or reply.

All arguments for the relief requested must be made in a motion. An opposition may raise new arguments, but only in response to arguments made in the corresponding motion. A reply may only respond to arguments raised in the corresponding opposition.

§ 41.123 Time for acting on motions.

(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 within 30 days of 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.

§ 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 a hearing is set for a panel, the movant on any issue to be heard 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 the request is granted, each party will have 20 minutes to present its argument, 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 terminating the proceeding 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 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 request 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. The Board may toll the time for seeking judicial review (35 U.S.C. 142 and 146[1]) for the pendency of the rehearing.

§ 41.128 Termination.

A contested case is terminated after a final Board action, as soon as any of the following occur:

(a) A notice of appeal under 35 U.S.C. 141 is filed,

(b) A civil action under 35 U.S.C. 146 is commenced, or

(c) The time for seeking judicial review has expired.

§ 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, 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.* 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.

§ 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.

§ 41.153 Records of the United States Patent and Trademark 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 objects. 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.

§ 1.155 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.

(c) 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.

§ 41.157 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 C 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).

Constructive reduction to practice means description and enablement of an embodiment within the scope of the interfering subject matter in a patent application.

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.

Earliest constructive reduction to practice means the first constructive reduction to practice that has been continuously disclosed through a chain of patent applications culminating 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).

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.

§ 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 and show how they should 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 enabling description of an embodiment within the scope of the interfering subject matter.

(b) *Patentee.* A patentee cannot suggest an interference under this section, but may file a protest to the extent permitted under § 1.291 of this title to draw the examiner's attention to a potential 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. 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.* A showing of priority under this section is not sufficient unless it would, if unrebutted, support with adequate evidence a determination of priority in favor of the party making the showing.

§ 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) *Additional patent, application, or interference.* 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).

§ 41.204 Notice of basis for relief.

(a) *Priority statement.* Each party that will submit evidence of its priority apart from its accorded benefit must file a statement alleging with particularity facts that, if proved, would be sufficient for it to establish an earlier date of conception or an earlier actual reduction to practice. The statement must include all bases on which the party intends to establish its entitlement to a judgment on priority and must include documentary support for each basis when the documentary support is a unique record under the control of the party or its real party-in-interest. Failure of a junior party to file a sufficient priority statement will be treated as an abandonment of contest absent a showing of good cause.

(b) *Other substantive motions.* For each substantive motion that a party will file, the Board may require a statement of basis for the relief the party seeks.

(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 (§ 41.128) of the interference between the parties to the agreement.

(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 terminate, 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 with supporting evidence.

(d) *Abandonment, suppression, or concealment.* A party is presumed to have abandoned, suppressed, or concealed the interfering subject matter if the accorded date of the party's earliest constructive reduction to practice is more than one year after the party's actual reduction to practice. A party subject to this presumption must show in its motion for priority that it did not abandon, suppress, or conceal its invention.

§ 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 count 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) *Specific motions* that may be authorized, along with necessary content for each, include:

(1) *No interference-in-fact.* A party moving for judgment because the involved claims do not, in fact, claim interfering subject matter must, for each of its involved claims, show that the subject matter of the claim does not interfere within the meaning of § 41.203(a) with the subject matter of any involved claim of an opponent.

(2) *Repose under 35 U.S.C. 135(b).* A party moving for repose under 35 U.S.C. 135(b) must:

(i) Identify the claims of the movant's United States patent or published application claiming the same or substantially the same invention as is claimed in an opponent's involved claim, and

(ii) Show the opponent did not make such a claim prior to one year from the grant of the patent or the publication of the application.

(3) *Unpatentability of a claim.* A party moving for a decision that an opponent's claim is not patentable to the opponent must:

(i) Identify the legal basis for unpatentability,

(ii) Show why each claim alleged to be unpatentable fails to satisfy the substantive requirements of the legal basis identified, and

(iii) For arguments involving prior art, explain why the movant's claims corresponding to the same count as the opponent's claim are not unpatentable in view of the prior art.

(4) *Adding or substituting a count.* (i) The movant must show why the proposed count does not define the same invention within the meaning of § 41.203(a) as any other count, including the count it would replace.

(ii) *To broaden a count* to include subject matter not in the current count, the movant must:

(A) Show that the proposed count does not include prior art subject matter,

(B) Show that the additional subject matter interferes within the meaning of § 41.203(a) with subject matter in an opponent's involved claim, and

(C) Show why the change is necessary to a priority determination. If the change is necessary to include the movant's best proof of priority, the movant must proffer that proof with an explanation of why it does not fall within the scope of the current count.

(5) *Changing claim correspondence.*—(i) *To add a claim.* A party moving to add a claim to an involved patent or application must show that the subject matter of the count would have anticipated or rendered obvious the subject matter of the added claim and that the added claim would be patentable in the patent or application. The showing of patentability must include a showing of where the disclosure of the patent or application provides written description of the subject matter of the claim.

(ii) *To designate a claim as corresponding to a count.* A party moving to have a claim designated as corresponding to a count must show that the subject matter of the count would have anticipated or rendered obvious the subject matter of the claim.

(iii) *To designate a claim as not corresponding to a count.* A party moving to have a claim designated as not corresponding to a count must show that:

(A) The subject matter of the count would not have anticipated or rendered

obvious the subject matter of the claim, and

(B) The claim to be designated as not corresponding to the count does not interfere within the meaning of § 41.203(a) with any claim of an opponent's involved patent or application.

(6) *Changing the accorded benefit.* A party moving:

(i) *To be accorded the benefit* of another constructive reduction to practice date must show that the application for which benefit is sought provided a constructive reduction to practice of an embodiment within the scope of the count.

(ii) *To attack the accorded benefit* of a constructive reduction to practice date accorded to an opponent must show that the application for which benefit has been accorded does not provide a constructive reduction to practice of an embodiment within the scope of the count or that the disclosure of the embodiment has not been continuous.

(7) *Other requirements.* The Board may specify additional requirements for a motion.

(d) *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.

Dated: November 12, 2003.

Jon W. Dudas,

Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office.

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