DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 41

[Docket No.: PTO–P–2007–0006]

RIN 0651–AC12

Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rule making.

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 in ex parte patent appeals. The changes are needed to permit the Board to handle an increasing number of ex parte appeals in a timely manner.

The proposed rules seek to provide examiners and Office reviewers with a clear and complete statement of an appellant's position at the time of filing an appeal brief so as to enhance the likelihood that appealed claims will be allowed without the necessity of further proceeding with the appeal, minimize the pendency of appeals before the Office, minimize the need for lengthy patent term adjustments in cases where claims become allowable as a result of an action by the Board in an appeal, provide uniform treatment of requests for an extension of time filed after an appeal brief is filed, and make the decision-making process more efficient.

DATES: Comments are solicited from interested individuals or entities. Written comments must be received on or before September 28, 2007. No public hearing will be held.

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, P.O. Box 1450, Alexandria, VA 22313–1450.

3. By facsimile to 571–273–0042.

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 is used to make a submission, the submitter should write only ''Ex parte Appeal Rules'' in the subject line to ensure prompt consideration of any comments.

Because 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.

FOR FURTHER INFORMATION CONTACT: Fred E. McKelvey or Allen R. MacDonald at 571–272–9797.

SUPPLEMENTARY INFORMATION:

Explanation of Proposed Changes

Existing rules in Part 1 are denominated as ''Rule x'' in this supplementary information. A reference to Rule 136(a) is a reference to 37 CFR 1.136(a) (2006).

Existing rules in Part 41 are denominated as ''Bd.R. x'' in this supplementary information. A reference to Bd.R. 41.3 is a reference to 37 CFR 41.3 (2006).

Proposed rules are denominated as ''Proposed Bd.R.'' in this supplementary information.

The Board has jurisdiction to consider and decide ex parte appeals in patent applications (including reissue, design and plant patent applications) and ex parte reexamination proceedings.

The Board is currently experiencing a large increase in the number of ex parte appeals. In FY 2006, the Board received 3,349 ex parte appeals. In FY 2007, the Board expects to receive more than 4,000 ex parte appeals. In FY 2008, the Board expects to receive over 5,000 ex parte appeals. These rules are proposed to change procedures in such a way as to allow the Board to continue to resolve ex parte appeals in a timely manner.

The proposed rules do not propose to change any of the rules relating to inter partes reexamination appeals. Nor do the proposed rules propose to change any of the rules relating to contested cases.

In some instances, the rules propose to adopt practices similar to those of the Court of Appeals for the Federal Circuit. For example, an appendix would be required, page limits would be set, and a table of contents and a table of authorities would be required in briefs.

Discussion of Specific Rules

Definitions

Proposed Bd.R. 41.2 would revise Bd.R. 41.2 to eliminate from the definition of ''Board'' any reference to a proceeding under Bd.R. 41.3 relating to petitions to the Chief Administrative Patent Judge. The Director has delegated authority to the Chief Administrative Patent Judge to decide petitions under Bd.R. 41.3. See Manual of Patent Examining Procedure, § 1002.02(f) (8th ed., Aug., 2006).

Proposed Bd. R. 41.2 would also revise Bd.R. 41.2 to eliminate a petition under Proposed Bd.R. 41.3 from the definition of contested case. At the present time, there are no petitions authorized in a contested case.

Petitions

Bd.R. 41.3 would be revised to include a delegation of authority from the Director to the Chief Administrative Patent Judge to decide certain petitions authorized by Part 41 as proposed to be revised. The delegation of authority would be in addition to that already set out in Manual of Patent Examining Procedure, § 1002.02(f) (8th ed., Aug., 2006). The petitions would include (1) seeking an extension of time to file certain papers after an appeal brief is filed in an ex parte appeal, and (2) to enlarge the page limit of an appeal brief, reply brief, supplemental reply brief or request for rehearing.

Proposed Bd.R. 41.3(a) would require that a copy of any petition be forwarded to the Chief Administrative Patent Judge, so as to minimize any chance that a petition may be overlooked.

Proposed Bd.R. 41.3(b) would define the scope of petitions which can be filed pursuant to the rules. Under Proposed Bd.R. 41.3(b), a petition could not be filed to seek review of issues committed by statute to a panel. *See, e.g., In re Dickinson,* 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962).

Timeliness of Petitions

Proposed Bd.R. 41.4(c) would be revised to add the phrase ''Except to the extent provided in this part'' and to revise paragraph 2 to read: ''Filing of a notice of appeal and an appeal brief (see §§ 41.31(c) and 41.37(c)).'' The revision would restrict Proposed Bd.R. 41.4(c)(2) to the notice of appeal and appeal brief. The Chief Administrative Patent Judge would determine whether extensions are to be granted for the filing of most other papers during the pendency of the appeal.

Definitions

Proposed Bd.R. 41.30 would be revised to add a definition of ''record on appeal.'' The record on appeal would consist of (1) the specification, (2) drawings (if any), (3) U.S. patents cited by the examiner or appellant, (4) published U.S. applications cited by the examiner or appellant, (5) the appeal brief, including all appendices, (6) the examiner's answer, (7) any reply brief, including any supplemental appendix, (8) any supplemental examiner's

answer, (9) any supplemental reply brief, (10) any request for rehearing, (11) any order or decision entered by the Board or the Chief Administrative Patent Judge, and (12) any other document or evidence which was considered by the Board as indicated in any opinion accompanying any order or decision. The definition would advise applicants of what documents the Board would consider in resolving the appeal. The definition would also make it clear to any reviewing court what record was considered by the Board.

Appeal to Board

Proposed Bd.R. 41.31(a) would provide that an appeal is taken from a decision of the examiner to the Board by filing a notice of appeal. The following language would be acceptable under the rule as proposed: ''An appeal is taken from the decision of the examiner entered [specify date appealed rejection was entered].'' An appeal can be taken when authorized by the statute. 35 U.S.C. 134. The provision of Bd.R. 41.31(b) that a notice of appeal need not be signed has been removed. Accordingly, if promulgated, Proposed Bd.R. 41.31 would no longer provide that a notice of appeal need not be signed. Instead, papers filed in connection with an appeal, including the notice of appeal, would need to be signed.

Proposed Bd.R. 41.31(b) would require that the notice of appeal be accompanied by the fee required by law and would refer to the rule that specifies the required fee.

Proposed Bd.R. 41.31(c) would specify the time within which a notice of appeal would have to be filed in order to be considered timely. The time for filing a notice of appeal appears in Rule 134.

Proposed Bd.R. 41.31(d) would provide that a request for an extension of time to file a notice of appeal in an application is governed by Rule 136(a). Proposed Bd.R. 41.31(d) would also provide that a request for an extension of time to file a notice of appeal in an ex parte reexamination proceeding is governed by Rule 550(c).

Proposed Bd.R. 41.31(e) would define a ''non-appealable issue'' as an issue that is not subject to an appeal under 35 U.S.C. 134. Non-appealable issues are issues (1) over which the Board does not exercise authority in appeal proceedings and (2) which are handled by a petition. Non-appealable issues include such matters as an examiner's refusal to (1) enter a response to a final rejection, (2) enter evidence presented after a final rejection, (3) enter an appeal brief or a reply brief, or (4) withdraw a restriction requirement. The proposed rules contemplate that some petitions relating to non-appealable issues are to be decided by the Chief Administrative Patent Judge. Some of those non-appealable issues include: (1) A petition to exceed page limit and (2) a petition to extend time for filing a paper in the appeal after the filing of the appeal brief. An applicant or patent owner dissatisfied with a decision of an examiner on a non-appealable issue would be required to seek review by petition before an appeal is considered on the merits. Failure to timely file a petition seeking review of a decision of the examiner related to a non-appealable issue would generally constitute a waiver to have those issues considered. The language ''[f]ailure to timely file'' would be interpreted to mean not filed within the time set out in the rules. The object of the rule, as proposed, would be to maximize resolution of non-appealable issues before an appeal is considered on the merits. Under current practice, an applicant or a patent owner often does not timely seek to have non-appealable issues resolved thereby necessitating a remand by the Board to the examiner to have a non-appealable issue resolved. The remand adds to the pendency of an application or reexamination proceeding and, in some instances, may unnecessarily enlarge patent term adjustment. The Office would intend to strictly enforce the waiver provisions of Proposed Bd.R. 41.31(e), if promulgated, with the view of making the appeal process administratively efficient. While the Office will retain discretion to excuse a failure to timely settle non-appealable issues, it is expected that exercise of that discretion will be reserved for truly unusual circumstances.

Amendments and Evidence Filed After Appeal and Before Brief

Proposed Bd.R. 41.33(a) would provide that an amendment filed after the date a notice of appeal is filed and before an appeal brief is filed may be admitted as provided in Rule 116.

Proposed Bd.R. 41.33(b) would give the examiner discretion to permit entry of an amendment filed with or after an appeal brief is filed under two circumstances. A first circumstance would be to cancel claims, provided cancellation of claims does not affect the scope of any other pending claim in the proceedings. A second circumstance would be to rewrite dependent claims into independent form.

Proposed Bd.R. 41.33(c) would provide that all other amendments filed after the date of an appeal brief is filed will not be admitted, except as permitted by (1) Proposed Bd.R. 41.39(b)(1) (request to reopen prosecution after new rejection in an examiner's answer), (2) Proposed Bd.R. 41.50(b)(1) (request to reopen prosecution after entry of a supplemental examiner's answer following a remand by the Board), (3) Proposed Bd.R. 41.50(d)(1) (request to reopen prosecution after entry of new rejection by the Board), and (4) Proposed Bd.R. 41.50(e) (amendment after recommendation by the Board).

Proposed Bd.R. 41.33(d) would provide that evidence filed after a notice of appeal is filed and before an appeal brief is filed may be admitted (1) if the examiner determines that the evidence overcomes some or all rejections under appeal and (2) appellant shows good cause why the evidence was not earlier presented. The first step in an analysis of whether evidence may be admitted is a showing of good cause why the evidence was not earlier presented. The Office has found that too often an applicant or a patent owner belatedly presents evidence as an afterthought and that the evidence was, or should have been, readily available. Late presentation of evidence is not consistent with efficient administration of the appeal process. Under the rule, as proposed, the Office would strictly apply the good cause standard. *Cf. Hahn* v. *Wong*, 892 F.2d 1028, 13 USPQ2d 1313 (Fed. Cir. 1989). For example, a change of attorneys at the appeal stage or an unawareness of the requirement of a rule would not constitute a showing of good cause. If good cause is not shown, the analysis ends and the evidence would not be admitted. In those cases where good cause is shown, a second analysis will be made to determine if the evidence would overcome all rejections. Even where good cause is shown, if the evidence does not overcome all rejections, the evidence would not be admitted. Alternatively, the examiner could determine that the evidence does not overcome all the rejections and on that basis alone could refuse to admit the evidence.

Proposed Bd.R. 41.33(e) would provide that evidence filed after an appeal brief is filed will not be admitted except as permitted by (1) Proposed Bd.R. 41.39(b)(1) (request to reopen prosecution after new rejection in examiner's answer), (2) Proposed Bd.R. 41.50(b)(1) (request to reopen prosecution after entry of a supplemental examiner's answer following a remand by the Board), and (3) Proposed Bd.R. 41.50(d)(1) (request

to reopen prosecution after new rejection entered by the Board).

Jurisdiction Over Appeal

Proposed Bd.R. 41.35(a) would provide that the Board acquires jurisdiction upon entry of a docket notice by the Board. At an appropriate time after proceedings are completed before the examiner, a docket notice would be entered in the application or reexamination proceeding file and sent to the appellant. By delaying the transfer of jurisdiction until the appeal is fully briefed and the position of the appellant is fully presented for consideration by the examiner and the Office reviewers (appeal conferees), the possibility exists that the examiner will find some or all of the appealed claims patentable without the necessity of proceeding with the appeal and invoking the jurisdiction of the Board. For this reason, jurisdiction should transfer to the Board only after (1) the appellant has filed an appeal brief, (2) the examiner has entered an answer, and (3) the appellant has filed a reply brief or the time for filing a reply brief has expired. The current rule (Bd.R. 41.35(a)) provides that the Board acquires jurisdiction upon transmittal of the file, including all briefs and examiner's answers, to the Board. However, under the current practice, an appellant may or may not know the date when a file is transmitted to the Board. Most files are now electronic files (Image File Wrapper or IFW file) as opposed to paper files. Accordingly, a paper file is no longer transmitted to the Board. Under current practice, the Board prepares a docket notice which is (1) entered in the IFW file and (2) sent to appellant. Upon receipt of the docket notice, appellant knows that the Board has acquired jurisdiction over the appeal. Proposed Bd.R. 41.35(a) essentially would codify current practice and establish a precise date, known to all involved, as to when jurisdiction is transferred to the Board.

Proposed Bd.R. 41.35(b) would provide that the jurisdiction of the Board ends when the Board (1) orders a remand, or (2) enters a final decision and judicial review is timely sought, or (3) enters a final decision and the time for seeking judicial review has expired. There are two occasions when a remand is entered. First, a remand is entered when the Board is of the opinion that clarification on a point of fact or law is needed. *See* Proposed Bd.R. 41.50(b). Second, a remand is entered when an appellant elects further prosecution before the examiner following entry of a new rejection by the Board. *See* Proposed Bd.R. 41.50(d)(1). Upon entry of a remand the Board's jurisdiction ends. The Board also loses jurisdiction as a matter of law when an appeal to the Federal Circuit is filed in the USPTO. *See In re Allen*, 115 F.2d 936, 47 USPQ 471 (CCPA 1940) and *In re Graves*, 69 F.3d 1147, 1149, 36 USPQ2d 1697, 1698 (Fed. Cir. 1995). A final decision is a panel decision which disposes of all issues with regard to a party eligible to seek judicial review and does not indicate that further action is needed. *See* Bd.R. 41.2 (definition of ''final''). When a party requests rehearing, a decision becomes final when the Board decides the request for rehearing. A decision including a new rejection is an interlocutory, not a final, order. If an appellant elects to ask for rehearing to contest a new rejection, the decision on rehearing is a final decision for the purpose of judicial review.

Bd.R. 41.35(c) would continue current practice and provide that the Director could *sua sponte* order an appeal to be remanded to an examiner before entry of a Board decision. The Director has inherent authority to order a *sua sponte* remand to the examiner. Ordinarily, a rule is not necessary for the Director to exercise inherent authority. However, in this particular instance, it is believed that a statement in the rule of the Director's inherent authority serves an appropriate public notice function.

Appeal Brief

Proposed Bd.R. 41.37 would provide for filing an appeal brief to perfect an appeal and would set out the requirements for appeal briefs. The appeal brief is a highly significant document in an ex parte appeal. Appeal brief experience under current Bd.R. 41.37 has been mixed. Proposed Bd.R. 41.37 seeks (1) to take advantage of provisions of Bd.R. 41.37 which have proved useful, (2) clarify provisions which have been subject to varying interpretations by counsel, and (3) add provisions which are expected to make the decision-making process more focused and efficient.

Proposed Bd.R. 41.37(a) would provide that an appeal brief shall be filed to perfect an appeal. Upon a failure to timely file an appeal brief, proceedings on the appeal process would be considered terminated. The language ''without further action on the part of the Office'' would provide notice that no action, including entry of a paper by the Office, would be necessary for the appeal to be considered terminated. Proposed Bd.R. 41.37(a) would not preclude the Office from entering a paper notifying an applicant or patent owner that the appeal has been terminated. Any failure of the Office to enter a paper notifying an applicant or patent owner that an appeal stands terminated would not affect the terminated status of the appeal. The language ''proceedings are considered terminated'' would provide notice that when no appeal brief is filed, the time for filing a continuing application under 35 U.S.C. 120 would be before the time expires for filing an appeal brief.

Proposed Bd.R. 41.37(b) would provide the appeal brief shall be accompanied by the fee required by Bd.R. 41.20(b)(2).

Proposed Bd.R. 41.37(c) would provide that an appellant must file an appeal brief within two months from the filing of the notice of appeal.

Proposed Bd.R. 41.37(d) would provide the time for filing an appeal brief is extendable under the provisions of Rule 136(a) for applications and Rule 550(c) for ex parte reexamination proceedings. Consideration was given to proposing a requirement for a petition to extend the time for filing an appeal brief. However, in view of the pre-appeal conference pilot program (see Official Gazette of July 12, 2005; *http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm),* and in an effort to encourage continued participation in that pilot program, further consideration on whether to require a petition will be deferred pending further experience by the Office in the pre-appeal conference pilot program.

Proposed Bd.R. 41.37(e) would provide that an appeal brief must contain, under appropriate headings and in the order indicated, the following items: (1) Statement of the real party in interest, (2) statement of related cases, (3) jurisdictional statement, (4) table of contents, (5) table of authorities, (6) status of claims, (7) status of amendments, (8) rejections to be reviewed, (9) statement of facts, (10) argument, and (11) an appendix containing (a) claims section, (b) claim support section, (c) drawing analysis section, (d) means or step plus function analysis section, (e) evidence section, and (f) related cases section. The items are otherwise defined in other subsections of Proposed Bd.R. 41.37 and, where applicable, would apply to appeal briefs, reply briefs (Proposed Bd.R. 41.41), and supplemental reply briefs (Proposed Bd.R. 41.44).

Proposed Bd.R. 41.37(f) would require a ''statement of real party in interest'' which would include an identification of the name of the real party in interest. The principal purpose of an identification of the name of the real party in interest is to permit members of the Board to assess whether recusal is

required or would otherwise be appropriate. Another purpose is to assist employees of the Board to comply with the Ethics in Government Act. Since a real party in interest can change during the pendency of an appeal, there would be a continuing obligation to update the real party in interest during the pendency of the appeal.

Proposed Bd.R. 41.37(g) would require an appeal brief to include a ''statement of related cases.'' The statement of related cases would identify related cases by (1) application number, patent number, appeal number or interference number or (2) court docket number. The statement would encompass all prior or pending appeals, interferences or judicial proceedings known to appellant (or appellant's legal representative or any assignee) that relate to, directly affect, or would be directly affected by or have a bearing on the Board's decision in the appeal. A copy of any final or significant interlocutory decision rendered by the Board or a court in any proceeding identified under this paragraph shall be included in the related cases section of the appendix. A significant interlocutory decision would include (1) a decision on a patentability motion in an interference, or (2) a decision interpreting a claim in an interference or by a court. Appellant would be under a continuing obligation to update this item during the pendency of the appeal.

Proposed Bd.R. 41.37(h) would require an appeal brief to contain a ''jurisdictional statement'' which would set out why appellant believes that the Board has jurisdiction to consider the appeal. The jurisdictional statement would include a statement of (1) the statute under which the appeal is taken, (2) the date of the decision from which the appeal is taken, (3) the date the notice of appeal was filed, and (4) the date the appeal brief is being filed. If a notice of appeal or an appeal brief is filed after the time specified in the rules, appellant would have to indicate (1) the date an extension of time was requested and (2) the date the request was granted. A jurisdictional statement would minimize the chance that the Board would consider an appeal when the application on appeal is abandoned or a reexamination proceeding on appeal has terminated. An example of a jurisdictional statement in an application under a heading styled ''Jurisdictional statement'' would be: ''The Board has jurisdiction under 35 U.S.C. 134(a). The Examiner entered a final rejection on August 1, 2006, setting a three-month period for response. The time for responding to the final rejection expired on November 1, 2006. Rule 134. A notice of appeal and a request for a one-month extension of time under Rule 136(a) was filed on November 15, 2006. The time for filing an appeal brief is two months after the filing of a notice of appeal. Bd.R. 41.37(c). The time for filing an appeal brief expired on January 16, 2007 (Monday, January 15, 2007, being a Federal holiday). The appeal brief is being filed on January 16, 2007.'' If during the preparation of a jurisdictional statement, an appellant becomes aware that its application is abandoned, appellant could then take steps to revive the application, if revival is appropriate. See Rule 137.

Proposed Bd.R. 41.37(i) would require an appeal brief to contain a ''table of contents'' identifying the items listed in Proposed Bd.R. 41.37(e) along with a page reference where each item begins. In the case of a reply brief, the table of contents would identify the items required by the reply brief rule (Proposed Bd.R. 41.41(d)). In the case of a supplemental reply brief, the table of contents would identify the items required by the supplemental reply brief rule (Proposed Bd.R. 41.44(d)).

Proposed Bd.R. 41.37(j) would require an appeal brief to contain a ''table of authorities.'' This item would list (1) court and administrative decisions (alphabetically arranged), (2) statutes, and (3) other authorities, along with a reference to the pages of the appeal brief where each authority is cited. A similar requirement applies to a reply brief and a supplemental reply brief.

Proposed Bd.R. 41.37(k) would require an appeal brief to include a ''status of pending claims'' (e.g., rejected—appealed, rejected—not appealed, cancelled, allowable, withdrawn from consideration, or objected to). An example of a status of pending claims might read as follows under a heading styled ''Status of pending claims:'' ''Claims 1–7 are pending in the application on appeal: Claim 1 (rejected—not appealed), Claims 2–3 (rejected—appealed), Claim 4 (restricted and withdrawn from consideration), Claim 5 (objected to as depending from rejected claim), and Claims 6–7 (allowable).''

Proposed Bd.R. 41.37(l) would require an appeal brief to indicate the ''status of amendments'' for all amendments filed after final rejection (e.g., entered or not entered). Examples of a status of amendments might read as follows under a heading styled ''Status of amendments'': (1) ''No amendment was filed after final rejection.'' (2) ''An amendment filed October 31, 2006, was *not* entered by the examiner.'' (3) ''An amendment filed November 1, 2006, was entered by the examiner.'' (4) ''An amendment filed October 31, 2006, was *not* entered by the examiner, but an amendment filed November 1, 2006, was entered by the examiner.''

Proposed Bd.R. 41.37(m) would require an appeal brief to set out the ''rejections to be reviewed,'' including the claims subject to each rejection. Examples might read as follows under a heading styled ''Rejections to be reviewed'': (1) ''Rejection of claim 2 as being anticipated under 35 U.S.C. 102(b) over Johnson.'' (2) ''Rejection of claims 2–3 as being unpatentable under 35 U.S.C. 103(a) over Johnson and Young.'' (3) ''Rejection of claim 2 as failing to comply with the written description requirement of the first paragraph of 35 U.S.C. 112.'' (4) ''Rejection of claim 2 as failing to comply with the enablement requirement of the first paragraph of 35 U.S.C. 112.'' (5) ''Rejection of claim 3 under 35 U.S.C. 251 based on recapture.''

Proposed Bd.R. 41.37(n) would require a ''statement of facts.'' Appellant would set out in an objective and non-argumentative manner the material facts relevant to the rejections on appeal, preferably in numbered paragraphs. A clear, concise and complete statement of relevant facts will clarify the position of an appellant on dispositive issues and assist the examiner in reconsidering the patentability of the rejected claims. A fact would be required to be supported by a reference to the page number of the record on appeal. Where appropriate, the citation should also be to a specific line and to a drawing figure and element number of the record on appeal (see Proposed Bd.R. 41.37(t)). Statements of facts should be set out in short declarative sentences, and each sentence should address a single fact. For example, ''In rejecting claims 1–5, the examiner cites Jones (App. [App. meaning appendix], page 8, lines x–y).'' ''Jones describes a widget (App., page 19, col. 8, lines 3–4 and App., page 16, Figure 1, elements 12 and 13).'' A compound statement of fact is not proper, e.g., ''Jones describes a widget (App., page 19, col. 8, lines 3–4) and Smith does not describe a device.'' A statement of facts would have to be non-argumentative, meaning that an appellant would not be able to argue its appeal in the statement of facts. Rather, the statement of facts is designed to require an appellant to set out the facts which the appellant considers material for resolution of the appeal, thereby assisting the examiner initially and, if necessary, the Board thereafter to focus on the dispositive portions of the record. For example, in the case of a rejection for obviousness under § 103, the facts should address at least the

scope and content of the prior art, any differences between the claim on appeal and the prior art, and the level of skill in the art. In the past, some appellants have provided minimal factual development in an appeal brief, apparently believing that the Board will scour the record to divine the facts. It should be remembered that when the appeal reaches the Board, the panel members do not know anything about the appellant's invention or the prosecution history of the application on appeal. Likewise, too often an appellant will not support a statement of fact in an appeal brief by an explicit reference to the evidence. A statement of fact based on the specification would be proper if supported by a reference to page and line (and where appropriate also to drawing figure and element number). A statement of fact based on a patent would be proper if it is supported by a reference to a column and line (and where appropriate also to a drawing figure and element number). A statement of fact based on an affidavit would be proper if supported by a reference to a page and line number or to a page and paragraph number of the affidavit; the affidavit would appear in the evidence section of the appendix. The Office is proposing requiring a reference to a specific citation because an appellant should not expect the examiner or the Board to search the record to determine whether a statement of fact is supported by the evidence. Proposed Bd.R. 41.37(n), as well as other proposed rules, is consistent with the approaches taken by federal courts concerning appeal brief practice and other briefing practice: (1) *Clintec Nutrition Co.* v. *Baxa Corp.,* 988 F. Supp. 1109, 1114, n.16, 44 USPQ2d 1719, 1723, n.16 (N.D. Ill. 1997) (where a party points the court to a multi-page exhibit without citing a specific portion or page, the court will not pour over the documents to extract the relevant information); (2) *Ernst Haas Studio, Inc.* v. *Palm Press, Inc.,* 164 F.3d 110, 112, 49 USPQ2d 1377, 1379 (2d Cir. 1999) (''Appellant's Brief is at best an invitation to the court to scour the record, research any legal theory that comes to mind, and serve generally as an advocate for appellant. We decline the invitation.''); (3) *Winner International Royalty Corp.* v. *Wang,* 202 F.3d 1340, 1351, 53 USPQ2d 1580, 1589 (Fed. Cir. 2000) (''[W]e will not search the record on the chance of discovering * * * whether the district court abused its discretion.''); (4) *Gorence* v. *Eagle Food Centers, Inc.*, 242 F.3d 759, 762–63 (7th Cir. 2001) (''Little has been done * * * to make slogging through the record here either more efficient or more pleasant. And it is simply not true, we want to emphasize, that if a litigant presents an overload of irrelevant or non-probative facts, somehow the irrelevancies will add up to relevant evidence * * *''); and (5) *DeSilva* v. *DiLeonardi,* 181 F.3d 865, 867 (7th Cir. 1999) (''[An appeal] brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.'' *See also* (1) *Shiokawa* v. *Maienfisch,* 56 USPQ2d 1970, 1975 (Bd. Pat. App. & Int. 2000) and (2) *LeVeen* v. *Edwards,* 57 USPQ2d 1406, 1413 (Bd. Pat. App. & Int. 2000).

Proposed Bd.R. 41.37(o) would require an appeal brief to contain an argument comprising an analysis explaining, as to each rejection to be reviewed, why the appellant believes the examiner erred as to each rejection to be reviewed. The analysis would have to address all points made by the examiner with which the appellant disagrees. The presentation of a concise, but comprehensive, argument in response to the final rejection will efficiently frame any dispute between the appellant and the examiner not only for the benefit of the Board but also for consideration by the examiner and Office reviewers (appeal conferees) and provide the best opportunity for resolution of the dispute without the necessity of proceeding with the appeal. Where an argument has previously been presented to the examiner, the analysis would have to identify where any argument being made to the Board was made in the first instance to the examiner. Where an argument has not previously been made to the examiner, an appellant would be required to say so in the appeal brief so that the examiner would know that the argument is new. An example where an argument might not previously have been made to an examiner might occur under the following fact scenario. A first office action rejects claims over Reference A. Applicant amends the claims to avoid Reference A. The examiner enters a final rejection now relying on References A and B. Applicant elects to appeal without filing a response under Rule 116. While applicants are encouraged to file a response under Rule 116 to possibly avoid an appeal all together, at the present time there is no requirement for an applicant to file a Rule 116 response. Whether such a requirement should be made in the future will be held in abeyance pending experience under the rules as proposed, should they ultimately be promulgated. The Board has found that many arguments made in an appeal brief were never earlier presented to the examiner even though they could have been presented (without filing a Rule 116 response). To promote clarity, Proposed Bd.R. 41.37(o) would also require that each rejection for which review is sought shall be separately argued under a separate heading. Also, Proposed Bd.R. 41.37(o) would provide that any finding made or conclusion reached by the examiner that is not challenged would be presumed to be correct. Proposed Bd.R. 41.37(o) would also refer to paragraphs (4) through (8) of the rule where additional requirements for making arguments in response to statutory rejections would be found.

Proposed Bd.R. 41.37(o)(1) would provide that when a rejection applies to two or more claims, the appellant could elect to (1) have all claims stand or fall together or (2) argue the separate patentability of individual claims. The choice would be up to the appellant. However, if the appeal brief fails to make an explicit or clear election, the Board would (1) treat all claims subject to the rejection as standing or falling together and (2) select a single claim to decide the appeal as to that rejection. Any doubt as to whether an election has been made would be resolved against the appellant. For each claim argued separately, a subheading identifying the claim by number would be required. The requirement for a separate subheading in the appeal brief is to minimize any chance the examiner or the Board would overlook an argument directed to the separate patentability of a particular claim. In the past, appellants have been confused about whether a statement of what a claim covers is sufficient to constitute an argument that the claim is separately patentable. It is not. A statement that a claim contains a limitation not present in another claim would not in and of itself be sufficient to satisfy the requirement of Proposed Bd.R. 41.37(o)(1) that a separate argument be made. Unless an appellant plans to argue the separate patentability of a claim, the appellant would not discuss or refer to the claim in the argument section of the appeal brief. A copy of the claims will be before the Board in the ''claims section'' (Proposed Bd.R. 41.37(p)). In an application containing claims 1–3 where the examiner has made (1) a Section 102 rejection or (2) a Section 103 rejection or (3) both a Section 102 and 103 rejection, examples of a proper statement of ''claims standing or falling together'' would be as follows: (1) ''With respect to the rejection under Section 102, claims 1–

3 stand or fall together.'' (2) ''With respect to the rejection under Section 103, claims 1–2 stand or fall together; claim 3 is believed to be separately patentable.'' (3) ''With respect to the rejection under Section 102, claims 1–2 stand or fall together; claim 3 is believed to be separately patentable. With respect to the rejection under Section 103, the claims stand or fall together.''

Proposed Bd.R. 41.37(o)(2) would provide that the Board would only consider arguments that (1) are presented in the argument section of the appeal brief and (2) address claims set out in the claim support section of the appendix. Appellant would waive all arguments which could have been, but were not, addressed in the argument section of the appeal brief. A first example would be where Argument 1 and Argument 2 are presented in response to a final rejection, but only Argument 1 is presented in the appeal brief. Only Argument 1 would be considered. Argument 2 would be waived. A second example would be where an applicant presents an affidavit under Rule 131 or Rule 132 to the examiner, but does not argue the relevance of the affidavit in the appeal brief. The Board would not consider the affidavit in deciding the appeal.

Proposed Bd.R. 41.37(o)(3) would require that, when responding to points made in the final rejection, the appeal brief shall specifically (1) identify each point made by the examiner and (2) indicate where appellant previously responded to each point that appellant has not previously responded to the point. In supporting any argument, the appellant shall refer to a page and, where appropriate a line, in the evidence section of the appendix, specification, drawings (if any), U.S. patents, and published U.S. applications. Examples of argument formats that would be acceptable under Proposed Bd.R. 41.37(o)(3) follow.

Example 1. In the case where an argument had been previously presented to the examiner, the following format would be acceptable under Proposed Bd.R. 41.37(o)(3). ''The examiner states that Reference A teaches element B. Final Rejection, App., page x, lines y–z. In response, appellant previously pointed out to the examiner why the examiner is believed to have erred. App., pages 8–9. The response is [concisely state the response].'' A similar format has been successfully used for some years in oppositions and replies filed in interference cases.

Example 2. Alternatively, in the case where an argument has not been previously made to the examiner, the following format would be acceptable under Proposed Bd.R. 41.37(o)(3). ''In response to the examiner's reliance on Reference C for the first time in the final rejection (App., page 4), appellant's response includes a new argument which has not been previously presented to the examiner. The response is [concisely state the response].'' Use of this format will minimize any chance that the examiner will overlook an argument when preparing the examiner's answer.

The recommended argument formats are intended to be efficient protocols for assisting the Board in focusing on any differences between the examiner's and appellant's positions.

Paragraphs (4) through (8) of Proposed Bd.R. 41.37(o) would reinstitute specific requirements not found in Bd.R. 41.37, but that appeared in the prior rule (37 CFR 1.192(c)(8)(i) through (v)) (2004). Since promulgation of Bd.R. 41.37, suggestions from outside the Office have been made to have the Office reinsert the requirements of former Rule 192(c)(8)(i) through (v) into the rules. These paragraphs would require that appellants expressly address the statutory requirements for patentability. Paragraphs (4) through (7), as under the Office's prior rules, would address rejections under 35 U.S.C. 102, 103 and 112 (first and second paragraphs). There are, of course, other rejections which are based on other sections of the Patent Law, e.g., 35 U.S.C. 101 (non-statutory subject matter, same invention double patenting, and lack of utility), 35 U.S.C. 251 (recapture and presenting claims in reissue applications that are broader than original patent claims), and 35 U.S.C. 305 (presenting claims in re-examination proceedings that are broader than original patent claims). Likewise, there are non-statutory rejections, such as obvious double patenting and interference estoppel. Since the vast majority of the rejections are based on sections 102, 103 and 112, it is proposed to have requirements in the rules related only to those rejections. Setting out requirements for other rejections is presently viewed as counterproductive and complicated since it would be impossible to address all the various possibilities for those other rejections. Accordingly, a ''catch-all'' for other rejections is set out in Proposed Bd.R. 41.37(o)(8).

Proposed Bd.R. 41.37(o)(4) would require, for each rejection under 35 U.S.C. 112, first paragraph, that the argument shall also specify the errors in the rejection and how the rejected claims comply with the first paragraph of 35 U.S.C. 112, including, as appropriate, how the specification and drawings, if any, (1) describe the subject matter defined by the rejected claims, (2) enable any person skilled in the art to which the invention pertains to make and use the subject matter of the rejected claims, or (3) set forth the best mode contemplated by the inventor of carrying out the claimed invention.

Proposed Bd.R. 41.37(o)(5) would require, for each rejection under 35 U.S.C. 112, second paragraph, that the argument shall also specify how the rejected claims particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Proposed Bd.R. 41.37(o)(6) would require, for each rejection under 35 U.S.C. 102 (anticipation), that the argument shall also identify any specific limitations in the rejected claims which are not described (explicitly or inherently) in the prior art relied upon in support of the rejection and, therefore, why the rejected claims are patentable under 35 U.S.C. 102.

Proposed Bd.R. 41.37(o)(7) would require, for each rejection under 35 U.S.C. 103, that the argument shall (1) specify the errors in the rejection, (2) if appropriate, specify the specific limitations in the rejected claims that are not described in the prior art relied upon in support of the rejection, and (3) explain how those limitations render the claimed subject matter unobvious over the prior art. A general argument that all limitations are not described in a single prior art reference would not satisfy the requirements of this paragraph.

Proposed Bd.R. 41.37(o)(8) would require for any rejection other than those mentioned in Proposed Bd.R. 41.37(o)(4) through (7) that the argument shall specify the errors in the rejection, including where appropriate the specific limitations in the rejected claims upon which the appellant relies to establish error.

Proposed Bd.R. 41.37(p) would require an appeal brief to contain a ''claims section'' in the appendix which would consist of an accurate clean copy in numerical order of all claims pending in the application or reexamination proceeding on appeal. The claims section of the appendix would include all pending claims, not just those under rejection. The status of each claim would have to be indicated.

Proposed Bd.R. 41.37(q) would require an appeal brief to contain a ''claim support section'' of the appendix. The claim support section would replace Bd.R. 41.37(c)(1)(v) which requires a concise explanation of the subject matter defined in each of the independent claims on appeal. The claim support section, for each claim argued separately (see Proposed Bd.R. 41.37(o)(1)), would consist of an annotated copy of the claim indicating

in bold face between braces ({}) after each limitation where, by page and line numbers, the limitation is described in the specification as filed. Braces ({}) are used instead of brackets [ ] because brackets are used in reissue claim practice. Unlike the ''claims section'' (see Proposed Bd.R. 41.37(p)), only those claims being argued separately would need to appear in the ''claim support section.'' A significant objective of the ''claim support section'' would be to provide the examiner and the Board with appellant's perspective on where language of the claims (including specific words used in the claims, but not in the specification) finds support in the specification. Finding support for language in the claims can help the examiner and the Board construe claimed terminology and limitations when applying the prior art. The claim support section of the appendix would help the Board to interpret the scope of claims, or the meaning of words in a claim, before applying the prior art. Practice under current Bd.R. 41.37(c)(1)(v) has not been efficient because of the diverse manners in which different appellants have attempted to comply with the current practice. One significant problem faced by the Board under the current practice occurs when the language of a claim does not have direct antecedent language in the specification. In order for the Board to understand the scope of a claim or the meaning of a term in the claim, the Board primarily relies on the specification. Moreover, in practice before the Office, a claim is given its broadest reasonable construction consistent with the specification. However, when the language of the claim does not find correspondence in the specification, as filed, often it is difficult to determine the meaning of a particular word in a claim or to give the claim its broadest reasonable interpretation. The claim support section of the appendix would give the examiner and the Board the appellant's view on where the claim is supported by the application, as filed. The proposed requirement, if promulgated, would significantly improve the efficiency of the Board's handling of appeals.

Proposed Bd.R. 41.37(r) would require an appeal brief to contain a ''drawing analysis section'' in the appendix. For each claim argued separately (see Proposed Bd.R. (o)(1)), the drawing analysis section would consist of an annotated copy of the claim in numerical sequence, indicating in bold face between braces ({}) after each limitation where, by reference or sequence residue number, each limitation is shown in the drawing or sequence. A drawing analysis has been required in interference cases since 1998 and has proven useful to the Board in understanding claimed inventions described in applications and patents involved in an interference. The drawing analysis section is expected to be equally useful in ex parte appeals. If there is no drawing or amino acid or nucleotide material sequence, the drawing analysis section would state that there is no drawing or sequence. The purpose of requiring a statement is to be certain that a drawing analysis has not been overlooked.

Proposed Bd.R. 41.37(s) would require an appeal brief to contain a ''means or step plus function analysis section'' in the appendix. The means or step plus function analysis section would replace the requirement of current Bd.R. 41.37(c)(1)(v) relating to identification of structure, material or acts for means or step plus function claims limitations contained in appealed claims. Under Proposed Bd.R. 41.37(s), the means or step plus function analysis section would include each claim argued separately (see Proposed Bd.R. 41.37(o)(1)) that contains a limitation that appellant regards as a means or step plus function limitation in the form permitted by the sixth paragraph of 35 U.S.C. 112. Further, for each such claim, a copy of the claim would be reproduced indicating in bold face between braces ({}) the specific portions of the specification and drawing that describe the structure material or acts corresponding to each claimed function. If the appealed claims do not contain any means or step plus function limitations, the section would state that there is no means or step plus function limitation in any claim on appeal. The Office is proposing to require a particular format for the means or step plus function analysis section to avoid the confusion that arises from the variety of ways appellants employ under current practice in attempting to comply with the requirements of Bd.R. 41.37(c)(1)(v). A means or step plus function analysis essentially tracking Proposed Bd.R. 41.37(s) has been used in interference cases since 1998 and has been helpful in determining the scope of claims involved.

Proposed Bd.R. 41.37(t) would require an appeal brief to contain an ''evidence section'' in the appendix. The evidence section continues, in part, the practice under Bd.R. 41.37(c)(1)(ix). The evidence section and any supplemental appendix filed pursuant to Proposed Bd.R. 41.41(h), as well as the specification, any drawings, and any cited U.S. patents and published U.S. applications, would constitute the record upon which the appeal would be decided. The word ''evidence'' would be construed broadly and would include amendments, affidavits or declaration, non-patent literature, foreign patents and publications, published PCT documents, and any other material admitted into the record by the examiner. The evidence section would include (1) table of contents, (2) the Office action setting out the rejection on appeal (including any Office action that may be incorporated by reference), (3) all evidence (except the specification, any drawings, U.S. patents and published U.S. applications) upon which the examiner relied in support of the rejection on appeal, (4) the relevant portion of papers filed by the appellant during prosecution before the examiner which show that an argument being made on appeal was made in the first instance to the examiner, (5) affidavits or declarations upon which the appellant relied before the examiner, and (6) other evidence upon which the appellants relied before the examiner. If the examiner believes that other material should be included in the evidence section, the examiner would be able to attach that evidence to the examiner's answer. Pursuant to Proposed Bd.R. 41.37(v)(1), all pages of an appeal brief or a reply brief (including appendices to those briefs) would be consecutively numbered beginning with page 1. Appeal briefs, examiner's answers, reply briefs, supplemental examiner's answers, supplemental reply briefs, and opinions of the Board would be able to cite the ''record'' by reference to a page of the evidence section or any supplemental appendix. If the appellant, the examiner, and the Board all cite to a well-defined record, confusion over what a reference to a piece of evidence means should be diminished.

Proposed Bd.R. 41.37(u) would require an appeal brief to contain a ''related cases section'' in the appendix. The related cases section would consist of copies of orders and opinions required to be cited pursuant to Proposed Bd.R. 41.37(g).

Proposed Bd.R. 41.37(v) would require an appeal brief to be presented in a particular format. The appeal brief would have to comply with the format of Rule 52 as well as with other requirements set out in Proposed Bd.R. 41.37(v)(1) through (6).

Proposed Bd.R. 41.37(v)(1) would require that the pages of an appeal brief, including all appendices, would be consecutively numbered using Arabic numerals beginning with the first page

of the appeal brief, which would be numbered page 1. This practice would prevent (1) re-starting numbering with each section of the appendix or (2) using Roman numeral page numbers, e.g., I, II, V, etc., or page numbers with letters, e.g., ''a'', ''b'', ''c'', ''i'', ''ii'', etc. The lines on each page of the appeal brief, and where practical, the appendices, would be consecutively line numbered beginning with line 1 at the top of each page. Line numbering has been used for some time in interference cases and has been found to be useful when making reference in oppositions, replies, and opinions of the Board.

Proposed Bd.R. 41.37(v)(2) would require that text in an appeal brief would be double spaced except in headings, tables of contents, tables of authorities, signature blocks and certificates of service. Block quotations would be indented. Footnotes, which are discouraged, would have to be double spaced.

Proposed Bd.R. 41.37(v)(3) would require that margins shall be at least one inch (2.5 centimeters) on all sides. Line numbering could appear within the left margin.

Proposed Bd.R. 41.37(v)(4) would require that the font would be readable and clean and equivalent to 14 point Times New Roman, including the font for block quotations and footnotes.

Proposed Bd.R. 41.37(v)(5) would provide that an appeal brief may not exceed 25 pages, excluding any (1) statement of the real party in interest, (2) statement of related cases, (3) table of contents, (4) table of authorities, (5) signature block and (6) appendix. To give meaning to the 25-page limitation, an appeal brief would not be permitted to incorporate by reference arguments from other papers in the evidence appendices or from any other source. The prohibition against incorporation by reference is necessary to prevent an appellant from adding to the length of an appeal brief. *Cf. DeSilva* v. *DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999) (''[A]doption by reference amounts to a self-help increase in the length of the appellate brief. * * * [I]ncorporation by reference 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.'') (citation omitted). A prohibition against incorporation by reference has been the practice in interference cases since 1998 and has minimized the chance that an argument is overlooked.

Proposed Bd.R. 41.37(v)(6) would require a signature block which would identify the appellant or appellant's representative, as appropriate, and a mailing address, telephone number, fax number and e-mail address.

Examiner's Answer

Proposed Bd.R. 41.39(a) would provide that within such time and manner as may be directed by the Director and if the examiner determines that the appeal should go forward, the examiner shall enter an examiner's answer responding to the appeal brief. The specific requirements of what would be required in an examiner's answer would appear in the Manual of Patent Examining Procedure.

Proposed Bd.R. 41.39(b) would provide that an examiner's answer may include a new rejection. In the past, the rules and the MPEP have used the phrase ''new ground of rejection.'' The phrase ''new rejection'' implies that the ground, or basis, for the rejection is new. Accordingly, in Proposed Bd.R. 41.39(b) and elsewhere in the proposed rules, the phrase ''new rejection'' rather than ''new ground of rejection'' is used. If an examiner's answer contains a rejection designated as a new rejection, appellant, within two months from the date of the examiner's answer, would be required to exercise one of two options or the application will be deemed to be abandoned or the reexamination proceeding will be deemed to be terminated.

Proposed Bd.R. 41.39(b)(1) would provide that the first option would be to 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 evidence. Any amendment or evidence would have to be relevant to the new rejection. A request that complies with this paragraph would be entered and the application or patent under reexamination would be reconsidered by the examiner under the provisions of § 1.112 of this title. A request under this paragraph would be treated as a request to withdraw the appeal.

Proposed Bd.R. 41.39(b)(2) would provide that the second option would be to request that the appeal be maintained by filing a reply brief as set forth in Proposed Bd.R. 41.41. A reply brief could not be accompanied by any amendment or evidence, except an amendment canceling one or more claims which are subject to the new rejection. A reply brief which is accompanied by evidence or any other amendment would be treated as a request to reopen prosecution pursuant to Proposed Bd.R. 41.39(b)(1).

Proposed Bd.R. 41.39(c) would provide that the time for filing a request under Proposed Bd.R. 41.39(b)(1) would be extendable under the provisions of Rule 136(a) as to applications and under the provisions of Rule 550(c) as to reexamination proceedings. However, a request for an extension of time for filing a request under Proposed Bd.R. 41.39(b)(2) would have to be presented as a petition under Proposed Bd.R. 41.3(a) and (c). A decision on the petition would be made by the Chief Administrative Patent Judge or an employee to whom the Chief Administrative Patent Judge has delegated authority to make the decision. The decision would be governed by Rule 41.4(a). The reason for the requirement for a petition is to minimize the time an appeal is pending. In the past, appellants have taken advantage of the provisions of Rule 136(a) to file a reply to maintain the appeal. The length of possible patent term adjustment (35 U.S.C. 154(b)(2)(iii)) is based on the time an appeal is pending. The provisions of Rule 136(a) are not consistent with efficient handling of appeals after the time an appeal brief is filed. The Office does not believe that an applicant should be able to add to any patent term adjustment by the automatic extensions of time that are available through Rule 136(a). Appellants should expect strict application of the ''good cause'' standard of Bd.R. Rule 41.4(a).

Reply Brief

Proposed Bd.R. 41.41(a) would provide that an appellant may file a single reply brief responding to the examiner's answer.

Proposed Bd.R. 41.41(b) would provide that the time for filing a reply brief would be within two months of the date the examiner's answer is entered.

Proposed Bd.R. 41.41(c) would provide that a request for an extension of time shall be presented as a petition under § 41.3(a) and (c) of this part. A decision on the petition shall be governed by § 41.4(a) of this part. The provisions of Rule 136(a) would no longer apply to extensions of time to file a reply brief.

Proposed Bd.R. 41.41(d) would provide that a reply brief shall be limited to responding to points made in the examiner's answer. Except as otherwise set out in these proposed rules, the form and content of a reply brief would be governed by the requirements for an appeal brief as set out in Proposed Bd.R. 41.37. A reply brief would not be able to exceed fifteen pages, excluding any (1) table of contents, (2) table of authorities, (3) statement of timeliness, (4) signature block and (5) supplemental appendix. A reply brief would be required to contain,

under appropriate headings and in the order indicated, the following items: (1) Table of contents, (2) table of authorities, (3) statement of timeliness, (4) statement of facts in response to any new rejection in examiner's answer, (5) argument, and, where appropriate, (6) supplemental appendix. If the examiner's answer contains a new rejection, designated as such, the page limit would be twenty-five pages and not fifteen pages.

Proposed Bd.R. 41.41(e) would require a reply brief to contain a statement of timeliness. The statement of timeliness would have to establish that the reply brief is being timely filed by including a statement of the date the examiner's answer was entered and the date the reply brief is being filed. If the reply brief is filed after the time specified in this subpart, appellant must indicate the date an extension of time was requested and the date the request was granted. An example of a statement of timeliness would be: ''The examiner's answer was entered on October 14, 2006. The time for filing a reply brief expired on December 14, 2006. Bd.R. 41.41(b). A request for extension of time to file the reply brief on December 21, 2006, was filed on December 1, 2006, and was granted by the Chief Administrative Patent Judge on December 10, 2006. The reply brief is being timely filed on December 21, 2006.'' A reply brief which is not timely filed would not be considered by the examiner or the Board.

Proposed Bd.R. 41.41(f) would require a statement of additional facts, but only when the appellant has elected to file a reply brief in response to a new rejection in an examiner's answer entered pursuant to Proposed Bd.R. 41.39(b)(2). When a statement of additional facts is required, it would have to meet the requirements of Proposed Bd.R. 41.37(n), but would have to be limited to facts relevant to the new rejection. If there is no new rejection in the examiner's answer, there would be no statement of additional facts.

Proposed Bd.R. 41.41(g) would require that an argument appear in the reply brief, which would be limited to responding to points made in the examiner's answer. No general restatement of the case would be permitted in a reply brief. An argument which could have been, but which was not, made in the appeal brief cannot be made in a reply brief. The Office has found a restatement of the case in a reply brief to be a serious distraction. Adding details or additional arguments, if not responsive to points made by the examiner, does not contribute to the efficient handling of appeals. As a result of appellants adding new details and arguments, an examiner often has to enter a supplemental examiner's answer to respond to details and arguments not previously considered by the examiner and that should have been presented in the appeal brief. An example of an acceptable format for presenting an argument in a reply brief (where there was no new rejection in the examiner's answer) might read as follows: First paragraph: ''This is a reply to the examiner's answer entered [insert the date the answer was entered].'' Last paragraph: ''For the reasons given in this reply brief and in the appeal brief, reversal of the examiner's rejection is requested.'' All paragraphs between the first and last paragraphs would read: ''On page x, lines y-z of the examiner's answer, the examiner states that [state what the examiner states]. The response is [concisely state the response].'' As part of each response, the appellant would have to refer to the page number and line or drawing element number of the evidence section. Any response which is not concise probably would not comply with Proposed Bd.R. 41.41(g). Frequently, new details and arguments surface in reply briefs. By Proposed Bd.R. 41.41(g), the Office seeks to confine reply briefs to what they ought to be—a response to points raised in the examiner's answer. If Proposed Bd.R. 41.41 is promulgated and, notwithstanding what the rule seeks to achieve, it turns out that too many resources of the Office are needed to enforce the reply brief rule and considerable time is wasted in resolving improper reply brief issues. Consideration could be given to further limiting the nature of replies filed in ex parte appeals.

Proposed Bd.R. 41.41(h) would require that a supplemental appendix be made part of the reply brief if the examiner entered a new rejection in the examiner's answer and appellant elects to respond to the new rejection in a reply brief. The supplemental appendix would include (1) table of contents, (2) examiner's answer, and (3) all evidence relied upon by the examiner in support of the new rejection which does not already appear in the evidence section of the appendix accompanying the appeal brief, except the specification, any drawings, U.S. patents and published U.S. applications.

Proposed Bd.R. 41.41(i) would provide that an amendment or new evidence may not accompany a reply brief. The Office has found that appellants continue to attempt to file amendments and evidence with reply briefs. If an appellant, after reviewing the examiner's answer, believes that an amendment is appropriate, the appellant may file a request for continued examination or, in the case of a reexamination proceeding, ask that the proceeding be reopened.

Examiner's Response To Reply Brief

Proposed Bd.R. 41.43 would provide that upon consideration of a reply brief, the examiner may withdraw a rejection and reopen prosecution or may enter a supplemental examiner's answer responding to the reply brief.

Supplemental Reply Brief

Proposed Bd.R. 41.44(a) would provide that, if the examiner enters a supplemental examiner's answer, the appellant would be able to file a single supplemental reply brief responding to the supplemental examiner's answer.

Proposed Bd.R. 41.44(b) would provide that the appellant would have to file a supplemental reply brief within two months from the date of the filing of the examiner's supplemental answer.

Proposed Bd.R. 41.44(c) would provide that a request for an extension of time shall be presented as a petition under Proposed Bd.R. 41.3(a) and (c). A decision on the petition shall be governed by Bd.R. 41.4(a).

Proposed Bd.R. 41.44(d) would provide that, except as otherwise set out in this rule, the form and content of a supplemental reply brief are governed by the requirements for appeal briefs as set out in Proposed Bd.R. 41.37. A supplemental reply brief would have to contain, under appropriate headings and in the order indicated, the following items: (1) Table of contents, (2) table of authorities, (3) statement of timeliness, and (4) argument. Proposed Bd.R. 41.44(d) would also provide that the argument portion of a supplement reply brief would be limited to ten pages and to responding to points made in the supplemental examiner's answer. A request to exceed the page limit would be presented as a petition under Proposed Bd.R. 41.3.

Proposed Bd.R. 41.44(e) would provide that a supplemental reply brief would have to contain a statement of timeliness, including a statement of the date the supplemental examiner's answer was entered and the date the supplemental reply is being filed. If the supplemental reply brief is filed after the time specified in this subpart, appellant would have to indicate the date an extension of time was requested and the date the request was granted.

Proposed Bd.R. 41.44(f) would provide that a supplemental reply brief shall be limited to responding to points made in the supplemental examiner's

answer. The supplemental reply brief preferably would adhere to the following format: ''On page x, lines y-z of the supplemental examiner's answer, the examiner states that [state what the examiner states]. The response is [state the response].'' As part of each response, appellant would have to refer to the page number and line or drawing number of the evidence section of the appendix accompanying the appeal brief or supplemental appendix accompanying the reply brief. No general restatement of the case would be permitted in a supplemental reply brief. A new argument would not be able to be made in a supplemental reply brief.

Proposed Bd.R. 41.44(g) would provide that an amendment or new evidence may not accompany a supplemental reply brief.

Oral Hearing

Proposed Bd.R. 41.47(a) would provide that if the appellant desires an oral hearing, appellant must file, as a separate paper, a written request captioned: ''REQUEST FOR ORAL HEARING.''

Proposed Bd.R. 41.47(b) would provide that a request for oral hearing shall be accompanied by the fee required by § 41.20(b)(3).

Proposed Bd.R. 41.47(c) would provide that the time for filing a request for an oral hearing would be within two months of the date of entry of the examiner's answer or a supplemental examiner's answer.

Proposed Bd.R. 41.47(d) would provide that a request for an extension of time to request an oral hearing would have to be presented as a petition under § 41.3(a) and (c) of this part. A decision on the petition shall be governed by § 41.4(a) of this part.

Proposed Bd.R. 41.47(e) would provide that if an oral hearing is properly requested, a date for the oral hearing would be set.

Proposed Bd.R. 41.47(f) would provide that if an oral hearing is set, then within such time as the Board may order, appellant shall confirm attendance at the oral hearing. Failure to timely confirm attendance would be taken as a waiver of any request for an oral hearing.

Proposed Bd.R. 41.47(g) would provide that at the time appellant confirms attendance at the oral hearing, appellant would be required to supply a list of technical terms and other unusual words which can be provided to any individual transcribing an oral hearing. The current practice of the Board is to transcribe all oral arguments. A list of technical terms provided by appellant should improve the accuracy of any transcript.

Proposed Bd.R. 41.47(h) would provide that unless otherwise ordered by the Board, argument on behalf of appellant at an oral hearing would be limited to 20 minutes.

Proposed Bd.R. 41.47(i) would provide that at oral hearing only evidence that has been previously presented to, entered by and considered by the primary examiner would be considered and that no additional evidence may be offered to the Board in support of the appeal. An argument not presented in a brief could not be made at the oral hearing.

Proposed Bd.R. 41.47(j) would provide that notwithstanding Proposed Bd.R. 41.47(i), an appellant could rely on and call the Board's attention to a recent court or Board opinion which could have an effect on the manner in which the appeal is decided.

Proposed Bd.R. 41.47(k) would provide that visual aids may be used at an oral hearing. However, visual aids must be limited to copies of documents in the record on appeal. A document not previously entered by the examiner could not be used as a visual aid. When an appellant seeks to use a visual aid, one copy should be provided for each judge and one copy for the record of the appeal.

Proposed Bd.R. 41.47(l) would provide that failure of an appellant to attend an oral hearing would be treated as a waiver of the oral hearing. Over the years the Board has become concerned with the large number of requests for postponements. In some cases, multiple requests in a single appeal are submitted for postponement of an oral hearing. Apart from the fact that a postponement can lead to large patent term adjustments, efficiency dictates that the Board be able to set an oral hearing schedule with an expectation that in a large majority of the cases the oral hearing will timely occur or the appellant will waive oral hearing. The Board will continue to handle requests for postponement of oral hearings on an ad hoc basis. However, postponements would no longer be granted on a routine basis. A request for a postponement made immediately after a notice of oral hearing is mailed is more likely to receive favorable treatment, particularly since it may be possible to set an oral hearing date prior to the originally scheduled oral hearing date.

Decisions and Other Actions by the Board

Proposed Bd.R. 41.50(a) would provide that the Board may affirm or reverse a decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. Proposed Bd.R. 41.50(a) would continue the practice that an affirmance of a 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.

Proposed Bd.R. 41.50(b) would provide that the Board may remand an application to the examiner. Upon entry of a remand, the Board would no longer have jurisdiction unless an appellant timely files a request for rehearing. If the request for rehearing does not result in modification of the remand, the Board would then lose jurisdiction. Upon remand, should examiner enter a supplemental examiner's answer in response to the remand, appellant would be required to exercise one of two options to avoid abandonment of the application or termination of the reexamination proceeding. Either option would have to be exercised within two months from the date of the supplemental examiner's answer.

Proposed Bd.R. 41.50(b)(1) specifies the first option and would provide that appellant could request that prosecution be reopened before the examiner by filing a reply under Rule 111, with or without amendment or submission of evidence. Any amendment or evidence would have to 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 would be entered and the application or patent under reexamination would be reconsidered by the examiner under the provisions of Rule 112. A request under Proposed Bd.R. 41.50(b)(1) would be treated as a request to dismiss the appeal.

Proposed Bd.R. 41.50(b)(2) specifies the second option and would provide that appellant could request that the appeal be re-docketed. The request would have to be accompanied by a reply brief as set forth in Proposed Bd.R. 41.41. An amendment or evidence could not accompany the reply brief. A reply brief that is accompanied by an amendment or evidence would be treated as a request to reopen prosecution pursuant to Proposed Bd.R. 41.50(b)(1).

Proposed Bd.R. 41.50(c) would provide that a remand is not a final decision. Following proceedings on remand, and with respect to affirmed rejections and claims not involved in the remand, an appellant could request the Board to enter a final decision so that the appellant could then seek judicial review as to those rejections and claims. Only a final decision of the

Board is subject to appeal. *Copelands' Enterprises, Inc.* v. *CNV, Inc.*, 887 F.2d 1065, 12 USPQ2d 1562 (Fed. Cir. 1989) (*en banc*).

Proposed Bd.R. 41.50(d) would provide that, should the Board have knowledge of a basis not involved in the appeal for rejecting a pending claim, the Board may enter a new rejection. A pending claim could be a claim not rejected by the examiner. A new rejection would not be considered final for purposes of judicial review. A new rejection is not considered a final agency action because the appellant has not explained to the Board, without amendment or new evidence, or to the Office, with an amendment or new evidence or both, why the rejection is not proper. Proposed Bd.R. 41.50(d) places an appellant under a burden to explain to the Board or the Office why a new rejection is not proper before it burdens a court with judicial review. A response by an appellant may convince the Office that a new rejection should be withdrawn. If the Board enters a new rejection, appellant would have to exercise one of two options with respect to the new rejection to avoid dismissal of the appeal as to any claim subject to the new rejection. Either option would have to be exercised within two months from the date of the new rejection.

Proposed Bd.R. 41.50(d)(1) specifies that a first option would be to submit an amendment of the claims subject to a new rejection or new evidence relating to the new rejection or both and request that the matter be reconsidered by the examiner. The proceedings would be remanded to the examiner. A new rejection would be binding on the examiner unless, in the opinion of the examiner, the amendment or new evidence overcomes the new rejection. In the event the examiner maintains the rejection, appellant would be able to again appeal to the Board.

Proposed Bd.R. 41.50(d)(2) specifies that a second option would be to request rehearing pursuant to Proposed Bd.R. 41.52. The request for rehearing would have to be based on the record before the Board and no new evidence or amendments would be permitted.

Proposed Bd.R. 41.50(e) would provide that the Board, in its opinion in support of its decision, could include a recommendation, explicitly designated as such, of how a claim on appeal may be amended to overcome a specific rejection. For the recommendation to be binding, it would have to be explicitly designated as a recommendation. For example, a conclusion or comment by the Board that a claim, notwithstanding appellant's argument, is so broad as to read on the prior art should not be taken as a recommendation that if some undefined limitation is added the claim would be patentable. When the Board makes a recommendation, appellant may file an amendment in conformity with the recommendation. An amendment in conformity with the recommendation would be deemed to overcome the specific rejection. An examiner would have authority to enter an additional rejection of a claim amended in conformity with a recommendation provided that the additional rejection constitutes a new rejection. For example, the examiner may know of additional prior art not known to the Board that would meet the claim as amended. It is because of the possibility that an examiner may know of additional prior art that a recommendation would be expected to be a relatively rare event.

Proposed Bd.R. 41.50(f) would provide that the Board could enter an order requiring appellant to brief additional issues or supply additional evidence or both if the Board believes doing so would be of assistance in reaching a decision on the appeal. Proposed Bd.R. 41.50(f) continues a practice which has been in existence since 1999. See, *e.g.*, (1) 37 CFR 1.196(d) (1999) and (2) Bd.R. 41.50(d). Practice under Bd.R. 41.50(d) has been highly useful and complements the authority of Office personnel to request additional material under Rule 105. Appellant would be given a non-extendable time period within which to respond to the order. In setting the length of the non-extendable time period, the Board would take into account the extent of the information requested and the time of year a response would be due. For example, it is not likely that the Board would set a date for response between Christmas Day and New Year's Day. Failure of appellant to timely respond to the order could result in dismissal of the appeal in whole or in part. An appeal might be dismissed in part if the order sought further briefing or evidence or both related to one rejection but not another rejection, particularly where the two rejections apply to different claims.

Proposed Bd.R. 41.50(g) would provide for extensions of time to respond to actions of the Board under Proposed Bd.R. 41.50(b) and (d).

Proposed Bd.R. 41.50(g) would provide that a request for an extension of time to respond to a request for briefing and information under Proposed Bd.R. 41.50(f) is not authorized. A request for an extension of time to respond to Board action under Proposed Bd.R. 41.50(b) and (d) would be presented as a petition under Bd.R. 41.3(a) and (c). A decision on the petition shall be governed by Bd.R. 41.4(a).

Rehearing

Proposed Bd.R. 41.52(a) would authorize an appellant to file a single request for rehearing.

Proposed Bd.R. 41.52(b) would provide that a request for rehearing would be due within two months from the date of the decision entered by the Board.

Proposed Bd.R. 41.52(c) would provide that a request for an extension of time would have to be presented as a petition under Proposed Bd.R. 41.3(a) and (c). A decision on the petition would be governed by Bd.R. 41.4(a).

Proposed Bd.R. 41.52(d) would provide that a request for rehearing shall state with particularity the points believed to have been misapprehended or overlooked by the Board. A request for rehearing would not be able to exceed ten pages, excluding any table of contents, table of authorities, statement of timeliness and signature block. A request for rehearing would have to contain, under appropriate headings and in the order indicated, the following items: (1) Table of contents, (2) table of authorities, (3) statement of timeliness, and (4) argument.

Proposed Bd.R. 41.52(e) would provide that a statement of timeliness establish that the request for rehearing was timely filed by including a statement of the date the decision sought to be reheard was entered and the date the request for rehearing is being filed. If the request for rehearing is filed after the time specified in this subpart, appellant would be required to indicate the date an extension of time was requested and the date the request was granted.

Proposed Bd.R. 41.52(f) would provide that in a request for rehearing, the argument preferably should adhere to the following format: ''On page x, lines y-z of the Board's opinion, the Board states that [set out what was stated]. The point misapprehended or overlooked was made to the Board in [identify paper, page and line where argument was made to the Board]. The response is [state response].'' As part of each response, appellant shall refer to the page number and line or drawing element number of the evidence section. No general restatement of the case would be permitted in a request for rehearing. A new argument could not be made in a request for rehearing, except in two instances.

Proposed Bd.R. 41.52(f)(1) would authorize in a first instance an appellant to respond to a new rejection entered pursuant to Proposed Bd.R. 41.50(d)(2).

Proposed Bd.R. 41.52(f)(2) would authorize an appellant to rely on and call the Board's attention to a recent decision of a court or the Board that is relevant to an issue decided in the appeal. Generally, the recent court decision would be a decision of the Supreme Court or the Court of Appeals for the Federal Circuit.

Proposed Bd.R. 41.52(g) would provide that an amendment or new evidence could not accompany a request for rehearing.

Proposed Bd.R. 41.52(h) would provide that a decision will be rendered on a request for rehearing. The decision on rehearing would be deemed to incorporate the decision sought to be reheard except for those portions of the decision sought to be reheard specifically modified on rehearing. A decision on rehearing would be considered final for purposes of judicial review, except when otherwise noted in the decision on rehearing.

Action Following Decision

Proposed Bd.R. 41.54 would provide that, after a decision by the Board and subject to appellant's right to seek judicial review, the proceeding will be returned to the examiner for such further action as may be consistent with the decision by the Board.

Sanctions

Proposed Bd.R. 41.56 would provide for sanctions.

Proposed Bd.R. 41.56(a) would provide that a sanction could be imposed against an appellant for misconduct, including, (1) failure to comply with an order entered in the appeal or an applicable rule, (2) advancing or maintaining a misleading or frivolous request for relief or argument, or (3) engaging in dilatory tactics.

Proposed Bd.R. 41.56(b) would provide that the nature of possible sanctions, includes entry of (1) an order declining to enter a docketing notice, (2) an order holding certain facts to have been established in the appeal, (3) an order expunging a paper or precluding an appellant from filing a paper, (4) an order precluding an appellant from presenting or contesting a particular issue, (5) an order excluding evidence, (6) an order requiring a terminal disclaimer of patent term, (7) an order holding an application on appeal to be abandoned or a reexamination proceeding terminated, (8) an order dismissing an appeal, (9) an order denying an oral hearing, or (10) an order terminating oral hearing.

Whether and which sanction, if any, should be imposed in any specific circumstance would be matters within the discretion of the Board.

Rule Making Considerations

Administrative Procedure Act

The notable changes in the proposed rules are: (1) Providing additional delegated authority from the Director to the Chief Administrative Patent Judge to decide certain petitions authorized by Part 41 as proposed, including requests for extension of time to file certain papers after the appeal brief and requests to enlarge the page limit on certain appeal papers; (2) defining the record on appeal to clarify what documents the Board will consider in resolving the appeal; (3) requiring the notice of appeal to be signed; (4) providing a definition of non-appealable issues; (5) transferring jurisdiction of an appeal to the Board upon entry of a docket notice by the Board; (6) relinquishing the Board's jurisdiction in an appeal when the Board orders a remand or enters a final decision and judicial review is sought or the time for seeking judicial review expires; (7) changing the format and content of the appeal brief to require the following additional sections: (a) Jurisdictional statement, (b) table of contents, (c) table of authorities, and (d) statement of facts; (8) changing the format and content of the appeal brief appendix to include the following additional sections: (a) claim support section, (b) drawing analysis section, (c) means or step plus function analysis section, and (d) an expanded evidence section to include, inter alia, relevant Office action(s) and portions of papers filed by appellant during prosecution; (9) providing page limits for all briefs; (10) prohibiting incorporation by reference in briefs; (11) establishing a format for a reply brief to include: (a) Table of contents, (b) table of authorities, (c) statement of timeliness, (d) statement of facts in response to a new ground of rejection in examiner's answer, (e) argument, and where appropriate, (f) supplemental appendix; (12) providing for a supplemental reply brief, if a supplemental examiner's answer is furnished by the examiner; (13) establishing a format for a supplemental reply brief to include: (a) Table of contents, (b) table of authorities, (c) statement of timeliness, and (d) argument; (14) requiring appellant to supply a list of technical terms and other unusual words at the time of confirmation of the oral hearing to aid in transcription at the oral hearing; (15) eliminating requests for extension of time to respond to a request for further briefing and information by the Board; (16) establishing a format for a request for rehearing to include: (a) Table of contents, (b) table of authorities, (c) statement of timeliness, and (d) argument; and (17) providing sanctions to be imposed on the appellant for misconduct during prosecution of the appeal.

The changes in the proposed rules relate solely to the procedure to be followed in filing and prosecuting an ex parte appeal to the Board. Therefore, these rule changes involve interpretive rules, or rules of agency practice and procedure under 5 U.S.C. 553(b)(A), and prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553(b)(A) (or any other law). *See Bachow Communications Inc.* v. *FCC*, 237 F.3d 683, 690 (DC Cir. 2001) (rules governing an application process are ''rules of agency organization, procedure, or practice'' and exempt from the Administrative Procedure Act's notice and comment requirement); *Merck & Co., Inc.* v. *Kessler*, 80 F.3d 1543, 1549–50, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996) (the rules of practice promulgated under the authority of former 35 U.S.C. 6(a) (now in 35 U.S.C. 2(b)(2)) are not substantive rules (to which the notice and comment requirements of the Administrative Procedure Act apply)); *Fressola* v. *Manbeck*, 36 USPQ2d 1211, 1215 (D.D.C. 1995) (''it is extremely doubtful whether any of the rules formulated to govern patent and trademark practice are other than 'interpretive rules, general statements of policy, * * * procedure, or practice' '' (quoting C.W. Ooms, *The United States Patent Office and the Administrative Procedure Act*, 38 Trademark Rep. 149, 153 (1948)); *Eli Lilly & Co.* v. *Univ. of Washington*, 334 F.3d 1264, 1269 n.1, 67 USPQ2d 1161, 1165 n.1 (Fed. Cir. 2003) (add parenthetical).

Regulatory Flexibility Act

As previously discussed, the changes in the proposed rules involve interpretive rules, or rules of agency practice and procedure, and prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553(b)(A) (or any other law). Because prior notice and an opportunity for public comment are not required for the changes in the proposed rules, a final Regulatory Flexibility Act analysis is also not required for the changes in the proposed rules. *See* 5 U.S.C. 603. Nevertheless, the USPTO is publishing a notice of proposed rule making in the **Federal Register** and in the Official Gazette of the United States Patent and Trademark Office, in order to solicit

public participation with regard to this rule package.

The USPTO received approximately 443,000 patent applications in Fiscal Year 2006. The proposed rules apply only to those applications where an appeal brief is filed with the Board. In Fiscal Year 2006, approximately 18,500 appeal briefs were filed. Of those 18,500 appeal briefs, approximately 4,000 were filed by small entities. Thus, the number of small entities affected by these proposed rule changes is not substantial (approximately 0.9%). Also, the proposed rules do not disproportionately impact small entities.

The proposed rules which change the format and content of briefs may require the appellant to spend additional time in preparing a compliant brief. The effect of such rules, however, will be to enhance the likelihood that the appealed claims will be allowed without the necessity of further proceeding with the appeal and improve the efficiency of the decision-making process at the Board. Any additional time burden that is imposed by the proposed rules relating to briefs is believed to be *de minimus* in comparison to the reduction in pendency that appellant gains as a result of early identification of allowable claims or a more efficient decision-making process. Moreover, the fees associated with filing an appeal with the Board are set by statute, and are not proposed for change in this rule making. These proposed procedural rules do not significantly increase the cost of filing or prosecuting an appeal before the Board.

Accordingly, these proposed rules do not have 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.*). The collection of information involved in this proposed rule has been reviewed and previously approved by OMB under control number 0651–0031. The United States Patent and Trademark Office is not resubmitting an information collection package to OMB for its review and approval because the changes in this proposed rule would not affect the information collection requirements associated with the information collection under OMB control number 0651–0031.

Comments are invited on: (1) Whether the collection of information is necessary for proper performance of the functions of the agency; (2) the accuracy of the agency's estimate of the burden; (3) ways to enhance the quality, utility, and clarity of the information to be collected; and (4) ways to minimize the burden of the collection of information to respondents.

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to Robert Clarke, Director, Office of Patent Legal Administration, United States Patent and Trademark Office, Washington, DC 20231, or to the Office of Information and Regulatory Affairs, OMB, 725 17th Street, NW., Washington, DC 20503, (Attn: PTO Desk Officer).

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 in 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 part 41 as follows:

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

1. The authority citation for part 41 is amended to read as follows:

Authority: 35 U.S.C. 2(b)(2), 3(a)(2)(A), 21, 23, 32, 132, 133, 134, 135, 306, and 315.

Subpart A—General Provisions

1. In § 41.2, revise the definitions of ''Board'' and ''Contested case'' to read as follows:

§ 41.2 Definitions.

* * * * *

Board means the Board of Patent Appeals and Interferences and includes:

(1) For a final Board action in an appeal or contested case, a panel of the Board.

(2) For non-final actions, a Board member or employee acting with the authority of the Board.

* * * * *

Contested case means a Board proceeding other than an appeal under 35 U.S.C. 134. An appeal in an inter partes reexamination proceeding is not a contested case.

* * * * *

2. In § 41.3, revise paragraphs (a) and (b) to read as follows:

§ 41.3 Petitions.

(a) *Deciding official.* A petition authorized by this part must be addressed to the Chief Administrative Patent Judge. In addition to complying with all other requirements of this title, a copy of the petition must also be forwarded to the Office addressed to: Chief Administrative Patent Judge, Board of Patent Appeals and Interferences, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313–1450. The Chief Administrative Patent Judge may delegate authority to decide petitions.

(b) *Scope.* This section covers petitions on matters pending before the Board, petitions authorized by this part and petitions seeking relief under 35 U.S.C. 135(c); otherwise see §§ 1.181 to 1.183 of this title. The following matters are not subject to petition:

(1) Issues committed by statute to a panel.

(2) In pending contested cases, procedural issues. See § 41.121(a)(3) and § 41.125(c).

* * * * *

3. In § 41.4, revise paragraphs (b) and (c) to read as follows:

§ 41.4 Timeliness.

* * * * *

(b) *Late filings.* (1) A request to revive an application which becomes abandoned or a reexamination proceeding which becomes terminated under §§ 1.550(d) or 1.957(b) or (c) of this title as a result of a late filing may be filed pursuant to § 1.137 of this title.

(2) A late filing that does not result in an application becoming abandoned or a reexamination proceeding becoming terminated under §§ 1.550(d) or 1.957(b) or (c) of this title may be excused upon a showing of excusable neglect or a Board determination that consideration on the merits would be in the interests of justice.

(c) *Scope.* Except to the extent provided in this part, this section

governs proceedings before the Board, but does not apply to filings related to Board proceedings before or after the Board has jurisdiction (§ 41.35), such as:

(1) Extensions during prosecution (see § 1.136 of this title).

(2) Filing of a notice of appeal and an appeal brief (see §§ 41.31(c) and 41.37(c)).

(3) Seeking judicial review (see §§ 1.301 to 1.304 of this title).

Subpart B—Ex Parte Appeals

4. Revise § 41.30 to add a definition of ''record on appeal'' to read as follows:

§ 41.30 Definitions.

* * * * *

Record on appeal. The record on appeal consists of the specification, drawings, if any, U.S. patents cited by the examiner or appellant, published U.S. applications cited by the examiner or appellant, the appeal brief, including all appendices, the examiner's answer, any reply brief, including any supplemental appendix, any supplemental examiner's answer, any supplemental reply brief, any request for rehearing, any order or decision entered by the Board or the Chief Administrative Patent Judge, and any other document or evidence which was considered by the Board as indicated in any opinion accompanying any order or decision.

5. Revise § 41.31 to read as follows:

§ 41.31 Appeal to Board.

(a) *Notice of appeal.* An appeal is taken to the Board by filing a notice of appeal.

(b) *Fee.* The notice of appeal shall be accompanied by the fee required by § 41.20(b)(1).

(c) *Time for filing notice of appeal.* A notice of appeal must be filed within the time period provided under § 1.134 of this title.

(d) *Extensions of time to file notice of appeal.* The time for filing a notice of appeal is extendable under the provisions of § 1.136(a) of this title for applications and § 1.550(c) of this title for ex parte reexamination proceedings.

(e) *Non-appealable issues.* A non-appealable issue is an issue not subject to an appeal under 35 U.S.C. 134. An applicant or patent owner dissatisfied with a decision of an examiner on a non-appealable issue shall timely seek review by petition before jurisdiction over an appeal is transferred to the Board (§ 41.35). Failure to timely file a petition seeking review of a decision of the examiner related to a non-appealable issue may constitute a waiver to have that issue considered.

6. Revise § 41.33 to read as follows:

§ 41.33 Amendments and evidence after appeal.

(a) *Amendment after notice of appeal and prior to appeal brief.* An amendment filed after the date a notice of appeal is filed and prior to the date an appeal brief is filed may be admitted as provided in § 1.116 of this title.

(b) *Amendment with or after appeal brief.* An amendment filed on or after the date an appeal brief is filed may be admitted:

(1) *To cancel claims.* To cancel claims provided cancellation of claims does not affect the scope of any other pending claim in the application or patent under reexamination, or

(2) *To convert dependent claim to independent claim.* To rewrite dependent claims into independent form.

(c) *Other amendments.* No other amendments filed after the date an appeal brief is filed will be admitted, except as permitted by §§ 41.39(b)(1), 41.50(b)(1), 41.50(d)(1) or 41.50(e) of this subpart.

(d) *Evidence after notice of appeal and prior to appeal brief.* Evidence filed after the date a notice of appeal is filed and prior to the date an appeal brief is filed may be admitted if the examiner determines that the evidence overcomes some or all rejections under appeal and appellant shows good cause why the evidence was not earlier presented.

(e) *Other evidence.* All other evidence filed after the date an appeal brief is filed will not be admitted, except as permitted by §§ 41.39(b)(1), 41.50(b)(1) or 41.50(d)(1) of this subpart.

7. Revise § 41.35 to read as follows:

§ 41.35 Jurisdiction over appeal.

(a) *Beginning of jurisdiction.* The jurisdiction of the Board begins when a docket notice is entered by the Board.

(b) *End of jurisdiction.* The jurisdiction of the Board ends when the Board orders a remand (see § 41.50(b) or § 41.50(d)(1) of this subpart) or enters a final decision (see § 41.2 of this subpart) and judicial review is sought or the time for seeking judicial review has expired.

(c) *Remand ordered by the Director.* Prior to entry of a decision on the appeal by the Board (§ 41.50), the Director may sua sponte order an application or reexamination proceeding on appeal to be remanded to the examiner.

8. Revise § 41.37 to read as follows:

§ 41.37 Appeal brief.

(a) *Requirement for appeal brief.* An appeal brief shall be timely filed to perfect an appeal. Upon failure to file an appeal brief, the proceedings on the appeal are terminated without further action on the part of the Office.

(b) *Fee.* The appeal brief shall be accompanied by the fee required by § 41.20(b)(2) of this subpart.

(c) *Time for filing appeal brief.* Appellant must file an appeal brief within two months from the date of the filing of the notice of appeal (§ 41.31(a)).

(d) *Extension of time to file appeal brief.* The time for filing an appeal brief is extendable under the provisions of § 1.136(a) of this title for applications and § 1.550(c) of this title for ex parte reexamination proceedings.

(e) *Content of appeal brief.* The appeal brief must contain, under appropriate headings and in the order indicated, the following items:

(1) Statement of the real party in interest.

(2) Statement of related cases.

(3) Jurisdictional statement.

(4) Table of contents.

(5) Table of authorities.

(6) Status of claims.

(7) Status of amendments.

(8) Rejections to be reviewed.

(9) Statement of facts.

(10) Argument.

(11) An appendix containing a claims section, a claim support section, a drawing analysis section, a means or step plus function analysis section, an evidence section and a related cases section.

(f) *Statement of real party in interest.* The ''statement of the real party in interest'' shall identify the name of the real party in interest. The real party in interest must be identified in such a manner as to readily permit a member of the Board to determine whether recusal would be appropriate. Appellant is under a continuing obligation to update this item during the pendency of the appeal.

(g) *Statement of related cases.* The ''statement of related cases'' shall identify, by application, patent, appeal, interference, or court docket number, all prior or pending appeals, interferences or judicial proceedings, known to appellant, appellant's legal representative or any assignee, and that are related to, directly affect, or would be directly affected by, or have a bearing on the Board's decision in the appeal. A copy of any final or significant interlocutory decision rendered by the Board or a court in any proceeding identified under this paragraph shall be included in the related cases section of the appendix. Appellant is under a continuing obligation to update this item during the pendency of the appeal.

(h) *Jurisdictional statement.* The ''jurisdictional statement'' shall establish the jurisdiction of the Board to consider the appeal. The jurisdictional statement shall include a statement of

the statute under which the appeal is taken, the date of the decision from which the appeal is taken, the date the notice of appeal was filed, and the date the appeal brief is being filed. If a notice of appeal or an appeal brief is filed after the time specified in this subpart, appellant must also indicate the date an extension of time was requested and, if known, the date the request was granted.

(i) *Table of contents.* A ''table of contents'' shall list, along with a reference to the page where each item begins, the items required to be listed in the appeal brief (see paragraph (e) of this section), reply brief (see § 41.41(d) of this subpart) or supplemental reply brief (see § 41.44(d) of this subpart), as appropriate.

(j) *Table of authorities.* A ''table of authorities'' shall list cases (alphabetically arranged), statutes and other authorities along with a reference to the pages where each authority is cited in the appeal brief, reply brief, or supplemental reply brief, as appropriate.

(k) *Status of pending claims.* The ''status of pending claims'' shall include a statement of the status of all pending claims (e.g., rejected, allowed, cancelled, withdrawn from consideration, or objected to).

(l) *Status of amendments.* The ''status of amendments'' shall indicate the status of all amendments filed after final rejection (e.g., whether entered or not entered).

(m) *Rejections to be reviewed.* The ''rejections to be reviewed'' shall set out the rejections to be reviewed, including the claims subject to each rejection.

(n) *Statement of facts.* The ''statement of facts'' shall set out in an objective and non-argumentative manner the material facts relevant to the rejections on appeal. A fact shall be supported by a reference to a specific page number and, where applicable, a specific line or drawing numerals of the record on appeal. A general reference to a document as a whole or to large portions of a document does not comply with the requirements of this paragraph.

(o) *Argument.* The ''argument'' shall explain why the examiner is believed to have erred as to each rejection to be reviewed. Any explanation must address all points made by the examiner with which the appellant disagrees and must identify where the argument was made in the first instance to the examiner or state that the argument has not previously been made to the examiner. Any finding made or conclusion reached by the examiner that is not challenged will be presumed to be correct. Each rejection shall be separately argued under a separate heading. For arguments traversing a rejection made under 35 U.S.C. 102, 103 or 112, see also paragraphs (o)(4) through (o)(7) of this section. For arguments traversing other rejections, see also paragraph (o)(8) of this section.

(1) *Claims standing or falling together.* When a rejection applies to two or more claims, as to that rejection, the appellant may elect to have all claims stand or fall together, or argue the separate patentability of individual claims. If the appeal brief fails to make an explicit election, the Board will treat all claims subject to a rejection as standing or falling together, and select a single claim to decide the appeal as to that rejection. Any doubt as to whether an election has been made or whether an election is clear will be resolved against the appellant. Any claim argued separately shall be placed under a subheading identifying the claim by number. A statement that merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(2) *Arguments considered.* Only those arguments which are presented in the argument section of the appeal brief and that address claims set out in the claim support section of the appendix will be considered. Appellant waives all other arguments.

(3) *Format of argument.* Unless a response is purely legal in nature, when responding to a point made in the examiner's rejection, the appeal brief shall specifically identify the point made by the examiner and indicate where appellant previously responded to the point or state that appellant has not previously responded to the point. In identifying any point made by the examiner, the appellant shall refer to a page and, where appropriate, a line, of the record on appeal.

(4) *Rejection under 35 U.S.C. 112, first paragraph.* For each rejection under 35 U.S.C. 112, first paragraph, the argument shall also specify the errors in the rejection and how the rejected claims comply with the first paragraph of 35 U.S.C. 112 including, as appropriate, how the specification and drawings, if any, describe the subject matter defined by the rejected claims, enable any person skilled in the art to which the invention pertains to make and use the subject matter of the rejected claims, or set forth the best mode contemplated by the inventor of carrying out the claimed invention.

(5) *Rejection under 35 U.S.C. 112, second paragraph.* For each rejection under 35 U.S.C. 112, second paragraph, the argument shall also specify how the rejected claims particularly point out and distinctly claim the subject matter which appellant regards as the invention.

(6) *Rejection under 35 U.S.C. 102.* For each rejection under 35 U.S.C. 102 (anticipation), the argument shall also specify why the rejected claims are patentable by identifying any specific limitation in the rejected claims which is not described in the prior art relied upon in support of the rejection.

(7) *Rejection under 35 U.S.C. 103.* For each rejection under 35 U.S.C. 103, if appropriate, the argument shall specify the errors in the rejection and, if appropriate, specify the specific limitations in the rejected claims that are not described in the prior art relied upon in support of the rejection, and explain how those limitations render the claimed subject matter unobvious over the prior art. A general argument that all limitations are not described in a single prior art reference does not satisfy the requirements of this paragraph.

(8) *Other rejections.* For each rejection other than those referred to in paragraphs (o)(4) through (o)(7), the argument shall specify the errors in the rejection, including where appropriate, the specific limitations in the rejected claims upon which the appellant relies to establish error.

(p) *Claims section.* The ''claims section'' of the appendix shall consist of an accurate clean copy in numerical order of all claims pending in the application or reexamination proceeding on appeal. The status of each claim shall be set out after the claim number and in parentheses (e.g., 1 (rejected), 2 (withdrawn), 3 (objected to), and 4 (allowed)).

(q) *Claim support section.* For each claim argued separately (see paragraph (o)(1) of this section), the ''claim support section'' of the appendix shall consist of an annotated copy of the claim indicating in bold face between braces ({}) the page and line after each limitation where the limitation is described in the specification as filed.

(r) *Drawing analysis section.* For each claim argued separately (see paragraph (o)(1) of this section) and having at least one limitation illustrated in a drawing or amino acid or nucleotide material sequence, the ''drawing analysis section'' of the appendix shall consist of an annotated copy of the claim indicating in bold face between braces ({}) where each limitation is shown in the drawings or sequence. If there is no drawing or sequence, the drawing analysis section shall state that there is no drawing or sequence.

(s) *Means or step plus function analysis section.* For each claim argued

separately (see paragraph (o)(1) of this section) and for each limitation that appellant regards as a means or step plus function limitation in the form permitted by the sixth paragraph of 35 U.S.C. 112, the ''means or step plus function analysis section'' of the appendix shall consist of an annotated copy of the claim indicating in bold face between braces ({}) the page and line of the specification and the drawing figure and element numeral that describes the structure, material or acts corresponding to each claimed function. If there is no means or step plus function limitation, the means or step plus function analysis section shall state that there are not means or step plus function limitations in the claims to be considered.

(t) *Evidence section.* The ''evidence section'' shall contain only papers which have been entered by the examiner. The evidence section shall include:

(1) A table of contents.

(2) The Office action setting out the rejection on appeal. If the Office action incorporates by reference any other Office action, then the Office action incorporated by reference shall also appear in the evidence section.

(3) All evidence relied upon by the examiner in support of the rejection on appeal (including non-patent literature and foreign application and patent documents), except the specification, any drawings, U.S. patents or published U.S. applications.

(4) The relevant portion of a paper filed by the appellant before the examiner which shows that an argument being made on appeal was made in the first instance to the examiner.

(5) Affidavits and declarations, if any, and attachments to declarations, relied upon by appellant before the examiner.

(6) Other evidence, if any, relied upon by the appellant before the examiner.

(u) *Related cases section.* The ''related cases section'' shall consist of copies of orders and opinions required to be cited pursuant to paragraph (g) of this section.

(v) *Appeal brief format requirements.* An appeal brief shall comply with § 1.52 of this title and the following additional requirements:

(1) *Page and line numbering.* The pages of the appeal brief, including all sections of the appendix, shall be consecutively numbered using Arabic numerals beginning with the first page of the appeal brief, which shall be numbered page 1. The lines on each page of the appeal brief and, where practical, the appendix shall be consecutively numbered beginning with line 1 at the top of each page.

(2) *Double spacing.* Double spacing shall be used except in headings, tables of contents, tables of authorities and signature blocks. Block quotations must be double spaced and indented.

(3) *Margins.* Margins shall be at least one inch (2.5 centimeters) on all sides. Line numbering may be within the left margin.

(4) *Font.* The font shall be readable and clean, equivalent to 14 point Times New Roman, including the font for block quotations and footnotes.

(5) *Length of appeal brief.* An appeal brief may not exceed 25 pages, excluding any statement of the real party in interest, statement of related cases, table of contents, table of authorities, signature block, and appendix. An appeal brief may not incorporate another paper by reference. A request to exceed the page limit shall be made by petition under § 41.3 filed at least ten calendar days prior to the date the appeal brief is due.

(6) *Signature block.* The signature block must identify the appellant or appellant's representative, as appropriate, and a registration number, a correspondence address, a telephone number, a fax number and an e-mail address.

9. Revise § 41.39 to read as follows:

§ 41.39 Examiner's answer.

(a) *Answer.* If the examiner determines that the appeal should go forward, then within such time and manner as may be established by the Director the examiner shall enter an examiner's answer responding to the appeal brief.

(b) *New rejection in examiner's answer.* An examiner's answer may include a new rejection. If an examiner's answer contains a rejection designated as a new rejection, appellant must, within two months from the date of the examiner's answer, exercise one of the following two options or the application will be deemed to be abandoned or the reexamination proceeding will be deemed to be terminated.

(1) *Request to 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 evidence. Any amendment or evidence must be responsive to the new rejection. A request that complies with this paragraph will be entered and the application or patent under reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. A request under this paragraph will be treated as a request to withdraw the appeal.

(2) *Request to maintain the appeal.* Request that the appeal be maintained by filing a reply brief as set forth in § 41.41 of this subpart. A reply brief may not be accompanied by any amendment or evidence, except an amendment canceling one or more claims which are subject to the new rejection. A reply which is accompanied by evidence or any other amendment will be treated as a request to reopen prosecution pursuant to paragraph (b)(1) of this section.

(c) *Extension of time to file request.* The time for filing a request under § 41.39(b)(1) is extendable under the provisions of § 1.136(a) of this title as to applications and under the provisions of § 1.550(c) of this title as to reexamination proceedings. A request for an extension of time for filing a request under paragraph (b)(2) of this section shall be presented as a petition under § 41.3 of this part.

10. Revise § 41.41 to read as follows:

§ 41.41 Reply brief.

(a) *Reply brief authorized.* An appellant may file a single reply brief responding to the points made in the examiner's answer.

(b) *Time for filing reply brief.* If the appellant elects to file a reply brief, the reply brief must be filed within two months of the date of the mailing of the examiner's answer.

(c) *Extension of time to file reply brief.* A request for an extension of time to file a reply brief shall be presented as a petition under § 41.3 of this subpart.

(d) *Content of reply brief.* A reply brief shall be limited to responding to points made in the examiner's answer. Except as otherwise set out in this section, the form and content of a reply brief are governed by the requirements for an appeal brief as set out in § 41.37 of this subpart. A reply brief may not exceed fifteen pages, excluding any table of contents, table of authorities, statement of timeliness, signature block, and supplemental appendix required by this section. If the examiner enters and designates a rejection as a new rejection, the reply brief may not exceed twenty-five pages, excluding any table of contents, table of authorities, statement of timeliness, signature block, and supplemental appendix required by this section. A request to exceed the page limit shall be made by petition under § 41.3 of this part and filed at least ten calendar days before the reply brief is due. A reply brief must contain, under appropriate headings and in the order indicated, the following items:

(1) Table of contents—see § 41.37(i) of this subpart.

(2) Table of authorities—see § 41.37(j) of this subpart.

(3) Statement of timeliness—see paragraph (e) of this section.

(4) Statement of facts—see paragraph (f) of this section.

(5) Argument.

(6) Supplemental appendix.

(e) *Statement of timeliness.* The ''statement of timeliness'' shall include the date that the examiner's answer was entered and the date that the reply is being filed. If the reply brief is filed after the time specified in this subpart, appellant must indicate the date an extension of time was requested and the date the request was granted.

(f) *Statement of additional facts.* The ''statement of additional facts'' shall consist of a statement of the additional facts that appellant believes are necessary to address the points raised in the examiner's answer and, as to each fact, must identify the point raised in the examiner's answer to which the fact relates.

(g) *Argument.* A reply brief is limited to responding to points made in the examiner's answer. Arguments generally restating the case will not be permitted in a reply brief.

(h) *Supplemental appendix.* If the examiner entered a new rejection in the examiner's answer and appellant elects to respond to the new rejection in a reply brief, this item shall include:

(1) A table of contents—see § 41.37(i) of this subpart.

(2) The examiner's answer.

(3) All evidence upon which the examiner relied in support of the new rejection that does not already appear in the evidence section accompanying the appeal brief, except the specification, any drawings, U.S. patents and U.S. published applications.

(i) *No amendment or new evidence.* No amendment or new evidence may accompany a reply brief.

11. Revise § 41.43 to read as follows:

§ 41.43 Examiner's response to reply brief.

Upon consideration of a reply brief, the examiner may withdraw a rejection and reopen prosecution or may enter a supplemental examiner's answer responding to the reply brief.

12. Add § 41.44 to read as follows:

§ 41.44 Supplemental reply brief. [new rule number]

(a) *Supplemental reply brief authorized.* If an examiner enters a supplemental examiner's answer, an appellant may file a single supplemental reply brief responding to the supplemental examiner's answer.

(b) *Time for filing supplemental reply brief.* Appellant must file a supplemental reply brief within two months from the date of the mailing of the examiner's supplemental answer.

(c) *Extension of time to file supplemental reply brief.* A request for an extension of time shall be presented as a petition under § 41.3.

(d) *Content of supplemental reply brief.* Except as otherwise set out in this subparagraph, the form and content of a supplemental reply brief are governed by the requirements for appeal briefs as set out in § 41.37 of this subpart. A supplemental reply brief may not exceed ten pages, excluding the table of contents, table of authorities, and statement of timeliness and signature block. A request to exceed the page limit shall be made by petition under § 41.3 of this part and filed at least ten calendar days before the supplemental reply brief is due. A supplemental reply brief must contain, under appropriate headings and in the order indicated, the following items:

(1) Table of contents—see § 41.37(i) of this subpart.

(2) Table of authorities—see § 41.37(j) of this subpart.

(3) Statement of timeliness—see paragraph (e) of this section.

(4) Argument—see paragraph (f) of this section.

(e) *Statement of timeliness.* The ''statement of timeliness'' shall establish that the supplemental reply brief was timely filed by including a statement of the date the supplemental examiner's answer was entered and the date the supplemental reply brief is being filed. If the supplemental reply brief is filed after the time specified in this subpart, appellant must indicate the date an extension of time was requested and the date the request was granted.

(f) *Argument.* The ''argument'' shall be limited to responding to points made in the supplemental examiner's answer. Arguments generally restating the case will not be permitted in a supplemental reply brief.

(g) *No amendment or new evidence.* No amendment or new evidence may accompany a supplemental reply brief.

13. Revise § 41.47 to read as follows:

§ 41.47 Oral hearing.

(a) *Request for oral hearing.* If appellant desires an oral hearing, appellant must file, as a separate paper, a written request captioned: ''REQUEST FOR ORAL HEARING''.

(b) *Fee.* A request for oral hearing shall be accompanied by the fee required by § 41.20(b)(3) of this subpart.

(c) *Time for filing request for oral hearing.* Appellant must file a request for oral hearing within two months from the date of the examiner's answer or supplemental examiner's answer.

(d) *Extension of time to file request for oral hearing.* A request for an extension of time shall be presented as a petition under § 41.3 of this subpart.

(e) *Date for oral hearing.* If an oral hearing is properly requested, the Board shall set a date for the oral hearing.

(f) *Confirmation of oral hearing.* Within such time as may be ordered by the Board, appellant shall confirm attendance at the oral hearing. Failure to timely confirm attendance will be taken as a waiver of any request for an oral hearing.

(g) *List of terms.* At the time appellant confirms attendance at the oral hearing, appellant shall supply a list of technical terms and other unusual words which can be provided to any individual transcribing an oral hearing.

(h) *Length of argument.* Unless otherwise ordered by the Board, argument on behalf of appellant shall be limited to 20 minutes.

(i) *Oral hearing limited to record.* At oral hearing only the record on appeal will be considered. No additional evidence may be offered to the Board in support of the appeal. Any argument not presented in a brief cannot be raised at an oral hearing.

(j) *Recent legal development.* Notwithstanding subparagraph (i) of this section, an appellant or the examiner may rely on and call the Board's attention to a recent court or Board opinion which could have an effect on the manner in which the appeal is decided.

(k) *Visual aids.* Visual aids may be used at an oral hearing, but must be limited to copies of documents in the record on appeal. At the oral hearing, appellant should provide one copy of each visual aid for each judge and one copy for the record.

(l) *Failure to attend oral hearing.* Failure of an appellant to attend an oral hearing will be treated as a waiver of oral hearing.

14. Revise § 41.50 to read as follows:

§ 41.50 Decisions and other actions by the Board.

(a) *Affirmance and reversal.* The Board may affirm or reverse an examiner's rejection in whole or in part. Affirmance of a rejection of a claim constitutes a general affirmance of the decision of the examiner on that claim, except as to any rejection specifically reversed.

(b) *Remand.* The Board may remand an application to the examiner. If in response to the remand, the examiner enters a supplemental examiner's answer, within two months the appellant shall exercise one of the following two options to avoid

abandonment of the application or termination of a reexamination proceeding:

(1) *Request to 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 evidence. Any amendment or evidence must be responsive to the remand or issues discussed in the supplemental examiner's answer. A request that complies with this paragraph will be entered and the application or patent under reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. A request under this paragraph will be treated as a request to dismiss the appeal.

(2) *Request to maintain the appeal.* The appellant may request that the Board re-docket the appeal (see § 41.35(a) of this subpart) and file a reply brief as set forth in § 41.41 of this subpart. A reply brief may not be accompanied by any amendment or evidence. A reply brief which is accompanied by an amendment or evidence will be treated as a request to reopen prosecution pursuant to paragraph (b)(1) of this section.

(c) *Remand not final action.* Whenever a decision of the Board includes a remand, the decision shall not be considered a final decision of the Board. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order making its decision final.

(d) *New rejection.* Should the Board have a basis not involved in the appeal for rejecting any pending claim, it may enter a new rejection. A new rejection shall be considered an interlocutory order and shall not be considered a final decision. If the Board enters a new rejection, within two months appellant must exercise one of the following two options with respect to the new rejection to avoid dismissal of the appeal as to any claim subject to the new rejection:

(1) *Reopen prosecution.* Submit an amendment of the claims subject to a new rejection or new evidence relating to the new rejection or both, and request that the matter be reconsidered by the examiner. The application or reexamination proceeding on appeal will be remanded to the examiner. A new rejection by the Board is binding on the examiner unless, in the opinion of the examiner, the amendment or new evidence overcomes the new rejection. In the event the examiner maintains the new rejection, appellant may again appeal to the Board.

(2) *Request for rehearing.* Submit a request for rehearing pursuant to § 41.52 of this subpart relying on the record on appeal.

(e) *Recommendation.* In its opinion in support of its decision, the Board may include a recommendation, explicitly designated as such, of how a claim on appeal may be amended to overcome a specific rejection. When the Board makes a recommendation, appellant may file an amendment or take other action consistent with the recommendation. An amendment or other action, otherwise complying with statutory patentability requirements, will overcome the specific rejection. An examiner, however, may enter a new rejection of a claim amended in conformity with a recommendation, when appropriate.

(f) *Request for briefing and information.* The Board may enter an order requiring appellant to brief matters or supply information or both that the Board believes would assist in deciding the appeal. Appellant will be given a non-extendable time period within which to respond to the order. Failure of appellant to timely respond to the order may result in dismissal of the appeal in whole or in part.

(g) *Extension of time to take action.* A request for an extension of time to respond to a request for briefing and information under paragraph (f) of this section is not authorized. A request for an extension of time to respond to Board action under paragraphs (b) and (d) of this section shall be presented as a petition under § 41.3 of this subpart.

15. Revise § 41.52 to read as follows:

§ 41.52 Rehearing.

(a) *Request for rehearing authorized.* An appellant may file a single request for rehearing.

(b) *Time for filing request for rehearing.* Any request for rehearing must be filed within two months from the date of the decision entered by the Board.

(c) *Extension of time to file request for rehearing.* A request for an extension of time shall be presented as a petition under § 41.3 of this subpart.

(d) *Content of request for rehearing.* A request for rehearing shall state with particularity the points believed to have been misapprehended or overlooked by the Board. The form of a request for rehearing is governed by the requirements of § 41.37(v) of this subpart, except that a request for rehearing may not exceed ten pages, excluding any table of contents, table of authorities, statement of timeliness, and signature block. A request to exceed the page limit shall be made by petition under § 41.3 at least ten calendar days before the request for rehearing is due. A request for rehearing must contain, under appropriate headings and in the order indicated, the following items:

(1) Table of contents—see § 41.37(i) of this subpart.

(2) Table of authorities—see 41.37(j) of this subpart.

(3) Statement of timeliness—see paragraph (e) of this section.

(4) Argument—see paragraph (f) of this section.

(e) *Statement of timeliness.* The ''statement of timeliness'' shall establish that the request for rehearing was timely filed by including a statement of the date the decision sought to be reheard was entered and the date the request for rehearing is being filed. If the request for rehearing is filed after the time specified in this subpart, appellant must indicate the date an extension of time was requested and the date the request was granted.

(f) *Argument.* In filing a request for rehearing, the argument shall adhere to the following format: ''On page x, lines y–z of the Board's opinion, the Board states that [set out what was stated]. The point misapprehended or overlooked was made to the Board in [identify paper, page and line where argument was made to the Board]. The response is [state response].'' As part of each response, appellant shall refer to the page number and line or drawing number of the record on appeal. No general restatement of the case is permitted in a request for rehearing. A new argument cannot be made in a request for rehearing, except:

(1) New rejection. Appellant may respond to a new rejection entered pursuant to § 41.50(d)(2) of this subpart.

(2) Recent legal development. Appellant may rely on and call the Board's attention to a recent court or Board opinion which is relevant to an issue decided in the appeal.

(g) *No amendment or new evidence.* No amendment or new evidence may accompany a request for rehearing.

(h) *Decision on rehearing.* A decision will be rendered on a request for rehearing. The decision on rehearing is deemed to incorporate the underlying decision sought to be reheard except for those portions of the underlying decision specifically modified on rehearing. A decision on rehearing is final for purposes of judicial review, except when otherwise noted in the decision on rehearing.

16. Revise § 41.54 to read as follows:

§ 41.54 Action following decision.

After a decision by the Board and subject to appellant's right to seek

judicial review, the application or reexamination proceeding will be returned to the jurisdiction of the examiner for such further action as may be appropriate consistent with the decision by the Board.

17. Add § 41.56 to read as follows:

§ 41.56 Sanctions.

(a) *Imposition of sanctions.* A sanction may be imposed against an appellant for misconduct, including:

(1) Failure to comply with an order entered in the appeal or an applicable rule.

(2) Advancing or maintaining a misleading or frivolous request for relief or argument.

(3) Engaging in dilatory tactics.

(b) *Nature of sanction.* Sanctions may include entry of:

(1) An order declining to enter a docketing notice.

(2) An order holding certain facts to have been established in the appeal.

(3) An order expunging a paper or precluding an appellant from filing a paper.

(4) An order precluding an appellant from presenting or contesting a particular issue.

(5) An order excluding evidence.

(6) An order requiring terminal disclaimer of patent term.

(7) An order holding an application on appeal to be abandoned or a reexamination proceeding terminated.

(8) An order dismissing an appeal.

(9) An order denying an oral hearing.

(10) An order terminating an oral hearing.

Dated: July 19, 2007.

Jon W. Dudas,

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

[FR Doc. E7–14645 Filed 7–27–07; 8:45 am]

BILLING CODE 3510–16–P

ENVIRONMENTAL PROTECTION AGENCY

40 CFR Part 52

[EPA–R05–OAR–2007–0292; FRL–8443–1]

Approval and Promulgation of Air Quality Implementation Plans; Indiana

AGENCY: Environmental Protection Agency (EPA).

ACTION: Proposed rule.

SUMMARY: EPA is proposing to approve Indiana's requests to amend its State Implementation Plan (SIP) for control of particulate matter in 326 IAC 6.5–7–13. Indiana submitted the SIP revision requests to EPA on November 1, 2005 and March 20, 2007. The revisions would change the source name from St. Mary's to Holy Cross Services Corporation (Saint Mary's Campus), and clarify and revise existing particulate matter (PM) emission limits for the boilers at that source to reflect current operating conditions. These revisions will not result in an increase in PM emissions.

DATES: Comments must be received on or before August 29, 2007.

ADDRESSES: Submit your comments, identified by Docket ID No. EPA–R05–OAR–2007–0292, by one of the following methods:

1. *http://www.regulations.gov:* Follow the on-line instructions for submitting comments.

2. *E-mail: mooney.john@epa.gov.*

3. *Fax:* (312) 886–5824.

4. *Mail:* John M. Mooney, Chief, Criteria Pollutant Section, Air Programs Branch (AR–18J), U.S. Environmental Protection Agency, 77 West Jackson Boulevard, Chicago, Illinois 60604.

5. *Hand Delivery:* John M. Mooney, Chief, Criteria Pollutant Section, Air Programs Branch (AR–18J), U.S. Environmental Protection Agency, 77 West Jackson Boulevard, Chicago, Illinois 60604. Such deliveries are only accepted during the Regional Office normal hours of operation, and special arrangements should be made for deliveries of boxed information. The Regional Office official hours of business are Monday through Friday, 8:30 a.m. to 4:30 p.m. excluding Federal holidays.

Please see the direct final rule which is located in the Rules section of this **Federal Register** for detailed instructions on how to submit comments.

FOR FURTHER INFORMATION CONTACT: Charles Hatten, Environmental Engineer, Criteria Pollutant Section, Air Programs Branch (AR–18J), Environmental Protection Agency, Region 5, 77 West Jackson Boulevard, Chicago, Illinois 60604, (312) 886–6031, *Hatten.Charles@epa.gov.*

SUPPLEMENTARY INFORMATION: In the Final Rules section of this **Federal Register**, EPA is approving the State's SIP submittal as a direct final rule without prior proposal because the Agency views this as a noncontroversial submittal and anticipates no adverse comments. A detailed rationale for the approval is set forth in the direct final rule. If no adverse comments are received in response to this rule, no further activity is contemplated. If EPA receives adverse comments, the direct final rule will be withdrawn and all public comments received will be addressed in a subsequent final rule based on this proposed rule. EPA will not institute a second comment period. Any parties interested in commenting on this action should do so at this time. Please note that if EPA receives adverse comment on an amendment, paragraph, or section of this rule and if that provision may be severed from the remainder of the rule, EPA may adopt as final those provisions of the rule that are not the subject of an adverse comment. For additional information, see the direct final rule which is located in the Rules section of this **Federal Register**.

Dated: July 11, 2007.

Bharat Mathur,

Acting Regional Administrator, Region 5.

[FR Doc. E7–14477 Filed 7–27–07; 8:45 am]

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ENVIRONMENTAL PROTECTION AGENCY

40 CFR Parts 52 and 97

[EPA–R06–OAR–2007–0252; FRL–8446–2]

Approval and Promulgation of Implementation Plans; Texas; Clean Air Interstate Rule Nitrogen Oxides Annual Trading Program

AGENCY: Environmental Protection Agency (EPA).

ACTION: Proposed rule.

SUMMARY: EPA is proposing to approve a revision to the Texas State Implementation Plan (SIP) submitted by the State of Texas on August 4, 2006, as the Texas Clean Air Interstate Rule (CAIR) Nitrogen Oxides (NO_X) Annual Abbreviated SIP. The abbreviated SIP revision EPA is proposing to approve includes the Texas methodologies for allocation of annual NO_X allowances for Phase 1 of CAIR, the control periods 2009 through 2014, and for allocating allowances from the compliance supplement pool (CSP) in the CAIR NO_X annual trading program. EPA is proposing to determine that the Texas CAIR NO_X Annual Abbreviated SIP revision satisfies the applicable requirements of a CAIR abbreviated SIP revision. Upon the effective date of approval of the Texas CAIR NO_X Annual Abbreviated SIP revision, EPA by ministerial action will note in the Texas CAIR NO_X Annual Federal Implementation Plan's (FIP) incorporated regulations that the Texas rules for annual NO_X allowances under Phase 1 of CAIR and allocating