

January 13, 2010

The Honorable David J. Kappos  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Comments on Procedure for Treating Rejected Claims  
That Are Not Being Appealed  
74 Federal Register 66097 (December 14, 2009)

Dear Under Secretary Kappos:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments in response to the Notice of the U.S. Patent and Trademark Office (PTO) regarding Procedures for Treating Rejected Claims That Are Not Being Appealed.

AIPLA is a national bar association whose more than 16,000 members are primarily lawyers and other patent practitioners in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

## INTRODUCTION

The PTO is considering changes to its practice for handling notices of appeal and appeal briefs that identify fewer than all of the rejected claims as being appealed. It has proposed to adopt the following practice: where an appellant limits the appeal to fewer than all the rejected

claims in a notice of appeal or an appeal brief, the non-appealed rejected claims would be deemed canceled by operation of this action on the part of appellant as of the date on which such a notice of appeal or appeal brief is filed. The practice, if adopted, would apply to notices of appeal and appeal briefs filed by patent applicants, as well as notices of appeal or cross appeal and appeal briefs filed by patent owners in ex parte and inter partes reexamination proceedings.

### CURRENT PRACTICE

As we understand it, the current practice is not much different from the practice being proposed, except as to the time when claims would be deemed canceled in the application/reexamination proceeding; and whether a PTO official needs to affirmatively cancel those claims that have been withdrawn. It has long been the practice of the Patent Office to regard the withdrawal of appealed claims as an authorization to cancel the withdrawn claims. For example, MPEP § 1214.05, Cancellation of Withdrawn Claims (3<sup>rd</sup> Ed., November 1961), provided as follows:

When an appellant withdraws some of the appealed claims, and the Board reverses the Examiner on the remaining appealed claims, the withdrawal is treated as an authorization to cancel the withdrawn claims. It is not necessary to notify the applicant of the cancellation of the withdrawn claims.

Similarly, under MPEP § 1215.03 (8<sup>th</sup> Ed., Rev. 7, July 2008), a withdrawal of the appeal as to some of the claims operates as an authorization to cancel those claims from the appealed application or reexamination proceeding. The examiner should notify the appellant of the cancellation. As noted in the Board decision cited in the Notice, *Ex Parte Ghuman*, 88 USPQ2d 1478 (Bd. Pat. App. & Int. 2008), rejected claims that are not addressed in the appeal brief are considered withdrawn from the appeal. In the *Ghuman* case, the Board remanded the application to the examiner to enter a paper canceling the claims withdrawn from appeal.

The Notice also points out that it has long been the practice that an appellant must either appeal from the rejection of all rejected claims or cancel those claims not being appealed. *Ex Parte Benjamin*, 1903 Dec. Comm. Pat. 132, 134 (1903). More recently, in *Ex Parte Letts* (cited

in the *Ghuman* decision), the Board held that “[i]f an Appellant wants an appeal withdrawn or dismissed as to a particular claim, the proper course of action is to file an amendment canceling the claim.” [emphasis supplied] The Notice incorrectly suggests that withdrawal of the appeal “operates as a cancellation of those claims from the application.” In fact, current practice appears to only authorize cancellation of those claims and requires some action to be taken by a PTO official to actually cancel those claims. MPEP § 1215.03.

### CONCERNS RAISED BY THE PROPOSAL

Among the principal concerns raised by the proposal was the fact that it is not always clear whether an appellant is withdrawing claims from an appeal, and claims would be canceled by the PTO before an appellant had an opportunity to clarify the matter and correct an inadvertent error, particularly in cases where that error would result in the cancellation of a patent claim in a reexamination proceeding. The Notice does not address whether the proposed cancellation would be without prejudice, but even assuming it was, the cancellation could have the effect of being with prejudice in a reexamination proceeding if the patent owner does not have an opportunity to reintroduce a patent claim that was deemed canceled because of some inadvertent defect in the notice of appeal or appeal brief. If the PTO ultimately adopts its proposed practice, it should be made clear that the cancellation is without prejudice.

There are obviously many inconsistencies that can arise from the relevant materials on appeal (the rejection from which the appeal was taken, the notice of appeal, and the content of the appeal brief) that would make appellant’s intention unclear. Rather than assuming that claims should be canceled when there is a failure to satisfy all requirements for a proper notice of appeal and appeal brief in a consistent manner, it would be a better practice to permit the appellant to clarify his or her intent and require adherence to the proper procedure before consideration is given to canceling claims. As noted in the *Letts* Board decision, if an appellant fails to properly appeal rejected claims, the proper course of action is to file an amendment canceling the claim.

While we would expect that this issue rarely arises, it is not difficult to imagine situations where the file record itself creates some ambiguity as to whether an appeal has been withdrawn.

For example, consider a situation where seven claims are finally rejected, the notice of appeal identifies only five claims, but the appeal brief properly addresses the rejection of all seven claims. The proposed practice apparently would cancel two claims because seven claims were not identified in the notice, but it cannot seriously be suggested that there was an intention to withdraw the appeal as to the two claims not mentioned in the notice.

Consider another example: ten claims are finally rejected, no claims are mentioned in the notice, the appeal brief contains a specific argument as to the rejection of only seven claims, but the claims appendix lists the ten claims finally rejected and the three claims omitted are dependent on a rejected independent claim that is properly addressed in the brief. As we understand the proposed practice, the three claims not addressed in the brief would be canceled because no argument is specifically addressed to those claims under a separate heading listing those claims, even though the claims appendix clearly appears to suggest they are “involved in the appeal.” See 37 C.F.R. § 41.37(b)(1)(viii). If no separate argument was presented for those dependent claims, the Board would properly consider that patentability of those claims would rise or fall with the determination of patentability of the independent claim from which they depend. Again, cancellation is the wrong result under circumstances such as these.

Some have raised a concern that examiners may improperly interpret the proposed practice and cancel claims that were argued in a group, but not specifically addressed. We understand that this would be mistaken and could be corrected, but it is often more difficult for both practitioners and examiners to correct a mistake than to get it right the first time.

We also think it is important that examiners understand the difference between unappealed claims that stand rejected after examination and unappealed claims that have been withdrawn from consideration as a result, for example, of a restriction requirement. It would be wholly objectionable to subject claims in the latter category to cancellation.

We think it is inappropriate and wasteful to focus too much attention on the content of the notice of appeal. As noted in MPEP § 1204, a notice of appeal in accordance with 37 C.F.R. § 41.31 need not identify the rejected claim(s) appealed. Accordingly, even in the situation

where the notice of appeal lists specific claims but does not list all rejected claims, the appeal should not be regarded as withdrawn as to the rejected claims not listed unless there is also an amendment filed to cancel those rejected claims.

The focus of attention should be directed to the content of the appeal brief, and there should be a presumption that the appellant intended to appeal all claims under rejection unless the “proper” course of action has been followed by filing an amendment canceling rejected claims. If such an amendment has not been filed and the rejected claims are not properly addressed in the appeal brief, the appellant should be sent a notice of a non-compliant appeal brief and given an opportunity either to present a brief that properly addresses all rejected claims or to file an amendment limited to the cancellation of claims for which the appeal is intended to be withdrawn. This general practice is already in place for briefs that do not comply with other requirements of the practice and regulations. See 37 C.F.R. § 41.37(d); MPEP § 1205.03.

The present requirements for an appeal brief should prevent the type of error addressed in this Notice from happening in the overwhelming majority of cases. An appellant is required to: list all claims in the proceeding and their status (37 C.F.R. § 41.37(c)(iii)); present a concise statement of each ground of rejection presented for review (37 C.F.R. § 41.37(c)(vi)); present an argument directed to each ground of rejection presented for review under a separate heading listing the claims by number (37 C.F.R. § 41.37(c)(vii)); and present a claims appendix containing a copy of the claims involved in the appeal (37 C.F.R. § 41.37(c)(viii)). Each one of these requirements presents an opportunity to confirm which claims are on appeal. We note also that the proposed appeal rules recently published by the PTO (74 Fed. Reg. 67987 (December 22, 2009)) would also require that the claims appendix include the status of each claim pending in the appealed proceeding which should provide an additional protection against an inadvertent error.

## RECOMMENDATION

AIPLA suggests the PTO adopt the practice of obtaining clarification from the appellant where appellant has not taken the proper step to withdraw a rejected claim from appeal. There

should be a presumption that rejected claims have been appealed unless appellant has followed the proper course of action of canceling those claims. Where an appellant has not followed the proper course of action, a notice of noncompliance should be sent, no earlier than after the appeal brief is filed, requiring a compliant appeal brief (addressing all rejected claims) or an amendment canceling rejected claims not on appeal.

We appreciate the opportunity to provide these comments in response to the Notice, and would be pleased to answer any questions that our comments may raise.

Sincerely

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", with a long horizontal flourish extending to the right.

Q. Todd Dickinson  
Executive Director  
AIPLA