

Rules of Practice Before the BPAI in Ex Parte Appeals

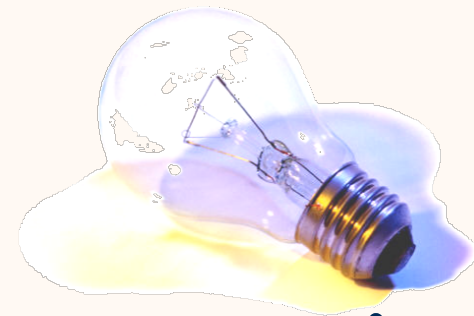
73 Fed. Reg. 32938 (June 10, 2008)
Effective December 10, 2008



Rules of Practice Before the BPAI in Ex Parte Appeals

Objectives of the Rules Changes:

- Streamline the appeal process by exchanging information and crystallizing the issues in dispute earlier in the process;
- Ensure briefing is focused on distilling the issues in dispute and where the Examiner erred in the rejections; and
- Reduce the number of administrative returns to the examining corps.



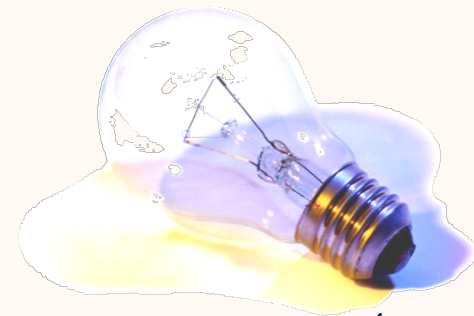
Rules of Practice Before the BPAI in Ex Parte Appeals

- Improvements to *Ex Parte* Appeal Practice:
 - ◆ The notice of appeal must be signed.
 - ◆ Petitions for extensions of time to file reply brief, oral hearing, or request for rehearing are decided by the Board.
 - ◆ Petitions to exceed page limit for appeal brief, reply brief, or request for rehearing are decided by the Board.
 - ◆ Evidence submitted under § 41.33(d) may now be admitted if the evidence overcomes at least one rejection and the evidence does not necessitate any new ground of rejection and appellant shows good cause as to why it was not submitted earlier.



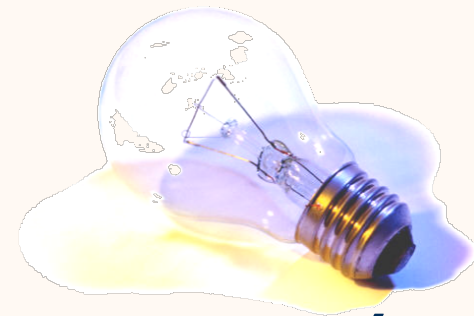
Rules of Practice Before the BPAI in Ex Parte Appeals

- Improvements to *Ex Parte* Appeal Practice (cont'd):
 - ◆ Appeal brief requires a statement of facts.
 - ◆ Appeal brief requirement that the appellant explain the error in the examiner's finding or conclusion makes clear the standard of review by the Board is not a *de novo* review, but a review of examiner's error.
 - ◆ Page limits for appeal briefs, reply briefs, and requests for rehearing have been added.



Rules of Practice Before the BPAI in Ex Parte Appeals

- Improvements to *Ex Parte* Appeal Practice (cont'd):
 - ◆ The “Summary of the Claimed Invention” section of the brief has been removed.
 - ◆ No new grounds of rejection will be made in the examiner’s answer.
 - ◆ The provisions for examiner’s response to reply brief have been removed. Accordingly, there will be no supplemental examiner’s answers.

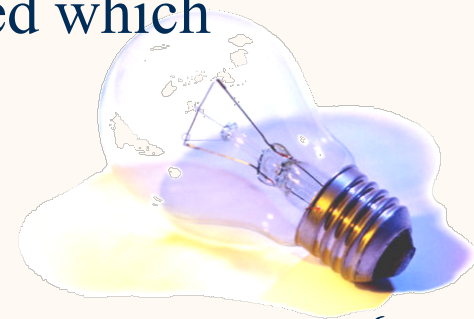


Rules of Practice Before the BPAI in Ex Parte Appeals

Jurisdiction Over Appeal – 37 CFR 41.35

- The jurisdiction of the Board begins when a docket notice is mailed by the Board. *See* § 41.35(a).
- The jurisdiction of the Board ends when:
 - ◆ The Board mails a remand order;
 - ◆ The Board mails a final decision and judicial review is sought or the time for seeking judicial review has expired;
 - ◆ An express abandonment is filed which complies with § 1.138 of this title; or
 - ◆ A request for continued examination is filed which complies with § 1.114 of this title.

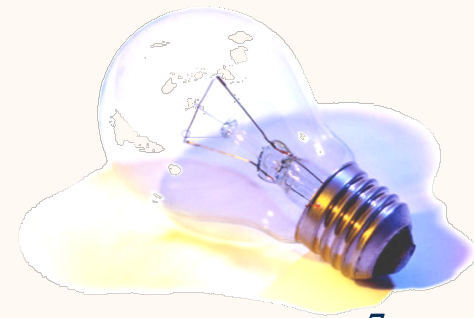
See § 41.35(b)



Rules of Practice Before the BPAI in Ex Parte Appeals

Jurisdiction Over Appeal – 37 CFR 41.35 (cont'd)

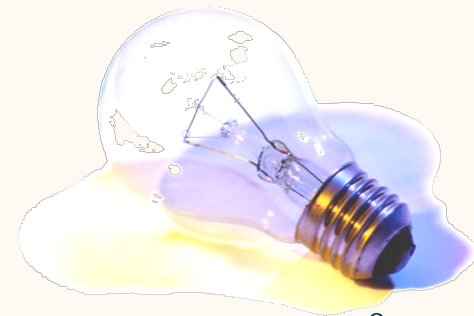
- Appellant should immediately notify the Board if appellant has filed an express abandonment or RCE.
- The appeal rules have not changed the present practice of providing the Director the authority to *sua sponte* order an application or reexamination proceeding on appeal to be remanded before the entry of a Board decision. *See* § 41.35(c).



Rules of Practice Before the BPAI in Ex Parte Appeals

Notice of appeal – 37 CFR 41.31

- The notice of appeal must be signed in accordance with § 1.33(b).
- The fee required by § 41.20(b)(1) must accompany the notice of appeal.
- The following language would be acceptable in providing notice of intent to appeal:
 - ◆ “An appeal is taken from the decision of the examiner dated {Specify date appealed rejection is mailed}.”



Rules of Practice Before the BPAI in Ex Parte Appeals

Notice of appeal – 37 CFR 41.31 (cont'd)

- ◆ The time period for filing the notice of appeal continues to be within the time period set forth in § 1.134.
See § 41.31(c).
- ◆ Appellants may continue to extend the time period for filing a notice of appeal under the provisions of:
 - 37 CFR 1.136(a) for applications, and
 - 37 CFR 1.550(c) for reexamination proceedings.
- ◆ 35 USC 134 provides authority for the right of appeal.

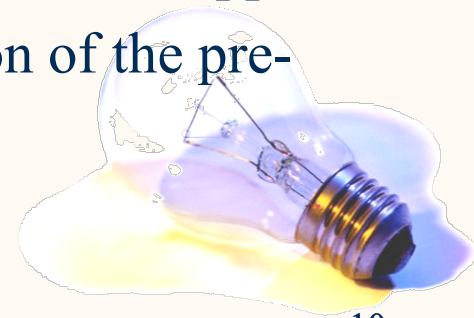


Rules of Practice before the BPAI in Ex Parte Appeals

Appeal Brief – 37 CFR 41.37(a)-(d)

■ Timeliness Requirement

- ◆ Appellant must file an appeal brief within two months of the date of the filing of the notice of appeal. *See* § 41.37(c)
- ◆ If appellant files a request for pre-appeal brief conference in compliance with the OG notice (*New Pre-Appeal Brief Conference Pilot Program*, 1296 *Off. Gaz. Pat. Office* 67 (July 12, 2005)), the appeal brief must be filed the later of:
 - Two months from the date of the filing of the notice of appeal; or
 - One month from the mailing date of the decision of the pre-appeal brief conference.



Rules of Practice before the BPAI in Ex Parte Appeals

Appeal Brief – 37 CFR 41.37(a)-(d)

- Timeliness Requirement (cont'd)
 - ◆ The time period for filing an appeal brief is extendable under the provisions of:
 - 37 CFR 1.136(a) for applications; and
 - 37 CFR 1.550(c) for reexamination proceedings. *See* §41.37(d)
 - ◆ Upon failure to file an appeal brief, the proceedings on the appeal are **terminated** without further action by the Office.
- Fee Requirement
 - ◆ The appeal brief shall be accompanied by the fee required by §41.20(b)(2). *See* §41.37(b)



Rules of Practice before the BPAI in Ex Parte Appeals

Contents of Appeal Brief – 37 CFR 41.37(e)

- The appeal brief must contain, under appropriate headings and in the order indicated, the following items:
 - ◆ Statement of the real party in interest;
 - ◆ Statement of related cases;
 - ◆ Jurisdictional statement;
 - ◆ Table of contents;
 - ◆ Table of authorities;
 - ◆ Status of amendments;
 - ◆ Grounds of rejection to be reviewed;

See 37 CFR 41.37(f)-(j), (l) and (m)



Rules of Practice before the BPAI in Ex Parte Appeals

Contents of Appeal Brief – 37 CFR 41.37(e) (cont'd)

- ◆ Statement of facts;
- ◆ Argument; and
- ◆ An appendix containing:
 - a claims section,
 - a claim support and drawing analysis section,
 - a means or step plus function analysis section,
 - an evidence section, and
 - a related cases section.

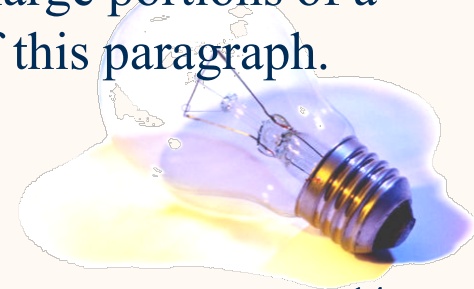
See 37 CFR 41.37(n)-(p) and (r)-(u)



Rules of Practice before the BPAI in Ex Parte Appeals

Contents of Appeal Brief (cont'd)

- Statement of facts – 37 CFR 41.37(n)
 - ◆ 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 of a document in the Record and, where applicable, a specific line or paragraph, and drawing numerals.
 - 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.



Rules of Practice before the BPAI in Ex Parte Appeals

Contents of Appeal Brief (cont'd)

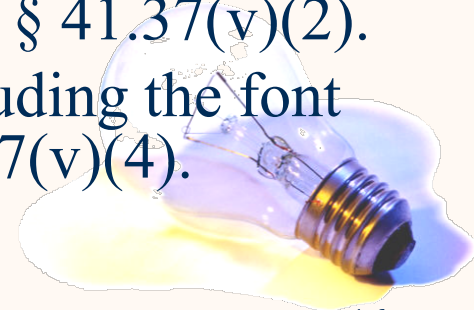
- Argument – 37 CFR 41.37(o)
 - ◆ The “argument” section shall explain why the examiner erred as to each ground of rejection to be reviewed.
 - Any explanation must address all points made by the examiner with which the appellant disagrees.
 - Any finding made or conclusion reached by the examiner that is not challenged will be presumed to be correct.
 - For each argument an explanation 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.
 - Each ground of rejection shall be separately argued under a separate heading.



Rules of Practice before the BPAI in Ex Parte Appeals

Appeal Brief Format Requirements – 37 CFR 41.37(v)

- An appeal brief shall comply with § 1.52 and the following additional requirements:
 - ◆ **Page numbering** - the pages of the appeal brief, including all sections in the appendix, shall be consecutively numbered using Arabic numerals beginning with the first page of the appeal brief, which shall be numbered page 1.
See § 41.37(v)(1).
 - ◆ **Spacing** - double spacing shall be used except in headings, tables of contents, tables of authorities, signature blocks, and certificates of service. Block quotations must be indented and can be one and one half or double spaced. *See § 41.37(v)(2).*
 - ◆ **Font size** - the font size shall be 14 point, including the font for block quotations and footnotes. *See § 41.37(v)(4).*



Rules of Practice before the BPAI in Ex Parte Appeals

Appeal Brief Format Requirements – 37 CFR 41.37(v)

- An appeal brief shall comply with § 1.52 and the following additional requirements (cont'd):
 - ♦ **Length of Appeal Brief** - an appeal brief may not exceed **30 pages**, excluding:
 - any statement of the real party in interest,
 - statement of related cases,
 - jurisdictional statement,
 - table of contents,
 - table of authorities,
 - status of amendments,
 - signature block, and
 - appendix.
 - An appeal brief may not incorporate another paper by reference.



Rules of Practice Before the BPAI in Ex Parte Appeals

Examiner's answer – 37 CFR 41.39

- 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. *See* § 41.39(a).
 - ◆ The MPEP will set out the requirements of the examiner answer.
- An examiner's answer shall not include a new ground of rejection under § 41.39(b).
 - ◆ If the examiner wants to make a new ground of rejection, the examiner will reopen prosecution of the application.



Rules of Practice Before the BPAI in Ex Parte Appeals

Manual of Patent Examining Procedure (MPEP) Revision

- Defective Brief Determination
 - Decided by Appeal Center
 - Checklist for Briefs
 - Appeal Conferee Must Approve Examiner's Notification of Defective Brief

- Examiner's Answer
 - Content
 - Page Limitation

- Examiner Prohibitions
 - Do Not Enter New Grounds of Rejection
 - Do Not enter Supplemental Answer
 - Do Not Hold Brief Defective unless concurrence by Appeal Conferee



Rules of Practice Before the BPAI in Ex Parte Appeals

Examiner prohibitions will shorten appeal process

- No New Grounds of Rejection
- No Supplemental Answers

Time for Appeal

- Present Appeal Rules
 - Minimum: 14
months
 - Maximum: 20
months

- New Appeal Rules
 - Minimum: 8.5
months
 - Maximum: 14.5
months



Rules of Practice Before the BPAI in Ex Parte Appeals

■ Manual of Patent Examining Procedure (MPEP) Revision

Examiner's Answer Content

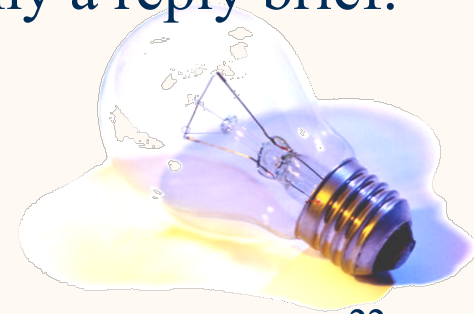
- Status of Amendments and Claims
- Status of Evidence Filed After Final Rejection
- Grounds of Rejection to be Reviewed on Appeal
- Statement of Additional Facts
- Response to Arguments



Rules of Practice Before the BPAI in Ex Parte Appeals

Reply brief – 37 CFR 41.41

- An appellant may file a single reply brief responding to the points made in the examiner's answer. *See* § 41.41(a).
- 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. *See* § 41.41(b).
- A request for an extension of time to file a reply brief shall be presented as a petition under § 41.3. *See* § 41.41(c).
- No amendment or new evidence may accompany a reply brief. *See* § 41.41(i).

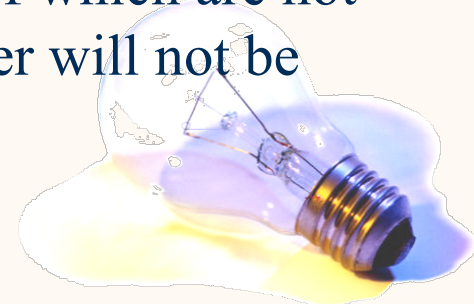


Rules of Practice Before the BPAI in Ex Parte Appeals

Reply brief – 37 CFR 41.41 (cont'd)

- A reply brief must contain, under appropriate headings and in the order indicated, the following items:
 - ◆ Table of contents;
 - ◆ Table of authorities; and
 - ◆ Statement of additional facts – a statement of 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;
 - ◆ Argument - any arguments raised in the reply brief which are not responsive to points made in the examiner's answer will not be considered and will be treated as waived.

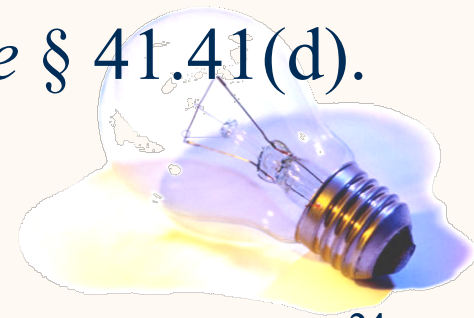
See § 41.41(d)-(g).



Rules of Practice Before the BPAI in Ex Parte Appeals

Reply brief – 37 CFR 41.41 (cont'd)

- A reply brief may not exceed 20 pages, excluding:
 - any table of contents,
 - table of authorities, and
 - signature block.
- ◆ A request to exceed the page limit shall be made by petition under § 41.3 and filed at least ten calendar days before the reply brief is due. *See* § 41.41(d).



Rules of Practice Before the BPAI in Ex Parte Appeals

Examiner's response to reply brief has been removed – 37 CFR 41.43

- The examiner will not review the reply brief or acknowledge receipt and entry of the reply brief.
- The examiner will not be furnishing a supplemental examiner's answer.
- The removal of the examiner's response to the reply brief will shorten the appeal period.



Rules of Practice Before the BPAI in Ex Parte Appeals

Oral hearing – 37 CFR 41.47

- If appellant desires an oral hearing, appellant must file, as a separate paper, a written request. *See* § 41.47(a).
 - ◆ The request must be captioned “REQUEST FOR ORAL HEARING” and must be accompanied by the fee required by § 41.20(b)(3).
 - ◆ Appellant must file the request within two months from the date of the examiner’s answer. *See* § 41.47(c).
 - ◆ A request for an extension of time shall be presented as a petition under § 41.3. *See* § 41.47(d).
 - Such petitions will be granted only upon a showing of good cause. *See* § 41.4(a)



Rules of Practice Before the BPAI in Ex Parte Appeals

Oral hearing – 37 CFR 41.47 (cont'd)

- 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. See § 41.47(f).



Rules of Practice Before the BPAI in Ex Parte Appeals

Rehearing – 37 CFR 41.52

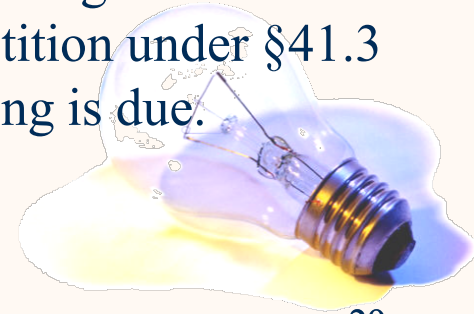
- Appellant may file a single request for rehearing.
See § 41.52(a)
- Any request for rehearing must be filed within two months from the date of the decision mailed by the Board. *See* § 41.52(b)
- A request for an extension of time shall be presented as a petition under § 41.3. *See* § 41.52(c)
 - ◆ A showing of good cause is required under § 41.4(a).



Rules of Practice Before the BPAI in Ex Parte Appeals

Rehearing – 37 CFR 41.52 (cont'd)

- Content requirements – 37 CFR 41.52(d)
 - ◆ A request for rehearing must contain, under appropriate headings and in the order indicated, the following items:
 - Table of contents;
 - Table of authorities;
 - Argument. *See* § 41.52(f).
- Format requirements – 37 CFR 41.52(d)
 - ◆ The form of a request for rehearing is governed by the requirements of §41.37(v), except that a request for rehearing may not exceed 10 pages, excluding any table of contents, table of authorities, 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.



Rules of Practice Before the BPAI in Ex Parte Appeals

Decisions and other actions by the Board - 37 CFR 41.50

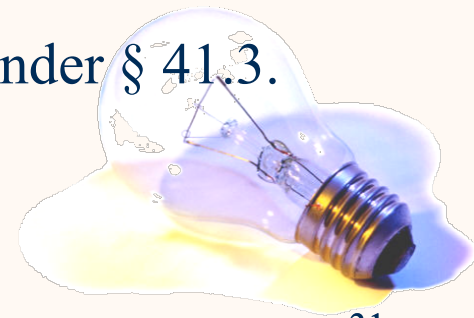
- The Board may affirm or reverse an examiner's rejection in whole or in part. *See* § 41.50(a).
- The Board may remand an application to examiner. *See* § 41.50(b).
- If the Board remands the appeal for further consideration of a rejection, then appellant shall elect one of the two options within two months to avoid abandonment of the application or termination of the reexamination proceeding:
 - Request to reopen prosecution, or
 - Request to re-docket the appeal.*See* §§ 41.50(b)(1) and (2).



Rules of Practice Before the BPAI in Ex Parte Appeals

Decisions and other actions by the Board

- A new ground of rejection by the Board – 37 CFR 41.50(d) (cont'd)
 - ◆ If the Board enters a new ground of rejection, within two months appellant must exercise one of the following two options with respect to the new ground of rejection to avoid dismissal of the appeal as to any claim subject to the new ground of rejection:
 - Request to reopen prosecution *See* § 41.50(d)(1)
 - Request for rehearing *See* § 41.50(d)(2)
 - ◆ The two-month time period may be extendable under § 41.3.



Rules of Practice Before the BPAI in Ex Parte Appeals

Petitions under 37 CFR 41.3 are decided by the Chief Administrative Patent Judge or his designee.

- **Petitions to exceed page limits:**

- ◆ 30-page limit for appeal briefs;
- ◆ 20–page limit for reply briefs; and
- ◆ 10-page limit for requests for rehearing.

See §§ 41.37(v)(5), 41.41(d), and 41.52(d).

- ◆ Petitions to exceed the page limit must be filed at least **ten** calendar days prior to the date the appeal brief, reply brief, or request for rehearing is due.



Rules of Practice Before the BPAI in Ex Parte Appeals

Petitions under 37 CFR 41.3 (cont'd)

- **Petitions for extensions of time to file:**
 - ◆ A reply brief;
 - ◆ A request oral hearing;
 - ◆ A reply or reply brief after an examiner's answer that is written in response to remand for further consideration of a rejection;
 - ◆ A reply or request for rehearing after a new ground of rejection by the Board; or
 - ◆ A request for rehearing.

- Petitions for extensions of time under § 41.3 must be filed prior to the due date of the paper and are subject to the good cause requirement of § 41.4(a).



Rules of Practice Before the BPAI in Ex Parte Appeals

Non-Appealable Issues – 37 CFR 41.31(e)

- If appellant is dissatisfied with a decision by an examiner on a non-appealable issue, appellant must timely seek review by petition before jurisdiction over an appeal is transferred to the Board.
- Failure to timely file a petition may constitute a waiver to having that issue considered.
- Examples of non-appealable issues:
 - ◆ Refusal to enter a response to a final rejection.
 - ◆ Refusal to enter evidence presented after a final rejection.
 - ◆ Refusal to withdraw a restriction requirement.





Thank You

