

## **Outline of Ex Parte Appeal Procedure Under the Proposed Rules**

The following procedural rules have been proposed and published in the Federal Register. The PTO is soliciting public comment although, at the same time, making it clear that because the proposed changes involve interpretive rules or rules of agency practice and procedure, prior notice and an opportunity for public comment are not required.

1. The proposed rules provide additional delegated authority from the Director to the Chief APJ 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. The proposed rules define the record on appeal to clarify what documents the Board will consider in resolving the appeal. The record on appeal will consist of:
  - a. The specification,
  - b. Drawings (if any),
  - c. U.S. patents cited by the examiner or appellant,
  - d. Published U.S. applications cited by the examiner or appellant,
  - e. The appeal brief including all appendices,
  - f. The examiner's answer,
  - g. Any reply brief, including any supplemental appendix,
  - h. Any supplemental reply brief,
  - i. Any request for rehearing,
  - j. Any order or decision entered by the Board or the Chief APJ, and
  - k. Any other document or evidence which was considered by the Board as indicated in any opinion accompanying any order or decision.
3. The proposed rules add a requirement that the notice of appeal be signed.
4. The proposed rules provide a clear definition of non-appealable issues. Non-appealable issues are issues:
  - a. Over which the Board does not exercise authority in appeal proceedings, and
  - b. Which are handled by a petition.

Non-appealable issues include and examiner's refusal to:

1. enter a response to a final rejection,
  2. enter evidence presented after final rejection,
  3. enter an appeal brief or a reply brief, or
  4. withdraw a restriction requirement.
5. The proposed rules transfer jurisdiction of an appeal to the Board upon entry of a docket notice by the Board. Jurisdiction should transfer to the Board only after:
- a. The appellant has filed an appeal brief,
  - b. The examiner has entered an answer, and
  - c. The appellant has filed a reply brief or the time for filing a reply brief has expired.
6. The proposed rules provide for amendments and evidence filed after the appeal:
- a. Amendments filed after the date a notice of appeal is filed and before an appeal brief is filed may be admitted:
    - i. If the examiner determines that the evidence overcomes some or all rejections under appeal, AND
    - ii. Appellant shows good cause why the evidence was not earlier presented.
  - b. The examiner has discretion to permit entry of an amendment filed with or after an appeal brief in two circumstances:
    - i. If an amendment cancels claims provided that such cancellation does not affect the scope of any other pending claim in the proceedings, or
    - ii. If an amendment rewrites dependent claims into independent form.
  - c. All other amendments filed after the date the appeal brief is filed will not be admitted except in the following situations:
    - i. In the context of a request to reopen prosecution after a new rejection in an examiner's answer,
    - ii. In the context of a request to reopen prosecution after entry of a supplemental examiner's answer following a remand by the Board,
    - iii. In the context of a request to reopen prosecution after entry of a new rejection by the Board, and

- iv. In the context of making an amendment after recommendation by the Board.
- 7. The proposed rules clarify that the Board's jurisdiction in an appeal is relinquished when the Board:
  - a. orders a remand,
  - b. enters a final decision and judicial review is timely sought, or
  - c. enters a final decision and the time for seeking judicial review expires.

When a party requests rehearing, a decision of the Board becomes final when the Board decides the request for rehearing.

- 8. The proposed rules change the format and content of the appeal brief to require the following additional sections:
  - a. Jurisdictional statement, including
    - i. The statute under which the appeal is taken,
    - ii. The date of the decision from which the appeal is taken,
    - iii. The date the notice of appeal was filed, and
    - iv. 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 the date the extension of time was requested and the date the request was granted.

- b. Table of contents,
  - c. Table of authorities listing:
    - i. Court and administrative decisions (alphabetically arranged),
    - ii. Statutes, and
    - iii. Other authorities along with a reference to the pages of the appeal brief where each authority is cited, and
  - d. Statement of facts setting out in an objective and non-argumentative manner the material facts relevant to the rejections on appeal.
    - i. Each fact must be supported by a reference to the page number of the record on appeal.

- ii. Where appropriate, the citation should also be to a specific line and to a drawing figure and element number of the record on appeal.
  - e. Appeal brief is not to exceed 25 pages, excluding any:
    - i. Statement of the real party in interest,
    - ii. Statement of related cases,
    - iii. Table of contents,
    - iv. Table of authorities,
    - v. Signature block, and
    - vi. Appendix.
- 9. The proposed rules also require that the appellant expressly address the statutory requirements of patentability in the argument section.
  - a. For each rejection under 112, first paragraph, the argument shall specify the errors in the rejection and how the rejected claims comply with 112, first paragraph, including how the specification and drawings, if any,:
    - i. Describe the subject matter defined by the rejected claim,
    - ii. Enable any person skilled in the art to which the invention pertains to make and use the subject matter of the rejected claims, and
    - iii. Set forth the best mode contemplated by the inventor of carrying out the claimed invention.
  - b. For each rejection under 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.
  - c. For each rejection under 102, 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 rejections and why the rejected claims are patentable.
  - d. For each rejection under 103, the argument shall:
    - i. Specify the errors in the rejection,
    - ii. 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

- iii. Explain how those limitations render the claimed subject matter unobvious over the prior art.
10. The proposed rules change the format and content of the appeal brief appendix to include the following additional sections:
  - a. Claim support section for each claim argued separately including 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,
  - b. Drawing analysis section for each claim argued separately including 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,
  - c. Means or step plus function analysis section for each claim argued separately that contains a limitation that appellant regards as a means or step plus function limitation including a copy of the claim 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, and
  - d. An expanded evidence section which includes:
    - i. Table of contents,
    - ii. The office action setting out the rejection on appeal (including any office action that may be incorporated by reference,
    - iii. All evidence (except the specification, any drawings, U.S. patents and published applications) upon which the examiner relied in support of the rejection on appeal,
    - iv. 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,
    - v. Affidavits or declarations upon which the appellant relied before the examiner, and
    - vi. Other evidence upon which the appellants relied before the examiner.
11. The proposed rules provide page limits for all briefs.
12. The proposed rules prohibit incorporation by reference in briefs.
13. The proposed rules provide for the examiner to enter an examiner's answer responding to the appeal brief if the examiner determines that the appeal should go

forward. The examiner's answer may include a new rejection. If the examiner's answer contains a new rejection, appellant has two months to exercise one of two options:

- a. Request that prosecution be reopened before the examiner by filing a reply with or without amendment or submission of evidence. Any amendment or evidence is limited to that which is relevant to the new rejection. Such request would be treated as a request to withdraw the appeal. Time for filing this request is extendable under the provisions of Rule 136(a).
- b. Request that the appeal be maintained by filing a reply brief. Such reply brief cannot 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 accompanied by evidence or other amendment would be treated as a request to reopen prosecution. A request to extend the time for filing a reply brief must be presented as a petition to which a strict "good cause" standard applies.

14. The proposed rules establish 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.

A reply brief shall be limited to responding to points made in the examiner's answer and shall not exceed 15 pages (unless the examiner's answer contains a new rejection, designated as such, then, the limit would be 25 pages) excluding any:

- i. Table of contents,
- ii. Table of authorities,
- iii. Statement of timeliness
- iv. Signature block, and
- v. Supplemental appendix.

15. The proposed rules provide for a supplemental reply brief, if a supplemental examiner's answer is furnished by the examiner.

16. The proposed rules set forth the format required for a supplemental reply brief which includes:
  - a. Table of contents,
  - b. Table of authorities,
  - c. Statement of timeliness, and
  - d. Argument.
17. The proposed rules provide for appellant to request oral hearing.
  - a. Must be filed as separate paper captioned: REQUEST FOR ORAL HEARING.
  - b. Request must be made within two months of the date of entry of the examiner's answer or a supplemental examiner's answer.
  - c. A request for an extension of time would have to be presented as a petition to which a strict "good cause" standard applies.
  - d. When the date for oral hearing is set, appellant is required to confirm attendance at oral hearing. Failure to do so will result in waiver of the request.
18. The proposed rules require the 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.
19. The proposed rules eliminate requests for extension of time to respond to a request for further briefing and information by the Board.
20. Upon remand from the Board, the proposed rules provide that if the examiner enters a supplemental examiner's answer in response to the remand, appellant is required, within two months, to exercise one of two options to avoid abandonment of the application or termination of the reexamination proceeding:
  - a. Appellant can 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 is limited to that which is relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. This request is treated as a request to dismiss the appeal.
  - b. Appellant can request that the appeal be redocketed. The request must be accompanied by a supplemental reply brief. No amendments or evidence can accompany the supplemental reply brief or the request will be treated as a request to reopen prosecution.

21. The proposed rules provide that if the Board has knowledge of a basis not involved in the appeal for rejecting a pending claim, the Board may enter a new rejection. If the Board enters a new rejection, Appellant must, within two months, exercise one of two options to avoid dismissal of the appeal as to any claim subject to the new rejection:
  - a. Appellant can 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. In the event the examiner maintains the rejection, appellant would be able to again appeal to the Board.
  - b. Appellant can request a rehearing. Such request has to be based on the record before the Board and no new evidence or amendments are permitted.
22. The proposed rules establish a format for a request for rehearing to include:
  - a. Table of contents,
  - b. Table of authorities,
  - c. Statement of timeliness, and
  - d. Argument.
23. The proposed rules 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. If the recommendation is explicitly designated as such, it is binding and if the Appellant files an amendment in conformity with the recommendation, it will be deemed to overcome the specific rejection. However, an examiner would still 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.
24. The proposed rules also 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. Appellant would be give a non-extendable time period within which to respond to the order.
25. The proposed rules authorize an appellant to file a single request for rehearing that would be due within two months from the date of the decision entered by the Board.
  - a. A request for an extension of time for filing a request for rehearing must be presented as a petition.
  - b. A request for rehearing shall state with particularity the points believed to have been misapprehended or overlooked by the Board.

- c. A request for rehearing shall not exceed 10 pages, excluding any table of contents, table of authorities, statement of timeliness and signature block.
  - d. A request for rehearing must contain the following items:
    - i. Table of contents,
    - ii. Table of authorities,
    - iii. Statement of timeliness, and
    - iv. Argument.
  - e. A new argument can be made in a request for rehearing only in two circumstances:
    - i. An appellant may respond to a new rejection by the Board, and
    - ii. An appellant may 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.
26. The proposed rules provide sanctions to be imposed, at the discretion of the board, on the appellant for misconduct during prosecution of the appeal.