

# Proposed Rules

Federal Register

Vol. 74, No. 244

Tuesday, December 22, 2009

This section of the FEDERAL REGISTER contains notices to the public of the proposed issuance of rules and regulations. The purpose of these notices is to give interested persons an opportunity to participate in the rule making prior to the adoption of the final rules.

## CONSUMER PRODUCT SAFETY COMMISSION

### 16 CFR Part 1422

RIN 3041-AC78

#### Standard for Recreational Off-Highway Vehicles

**AGENCY:** Consumer Product Safety Commission.

**ACTION:** Notice of extension of comment period.

**SUMMARY:** The Commission is extending its comment period to receive information regarding the advance notice of proposed rulemaking concerning Recreational Off-Highway Vehicles (ROVs). The Commission received two letters requesting an extension of the comment period, one from three manufacturers and distributors of Multi-Purpose Off-Highway Utility Vehicles, and the other from a trade association. The letters each requested that the comment period be extended 60 days from the date certain information was received by the companies or became publicly available. The Commission has decided to extend the comment period 75 days after the original comment period of December 28, 2009.

**DATES:** Written comments in response to this document must be received by the Commission no later than March 15, 2010.

**ADDRESSES:** You may submit comments, identified by Docket No. CPSC-2009-0087, by any of the following methods:

#### Electronic Submissions

Submit electronic comments in the following way:

Federal eRulemaking Portal: <http://www.regulations.gov>. Follow the instructions for submitting comments. To ensure timely processing of comments, the Commission is no longer accepting comments submitted by electronic mail (e-mail) except through <http://www.regulations.gov>.

#### Written Submissions

Submit written submissions in the following way:

Mail/Hand delivery/Courier (for paper (preferably in five copies), disk, or CD-ROM submissions), to: Office of the Secretary, Consumer Product Safety Commission, Room 502, 4330 East West Highway, Bethesda, MD 20814; telephone (301) 504-7923.

**Instructions:** All submissions received must include the agency name and docket number for this rulemaking. All comments received may be posted without change, including any personal identifiers, contact information, or other personal information provided, to <http://www.regulations.gov>. Do not submit confidential business information, trade secret information, or other sensitive or protected information electronically. Such information should be submitted in writing.

**Docket:** For access to the docket to read background comments or comments received, go to <http://www.regulations.gov>.

**FOR FURTHER INFORMATION CONTACT:** For information about submitting comments, call or write to Rockelle Hammond, Office of the Secretary, Consumer Product Safety Commission, Bethesda, MD 20814; telephone (301) 504-6833.

**SUPPLEMENTARY INFORMATION:** On October 28, 2009, the Commission published an ANPR in the **Federal Register** concerning ROVs. 74 FR 55495. The ANPR was issued under the authority of the Consumer Product Safety Act (CPSA). The ANPR provided for a 60-day comment period to end December 28, 2009. Three companies that manufacture and/or distribute Multi-Purpose Off-Highway Utility Vehicles (American Honda Motor Co., Inc., Deere & Company and Kawasaki Motors Corp., U.S.A.) and a trade association (Recreational Off-Highway Vehicle Association) have requested that the Commission extend the comment period 60 days after the companies receive certain information or that information becomes publicly available. A portion of this information was publicly released on November 20, 2009. The remainder, which was posted for a period of five days on the Commission's Web site in draft form, was finalized on December 15, 2009,

and is now publicly available.<sup>1</sup> Because this information was only recently released, the Commission has decided to extend the comment period to 75 days from the date of the original comment period deadline, or March 15, 2010.

Dated: December 17, 2009.

**Todd A. Stevenson,**

*Secretary, Consumer Product Safety Commission.*

[FR Doc. E9-30378 Filed 12-21-09; 8:45 am]

**BILLING CODE 6355-01-P**

## DEPARTMENT OF COMMERCE

### United States Patent and Trademark Office

#### 37 CFR Part 41

[Docket No.: PTO-P-2009-0021]

RIN 0651-AC37

#### Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Request for Comments on Potential Modifications to Final Rule and Notice of Roundtable During Comment Period

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Advance notice of proposed rule making; request for comments.

**SUMMARY:** The United States Patent and Trademark Office (USPTO or Office) is considering modifications to rules governing practice before the Board of Patent Appeals and Interferences (BPAI) in ex parte patent appeals. Previously submitted comments with regard to an earlier published final rule, particularly those submitted in response to a proposed collection of information, raised some public concerns which have been reconsidered by the Office. After further consideration of these concerns, the Office is issuing this notice seeking further public comment on possible revisions to portions of the final rule. In order to facilitate a full exchange of views, the United States Patent and Trademark Office is also conducting a public session and roundtable in connection with this request for comments. Following the public comment period, if the Office

<sup>1</sup> All of this information will become part of the public record.

determines further action is necessary, a subsequent notice of proposed rule making would be issued to solicit additional comments on specific proposals before any modified final rule would be issued.

**DATES:** The roundtable is scheduled to be held on January 20, 2010, beginning at 9:30 a.m. and ending at 12:30 p.m. In the event of inclement weather or other reason for cancellation or delay, the public is advised to check the USPTO, Board of Patent Appeals and Interferences Web site for the latest roundtable scheduling information (<http://www.uspto.gov/patents/process/appeal/>).

The deadline for receipt of requests to participate in the roundtable is 5 p.m. Eastern Standard Time on January 8, 2010.

The deadline for receipt of written comments on potential modifications to the final rule is 5 p.m. Eastern Standard Time on February 12, 2010.

Additionally, the USPTO will accept written comments on other matters discussed at the roundtable until 5 p.m. Eastern Standard Time on February 25, 2010.

Because the USPTO is now considering the final rule anew, and in light of potential modifications to the final rule, appeal briefs filed on or after January 21, 2010 must comply with the current rules in effect.

**ADDRESSES:** The roundtable will be held at the USPTO, in the Madison Auditorium on the concourse level of the Madison Building, which is located at 600 Dulany Street, Alexandria, Virginia.

Requests to participate at the roundtable are required and must be submitted by electronic mail message through the Internet to [linda.horner@uspto.gov](mailto:linda.horner@uspto.gov). Requests to participate at the roundtable should indicate the following information: (1) The name of the person desiring to participate and his or her contact information (telephone number and electronic mail address); and (2) the organization(s) he or she represents.

Written comments on potential modifications to the final rule should be sent by electronic mail message over the Internet addressed to

[BPAI.Rules@uspto.gov](mailto:BPAI.Rules@uspto.gov). Comments on potential modifications to the final rule may also be submitted by mail addressed to: Mail Stop Interference, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of "Linda Horner, BPAI Rules." Although comments may be submitted by mail, the USPTO prefers to receive comments via the Internet.

Written comments on general topics discussed at the roundtable should be sent by electronic mail message over the Internet addressed to [BPAI.Roundtable@uspto.gov](mailto:BPAI.Roundtable@uspto.gov). Comments on general topics discussed at the roundtable may also be submitted by mail addressed to: Mail Stop Interference, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of "Linda Horner, BPAI Gen. Topics." Although comments may be submitted by mail, the USPTO prefers to receive comments via the Internet.

The written comments and list of the roundtable participants and their associations will be available for public inspection at the Board of Patent Appeals and Interferences, located in Madison East, Ninth Floor, 600 Dulany Street, Alexandria, Virginia, and will be available via the USPTO Internet Web site (address: <http://www.uspto.gov/web/offices/dcom/bpai/>). Because comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

#### FOR FURTHER INFORMATION CONTACT:

Linda Horner, Administrative Patent Judge, Board of Patent Appeals and Interferences, by telephone at (571) 272-9797, or by mail addressed to: Mail Stop Interference, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Linda Horner.

#### SUPPLEMENTARY INFORMATION:

##### Background

The United States Patent and Trademark Office (USPTO or Office) published a notice of proposed rule making governing practice before the Board of Patent Appeals and Interferences (BPAI) in ex parte patent appeals (72 FR 41,472-41,490 (Jul. 30, 2007)). The notice was also published in the Official Gazette, 1321 Off. Gaz. Pat. Office 95 (Aug. 21, 2007). The public was invited to submit written comments. Comments were to be received on or before September 30, 2007.

A final rule making was then published in the **Federal Register** (73 FR 32937-32977 (Jun. 10, 2008)). The final rule that was published on June 10, 2008, may be viewed at <http://www.uspto.gov/web/offices/com/sol/notices/73fr32938.pdf>. The final rule stated that the effective date was December 10, 2008, and that the final rule would apply to all appeals in

which an appeal brief was filed on or after the effective date. On June 9, 2008, the Office published a 60-Day **Federal Register** notice requesting the Office of Management and Budget (OMB) to establish a new information collection for BPAI items in the final rule and requesting public comment on the burden impact of the final rule under the provisions of the Paperwork Reduction Act (PRA). On October 8, 2008, the Office published a 30-Day **Federal Register** notice stating that the proposal for the collection of information under the final rule was being submitted to OMB and requesting that comments on the proposed information collection be submitted to OMB. Because the information collection process had not been completed by the original effective and applicability date of the final rule, the Office published a **Federal Register** notice (73 FR 74972 (December 10, 2008)) notifying the public that the effective and applicability date of the final rule was not December 10, 2008, and that the effective and applicability dates would be identified in a subsequent notice.

Additionally, on January 20, 2009, the Assistant to the President and Chief of Staff instructed agencies via a memorandum entitled, "Regulatory Review," to consider seeking comments for an additional 30 days on rules that were published in the **Federal Register** and had not yet become effective by January 20, 2009. On January 21, 2009, the Office of Management and Budget issued a memorandum, "Implementation of Memorandum Concerning Regulatory Review," which provided agencies further guidance on such rules that had not yet taken effect. For such rules, both memorandums stated that agencies should consider reopening the rule making process to review any significant concerns involving law or policy that have been raised.

The USPTO is now considering further modifications to the rules of practice before the Board of Patent Appeals and Interferences in ex parte appeals and is conducting a roundtable and publishing this request for comments to solicit input from interested members of the public on potential modifications to the final rule. The Office seeks comment both on potential modifications to the final rule and issues of law and policy raised by the final rule.

The Office has further considered the comments thus far submitted and is considering changes to the final rule to significantly reduce any additional burden introduced by the final rule. The

continued delay of the effective and applicability dates and a new comment period are necessary to give the public additional time to comment on potential modifications to the final rule and to permit the Director to evaluate any additional comments to determine if the rules are consistent with administration policy.

On November 20, 2008 [73 FR 70282], the Office published a clarification notice on the effective date provision. See *Clarification of the Effective Date Provision in the Final Rule for Ex Parte Appeals*, 73 FR 70282 (November 20, 2008). The clarification notice states that the Office will not hold an appeal brief as non-compliant solely for following the new format set forth in the notice published on June 10, 2008, in the **Federal Register** (Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Final Rule, 73 FR 32938 (June 10, 2008), 1332 Off. Gaz. Pat. Office 47 (July 1, 2008)). Because the USPTO is now considering the final rule anew, and in light of the potential modifications to the final rule, for purposes of consistency, the Office will now no longer accept appeal briefs in the new format. Therefore, appeal briefs filed on or after 30 days from the publication of this notice must comply with the current 37 CFR 41.37. For clarity, this notice refers to three sets of Board Rules: (1) The “current board rules” published in 37 CFR 41.1 *et seq.* (2007); (2) the “final rule” published on June 10, 2008 [73 FR 32938], the effective date of which is delayed; and (3) potential modifications to the board rules published in this notice for the purpose of soliciting comments from the public. The current rules in effect are the current board rules as published in 37 CFR 41.1 *et seq.* (2007).

Furthermore, the Office has posted a list of questions and answers on the USPTO Web site (at [http://www.uspto.gov/web/offices/dcom/bpai/rule/faq\\_121008.html](http://www.uspto.gov/web/offices/dcom/bpai/rule/faq_121008.html)) regarding the implementation of the Board final rule. These questions and answers will be updated after the Office issues notice of the revised effective and applicability dates for the final rule. Previously submitted comments, particularly those submitted in response to the PRA notice [73 FR 32559], raised some public concerns which have been reconsidered by the Office. After further consideration of these concerns the Office is considering modifications to the final rule as follows below.

#### Public Participation

In addition to these considerations to modify the final rule, the Office is also seeking comment on those portions of

the final rule that are not being specifically considered for modification in this notice. After receiving comments from the public as a result of this notice, the Office would issue a notice of proposed rulemaking seeking additional feedback on proposed rule changes before any modifications to the final rule would take effect.

The date for the roundtable has been set to occur during the comment period so that participants will have time to familiarize themselves with modifications to the final rule that are under consideration in advance of the roundtable so as to provide meaningful input to the USPTO and so that those submitting written comments will have the benefit of the discussion from the roundtable and adequate time after the roundtable to prepare and submit written comments. The public session will also include a presentation by the USPTO of the challenges, including an increased appeal workload, facing the Board of Patents Appeals and Interferences. It will discuss the results it hopes to achieve from any potential modifications to the final rule and will solicit input from the roundtable participants on how, beyond the procedural changes that are under consideration, to meet these challenges.

The number of participants in the roundtable is limited to ensure that all who are speaking will have a meaningful chance to do so. The roundtable is open to the public, but participation in the roundtable is by request, as the number of participants in the roundtable is limited. The USPTO plans to invite a number of participants from patent user, practitioner, industry, and independent inventor organizations, academia, industry, and government. The USPTO also plans to have a few “at-large” participants based upon requests received in response to this notice to ensure that the USPTO is receiving a balanced array of views on the potential modifications to the final rule. The USPTO will attempt to provide selected participants with notice at least seven days prior to the roundtable. While members of the public who wish to participate in the roundtable must do so by request, members of the public who wish solely to observe need not submit a request. Any member of the public, however, may submit written comments on issues raised at the roundtable or on potential modifications to the final rule under consideration by the USPTO.

The USPTO plans to make the roundtable available via Web cast. Web cast information will be available on the USPTO’s Internet Web site before the roundtable. The written comments and

list of the roundtable participants and their associations will be posted on the USPTO’s Internet Web site.

This notice is not a publication of a final rule. After the public comment period, if the Office determines further action is necessary, a subsequent notice of proposed rule making will be issued to solicit additional comments on specific proposals before any modified final rule would be issued. The Office is publishing these possible modifications to the final rule for the purpose of soliciting comments from the public on these topics. The Office will also be accepting comments on other matters raised at the public session and roundtable.

#### Purpose for Potential Modifications to the Final Rule Under Consideration

The Office is considering modifications to the final rule in an effort to efficiently frame any dispute between the appellant and the examiner for the benefit of the Board and the appeal conferees to provide the best opportunity for resolution of the dispute without the necessity of proceeding with the appeal, and in an effort to reduce the number of returns based on defective briefs. The Office is also considering further modifications to the final rule that would reserve (delete) certain sections of the final rule that place a burden on appellants appearing before the BPAI in ex parte appeals. The **SUPPLEMENTARY INFORMATION** in this notice provides: (1) An explanation of the possible modifications to the final rule (referred to herein as the “potential modifications to the final rule”) under consideration, (2) a discussion of the differences between the potential modified final rule and the existing rule, and (3) a copy of potential modifications to the final rule under consideration.

#### Explanation of Potential Modifications to the Final Rule

Several changes are being considered to the final rule as compared to the final rule as published in 73 FR 32937 (June 10, 2008). The possible changes under consideration include: (1) Deleting portions of the rule that require the filing of a petition to the Chief Administrative Patent Judge seeking extensions of time to file certain papers after an appeal brief is filed in an ex parte appeal or seeking to exceed a page limit; (2) deleting portions of the rule that require the filing of a jurisdictional statement, table of contents, table of authorities, and statement of facts in appeal briefs, a table of contents, table of authorities, and statement of additional facts in reply briefs, and a table of contents and table of authorities

in requests for rehearing filed in ex parte appeals; (3) deleting portions of the rule that require an appellant to specifically identify which arguments were previously presented to the Examiner and which arguments are new; (4) deleting portions of the rule that require specific formatting requirements and page limits for appeal briefs, reply briefs, and requests for rehearing; and (5) deleting portions of the rule that require appellants to provide a list of technical terms and other unusual words for an oral hearing. The Office is also considering a revision to the final rule so that an examiner may continue to enter a new ground of rejection in an examiner's answer (as is allowed under the current rules). The Office is also considering not allowing an examiner to file a supplemental examiner's answer in response to a reply brief. For reasons of administrative efficiency, the Office is also considering revising the final rule to make clear that the Chief Administrative Patent Judge, rather than the Board, may remand an application to the examiner.

#### Discussion of Potential Modifications to the Final Rule

What follows is a discussion of the potential modifications to the final rule (text follows) compared to the existing rule, currently in effect, for discussion at the roundtable.

Existing rules in Part 1 are denominated as "Rule x" in this **SUPPLEMENTARY INFORMATION**. For example, a reference to Rule 136(a) is a reference to 37 CFR 1.136(a) (2007).

Existing rules in Part 41 are denominated as "Rule 41.x" in this **SUPPLEMENTARY INFORMATION**. For example, a reference to Rule 41.3 is a reference to 37 CFR 41.3 (2007).

Potential modifications to the final rule in this request for comments and notice of roundtable are denominated as "Bd.R. x" in this **SUPPLEMENTARY INFORMATION**. For example, a reference to Bd.R. 41.3 is a reference to the potential modification of 37 CFR 41.3 (2007), as considered for discussion in this request for comments and notice of roundtable.

#### Definitions

Bd.R. 41.2 amends Rule 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. Action by the Chief Administrative Patent Judge is action on behalf of the Director by delegation to the Chief Administrative Patent Judge. *See* MPEP § 1002.02(f) (8th ed., Aug., 2006).

Bd.R. 41.2 also amends Rule 41.2 to eliminate a petition under 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 is amended to include a delegation of authority from the Director to the Chief Administrative Patent Judge to decide certain petitions authorized by Part 41. The delegation of authority would be in addition to that already set out in the MPEP § 1002.02(f) (8th ed., Aug., 2006).

Bd.R. 41.3(b) is amended to define the scope of petitions which can be filed pursuant to the rules. Under 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 (CCPA 1962).

#### Timeliness

Bd.R. 41.4(c) is amended 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, a brief, or a request for oral hearing (*see* §§ 41.31, 41.37, 41.41, 41.47, 41.61, 41.66, 41.67, 41.68, 41.71 and 41.73)." The amendment makes clear that the Chief Administrative Patent Judge would not determine whether extensions are to be granted for the filing of papers before the Board has jurisdiction.

#### Citation of Authority

Rule 41.12 currently requires the public to cite to specific reporters, including some parallel citations. The Board, however, no longer follows the practice specified in Rule 41.12, and does not use parallel citations. Accordingly, Bd.R. 41.12 is amended to make the rule consistent with Board practice and minimize the citation burden on the public. Under Bd.R. 41.12, as amended, a citation to a single source, in the priority order set out in the rule, will be sufficient.

#### Definitions

Bd.R. 41.30 is amended to add a definition of "Record." The Record on appeal would be the official content of the file of an application or reexamination proceeding on appeal. In the rules, a reference to "Record" with a capital R is a reference to the Record as defined in Bd.R. 41.30. The definition advises applicants of what documents the Board will consider in resolving the appeal. The definition also makes it clear to any reviewing court what record was considered by the Board.

#### Appeal to Board

Bd.R. 41.31(a) provides 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: "An appeal is taken from the decision of the examiner mailed [specify date appealed rejection was mailed]." An appeal can be taken when authorized by the statute 35 U.S.C. 134. The provision of Rule 41.31(b) that a notice of appeal need not be signed has been removed. Papers filed in connection with an appeal, including the notice of appeal, would need to be signed in accordance with § 1.33 of this title.

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

Bd.R. 41.31(c) specifies 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.

Bd.R. 41.31(d) provides that a request for an extension of time to file a notice of appeal in an application is governed by Rule 136(a). Bd.R. 41.31(d) also provides 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).

Bd.R. 41.31(e) defines 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. 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. For example, Rule 1.181(f) provides that any petition under Rule 181 not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. The object of the amendment to the rule is 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 intends to strictly enforce the waiver provisions of Bd.R. 41.31(e) 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*

Bd.R. 41.33(a) provides 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.

Bd.R. 41.33(b), under two circumstances, gives the examiner discretion to enter an amendment filed with or after an appeal brief is filed. 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.

Bd.R. 41.33(c) provides that all other amendments filed after the date an appeal brief is filed will not be admitted, except as permitted by (1) Bd.R. 41.39(b)(1) (request to reopen prosecution after entry of new ground of rejection by Examiner), (2) Bd.R. 41.50(b)(1) (request for amendment after remand), (3) Bd.R. 41.50(d)(1) (request to reopen prosecution after entry of new ground of rejection by the Board), and (4) Bd.R. 41.50(e) (amendment after recommendation by the Board).

Bd.R. 41.33(d) provides that evidence filed after a notice of appeal is filed and before an appeal brief is filed may be admitted if (1) the examiner determines that the evidence overcomes at least one rejection 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, the Office would strictly apply the good cause standard. *Cf. Hahn v. Wong*, 892 F.2d 1028 (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 at least one rejection. Even where good cause is shown, if the evidence does not overcome at least one rejection, the evidence would not be admitted. Alternatively, the examiner could determine that the evidence does not overcome at least one rejection under appeal and does not necessitate any new ground of rejection, and on that basis alone, could refuse to admit the evidence.

Bd.R. 41.33(e) provides that evidence filed after an appeal brief is filed will not be admitted except as permitted by (1) Bd.R. 41.39(b)(1) (request to reopen prosecution after entry of new ground of rejection by Examiner), (2) Bd.R. 41.50(b)(1) (request to reopen prosecution after entry of a remand by the Board), and (3) Bd.R. 41.50(d)(1) (request to reopen prosecution after new ground of rejection entered by the Board).

#### *Jurisdiction Over Appeal*

Bd.R. 41.35(a) provides that the Board acquires jurisdiction when the Board mails a docket notice. At an appropriate time after proceedings are completed before the examiner, a docket notice identifying the appeal number would be entered in the application or reexamination proceeding file and mailed to the appellant. A new docket notice identifying a new appeal number would be mailed upon return of the case to the Board following remand. 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 transfers to the Board only after (1) the appellant has filed an appeal brief, (2) the examiner's answer has been mailed, and (3) the appellant has filed a reply brief or the time for filing a reply brief has expired.

Rule 41.35(a) provides that the Board acquires jurisdiction upon transmittal of the file, including all briefs and examiner's answers, to the Board. Under that practice, however, 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 a paper file wrapper. Accordingly, a paper file wrapper 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) mailed to appellant. Upon receipt of the docket notice, appellant knows that the Board has acquired jurisdiction over the appeal. Bd.R. 41.35(a) codifies current practice and establishes a precise date, known to all involved, as to when jurisdiction is transferred to the Board.

Bd.R. 41.35(b) provides that the jurisdiction of the Board ends when (1) the Board mails a remand order (*see* § 41.50(b) or § 41.50(d)(1)), (2) the Board mails a final decision (*see* § 41.50(a) and judicial review is sought or the time for seeking judicial review has expired), (3) an express abandonment is filed which complies with § 1.138 of this title, or (4) a request for continued examination is filed which complies with § 1.114 of this title. The Board knows when it mails a remand order and when it mails a final decision. The Board is not automatically notified when an express abandonment or a request for continued examination is filed. One problem the Board has had in the past is that an appellant does not notify the Board that it has filed an express abandonment or a request for continued examination and the Board continues to work on the appeal. Often failure to notify occurs after oral hearing. Accordingly, an appellant should notify the Board immediately if an express abandonment or a request for continued examination is filed. If any notification reaches the Board after a remand order or a final decision is mailed, the remand order or final decision will not be removed from the file.

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* Bd.R. 41.50(b). Second, a remand is entered when an appellant elects further prosecution before the examiner following entry of a new ground of rejection by the Board. *See* Bd.R. 41.50(d)(1). Upon entry of a remand, the Board's jurisdiction ends.

The Board also no longer has 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, 939 (CCPA 1940) and *In re Graves*, 69 F.3d 1147, 1149 (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 Rule 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 remand or a new ground of rejection is an interlocutory order and is not a final decision. If an appellant elects to ask for rehearing to contest a new ground of 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 has been mailed. 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*

Bd.R. 41.37 provides for filing an appeal brief to perfect an appeal and sets out the requirements for appeal briefs. The appeal brief is a highly significant document in an ex parte appeal. Appeal brief experience under Rule 41.37 has been mixed. Bd.R. 41.37 seeks to (1) take advantage of provisions of Rule 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.

Bd.R. 41.37(a) provides that an appeal brief shall be filed to perfect an appeal. Upon a failure to timely file an appeal brief, proceedings on the appeal would be considered terminated. The language “without further action on the part of the Office” gives notice that no action, including entry of a paper by the Office, would be necessary for the appeal to be considered terminated. Bd.R. 41.37(a) does 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” provides notice that when

(1) no appeal brief is filed, and (2) no claims are allowed, the time for filing a continuing application under 35 U.S.C. 120 would be before the time expires for filing an appeal brief. The language “terminated” is used because proceedings on appeal are over prior to mailing of a docket notice pursuant to Bd.R. 41.35(a). Dismissal of an appeal takes place after a docket notice is mailed since only the Board dismisses an appeal (Bd.R. 41.35(b)(2)).

Bd.R. 41.37(b) provides that the appeal brief shall be accompanied by the fee required by Bd.R. 41.20(b)(2).

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

Bd.R. 41.37(d) provides that 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://frwebgate.access.gpo.gov/cgi-bin/leaving.cgi?from=leavingFR.html&log=linklog&to=http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.html>), 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.

*Bd.R. 41.37(e) provides 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) [reserved], (4) [reserved], (5) [reserved], (6) [reserved], (7) status of amendments, (8) grounds of rejection to be reviewed, (9) [reserved], (10) argument, and (11) an appendix containing (a) claims section, (b) claim support and drawing analysis section, (c) means or step plus function analysis section, (d) evidence section, and (e) related cases section. The items are otherwise defined in other subsections of Bd.R. 41.37.

Bd.R. 41.37(f) requires 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. If an appeal brief does not contain a statement of real party in interest, the Office will assume that the named inventors are the real party in interest.

Bd.R. 41.37(g) requires 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 any inventors, any attorneys or agents who prepared or prosecuted the application on appeal and any other person who was substantively involved in the preparation or prosecution of the application on appeal. A related case is one which would 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 in the appendix (Bd.R. 41.37(u)). A significant interlocutory decision would include (1) a decision on a patentability motion in an interference, or (2) a decision in an interference or a court interpreting a claim. A related case includes any continuing application of the application on appeal. If an appellant fails to advise the Board that it has filed a continuing application or a request for continued examination, or that it has filed an express abandonment of the application on appeal and the Board mails a decision on appeal in the application on appeal, the appellant should expect that the decision will not be removed from the file. The time to update a statement of related cases, or notify the Board that an application on appeal has been abandoned, is when the continuing application, request for continued examination, or express abandonment is filed. Appellant would be under a continuing obligation to update a statement of related cases during the pendency of the appeal. If an appeal brief does not contain a statement of related cases, the Office will assume that there are no related cases.

Bd.R. 41.37(h) is reserved.

Bd.R. 41.37(i) is reserved.

Bd.R. 41.37(j) is reserved.

Bd.R. 41.37(k) is reserved.

Bd.R. 41.37(l) requires 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: (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.”

Bd.R. 41.37(m) requires an appeal brief to set out the grounds of rejection to be reviewed, including the claims subject to each rejection. Examples might read as follows: (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.”

Bd.R. 41.37(n) is reserved.

Bd.R. 41.37(o) requires that an appeal brief contain an argument comprising an analysis explaining, as to each rejection to be reviewed, why the appellant believes the examiner erred. 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 (1) 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 (2) provide the best opportunity for resolution of the dispute without the necessity of proceeding with the appeal.

To promote clarity, Bd.R. 41.37(o) also requires that each rejection for which review is sought shall be separately argued under a separate heading. Also, Bd.R. 41.37(o) provides that any finding made or conclusion reached by the examiner that is not challenged would be presumed to be correct.

Bd.R. 41.37(o)(1) provides that when a ground of rejection applies to two or more claims, the claims may be argued separately (claims are considered by appellant as separately patentable) or as

a group (claims stand or fall together). When two or more claims subject to the same ground of rejection are argued as a group, the Board may select a single claim from the group of claims that are argued together and decide the appeal on the basis of the selected claim alone with respect to the group of claims as to the ground of rejection. Any doubt as to whether an election has been made would be resolved against the appellant and the claims would be deemed to have been argued as a group.

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 will 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 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 should 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” (Bd.R. 41.37(p)). In an application containing claims 1–3 where the examiner has made (1) a § 102 rejection, or (2) a § 103 rejection, or (3) both a § 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 § 102, claims 1–3 stand or fall together.” (2) “With respect to the rejection under § 103, claims 1–2 stand or fall together; claim 3 is believed to be separately patentable.” (3) “With respect to the rejection under § 102, claims 1–2 stand or fall together; claim 3 is believed to be separately patentable. With respect to the rejection under § 103, the claims stand or fall together.”

Bd.R. 41.37(o)(2) provides 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 and drawing analysis section in the appendix. In keeping with the well-established rules of waiver, Appellant would waive all arguments which could have been, but were not, addressed in the argument section of the appeal brief. See e.g., *Hyatt v. Dudas*, 551 F.3d 1307, 1313–14 (Fed. Cir. 2008) (holding that

when an appellant fails to contest a ground of rejection to the Board, the Board may treat any argument with respect to that ground of rejection as waived); *In re Watts*, 354 F.3d 1362, 1367–68 (Fed. Cir. 2004) (declining to consider the appellant’s new argument regarding the scope of a prior art patent raised for the first time on appeal because the court did not have the benefit of the Board’s informed judgment on the issue for its review); *In re Berger*, 279 F.3d 975, 984 (Fed. Cir. 2002) (in which the Board affirmed an uncontested rejection of claims under 35 U.S.C. 112, second paragraph, and on appeal the Federal Circuit affirmed the Board’s decision and found that the appellant had waived his right to contest the indefiniteness rejection by not presenting arguments as to error in the rejection on appeal to the Board); and *In re Schreiber*, 128 F.3d 1473, 1479 (Fed. Cir. 1997) (declining to consider whether prior art cited in an obviousness rejection was non-analogous art when that argument was not raised before the Board).

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 in the appendix would include all pending claims, not just those under rejection. The status of each claim would have to be indicated (i.e., 1 (rejected), 2 (withdrawn), 3 (objected to), 4 (cancelled), 5 (allowed), 6 (confirmed), 7 (not subject to reexamination)).

Bd.R. 41.37(q) is reserved.

Bd.R. 41.37(r) requires an appeal brief to contain a “claim support and drawing analysis section.”

The claim support portion of Bd.R. 41.37(r) replaces Rule 41.37(c)(1)(v) which required a concise explanation of the subject matter defined in each of the independent claims on appeal. The claim support section, for each independent claim involved in the appeal and each dependent claim argued separately (see 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 or paragraph 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 Bd.R. 41.37(p)), only those independent claims and dependent claims being argued separately, would need to appear in the “claim support



and drawing analysis section.” A significant objective of the claim support requirement is 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 requirement will help the Board interpret the scope of claims, or the meaning of words in a claim, before applying the prior art. Practice under Rule 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 rule.

One significant problem faced by the Board under Rule 41.37(c)(1)(v) 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 requirement will give the examiner and the Board the appellant’s view on where the claim is supported by the application, as filed. The requirement is expected to significantly improve the efficiency of the Board’s handling of appeals.

The “claims support and drawing analysis section” also requires for each independent claim on appeal and each dependent claim argued separately (*see* Bd.R. 41.37(o)(1)), that a drawing analysis consist of an annotated copy of the claim in numerical sequence, indicating in bold face between braces ( { } ) (the same braces used to identify references to the specification) 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 requirement is

expected to be equally useful in *ex parte* appeals.

Bd.R. 41.37(s) requires an appeal brief to contain a “means or step plus function analysis section.” The means or step plus function analysis section replaces the requirement of Rule 41.37(c)(1)(v) relating to identification of structure, material or acts for means or step plus function claim limitations contained in appealed claims. Under Bd.R. 41.37(s), the means or step plus function analysis section would include each independent claim and each dependent claim argued separately (*see* 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, an annotated 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.

The Office is requiring 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 Rule 41.37(c)(1)(v). A means or step plus function analysis essentially tracking Bd.R. 41.37(s) has been used in interference cases since 1998 and has been helpful in determining the scope of claims involved.

Bd.R. 41.37(t) would require an appeal brief to contain an “evidence section” in the appendix. The evidence section essentially continues the practice under Rule 41.37(c)(1)(ix). The evidence section would include (1) [reserved], (2) [reserved], (3) [reserved], (4) [reserved], (5) affidavits and declarations upon which the appellant relied before the examiner, (6) other evidence upon which the appellant relied before the examiner, and (7) evidence relied upon by the appellant and admitted into the file pursuant to Bd.R. 41.33(d).

Documents in the evidence appendix would not have to be reformatted to comply with format requirements of the appeal brief. However, the affidavits, declarations and evidence required by Bd.R. 41.37(t) which is otherwise mentioned in the appeal brief, but which does not appear in the evidence section will not be considered. Rule 41.37(c)(1)(ix) has a similar provision, but appellants have not attached the evidence appendix required by that rule. Appellants will now be on notice

of the consequence of failing to comply with Bd.R. 41.37(t).

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 for consideration by Board.

Bd.R. 41.37(u) requires an appeal brief to contain a “related cases section” in the appendix. The related cases section consists of copies of orders and opinions required to be cited pursuant to Bd.R. 41.37(g).

#### *Examiner’s Answer*

Bd.R. 41.39(a)(1) provides 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 may 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.

Bd.R. 41.39(a)(2) provides that an examiner may enter a new ground of rejection in an examiner’s answer. As made clear in Bd.R. 41.39(a)(1) and Bd.R. 41.39(d), the examiner may respond to appellant’s brief by filing only one examiner’s answer, except in the case of a return or remand of an application by the Chief Administrative Patent Judge to the examiner (*see* Bd.R. 41.50(b)). The examiner may no longer file a supplemental examiner’s answer in response to a reply brief. The reply brief is the last word. Although the examiner may enter a new ground of rejection in the examiner’s answer, this will rarely occur because the examiner will not be able to respond to any new argument raised in the reply brief in response to the new ground. As set forth below in Bd.R. 41.39(b) and its subparts, if the examiner does enter a new ground of rejection in the examiner’s answer, the appellant will have a choice of either (a) requesting reopening of prosecution before the examiner with the opportunity to enter an amendment or file additional evidence, or (b) requesting docketing of the appeal by the Board and filing a reply brief with argument relevant to the new ground of rejection. Where a newly cited reference is added in the examiner’s answer merely as evidence of the prior statement made by the examiner as to what is “well-known” in the art which was challenged for the first time in the appeal brief, the citation of the reference in the examiner’s answer would not ordinarily constitute a new ground of rejection within the meaning of Bd.R. 41.39(a)(2) and 41.39(b). Similarly, it



would not ordinarily be a new ground of rejection for an examiner to cite an additional reference in an examiner's answer in the following situations: (1) To prove a previously applied reference contains an enabling disclosure; (2) to explain the meaning of a term used in a previously applied reference; or (3) to show that a characteristic not explicitly disclosed in a previously applied reference is inherent. The basic thrust of the rejection remains the same in these above-referenced situations because the additional reference simply explains a previously applied reference or is evidence of what was taught in a previously applied reference in response to a new argument.

Bd.R. 41.39(b) provides that if an examiner's answer contains a rejection designated as a new ground of rejection, appellant would be required to exercise one of two options to avoid dismissal of the appeal as to the claims subject to the new ground of rejection. Either option would have to be exercised within two months from the date of the examiner's answer.

Bd.R. 41.39(b)(1) specifies a first option and provides 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 new ground of 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 Rule 112. A request under Bd.R. 41.39(b)(1) would be treated as a request to dismiss the appeal.

Bd.R. 41.39(b)(2) specifies a second option and provides that appellant could request that the appeal be docketed. The request would have to be accompanied by a reply brief as set forth in 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 Bd.R. 41.39(b)(1).

Bd.R. 41.39(c) provides that extensions of time under Rule 136(a) do not apply and that a request for an extension of time would be governed by the provisions of Rule 136(b) for extensions of time to reply for patent applications and Rule 550(c) for extensions of time to reply for ex parte reexamination proceedings.

Bd.R. 41.39(d) provides that the examiner shall not enter a supplemental examiner's answer in response to any

reply brief filed under Bd.R. 41.39(b)(2) and/or Bd.R. 41.41.

#### *Reply Brief*

Bd.R. 41.41(a) provides that an appellant may file a single reply brief responding to the examiner's answer. On too many occasions, appellants have filed a first reply brief and thereafter a second reply brief. Only one reply brief is authorized under Bd.R. 41.41(a). A second reply brief will not be considered.

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

Bd.R. 41.41(c) provides that extensions of time under Rule 136(a) do not apply and that a request for an extension of time would be governed by the provisions of Rule 136(b) for extensions of time to reply for patent applications and Rule 550(c) for extensions of time to reply for ex parte reexamination proceedings.

Bd.R. 41.41(d) provides that a reply brief shall be limited to responding to points made in the examiner's answer. Except as otherwise set out in the rules, the form and content of a reply brief would be governed by the requirements for an appeal brief as set out in Bd.R. 41.37. A reply brief would be required to contain, under appropriate headings and in the order indicated, the following items: (1) [reserved], (2) [reserved], (3) [reserved], (4) [reserved], (5) argument.

Bd.R. 41.41(e) is reserved.

Bd.R. 41.41(f) is reserved.

Bd.R. 41.41(g) requires that an argument made in the reply brief be limited to responding to points made in the examiner's answer. Any argument raised in a reply brief which is not responsive to a point made in the examiner's answer will not be considered and will be treated as waived. An example of an acceptable format for presenting an argument in a reply brief (where there was no new ground of rejection in the examiner's answer) might read as follows: First paragraph: "This is a reply to the examiner's answer mailed [insert the date the answer was mailed]." 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 should 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 should refer to the page number and line or paragraph and drawing element number of any document relied upon to

support the response. Frequently, new details and arguments surface in reply briefs. Bd.R. 41.41(g) seeks to confine reply briefs to what they ought to be—a response to points raised in the examiner's answer. If 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 may be given to further limiting the nature of replies filed in ex parte appeals.

Bd.R. 41.41(h) is reserved.

Bd.R. 41.41(i) provides 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 continuing application or 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 and Supplemental Reply Brief Bd.R. 41.43 is reserved. An examiner will no longer be responding to a reply brief. As such, a supplemental reply brief is also no longer authorized because the examiner will no longer be filing a response to a reply brief.

#### *Oral Hearing*

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

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

Bd.R. 41.47(c) provides that the time for filing a request for an oral hearing would be within two months from the date the examiner's answer is mailed.

Bd.R. 41.47(d) provides that extensions of time under Rule 136(a) do not apply and that a request for an extension of time would be governed by the provisions of Rule 136(b) for extensions of time to reply for patent applications and Rule 550(c) for extensions of time to reply for ex parte reexamination proceedings.

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

Bd.R. 41.47(f) provides 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.

Bd.R. 41.47(g) is reserved.

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

Bd.R. 41.47(i) provides that at oral hearing only the Record 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 made at the oral hearing.

Bd.R. 41.47(j) provides that notwithstanding 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.

Bd.R. 41.47(k) provides that visual aids may be used at an oral hearing. However, visual aids must be limited to copies of documents or artifacts in the Record or a model or exhibit presented for demonstration purposes during an interview with the examiner. When an appellant seeks to use a visual aid, one copy of each visual aid (photograph in the case of an artifact, a model or an exhibit) should be provided for each judge and one copy to be added to the Record.

Bd.R. 41.47(l) provides 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 is 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*

Bd.R. 41.50(a) provides 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. Bd.R. 41.50(a) continues a

long-standing 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.

Bd.R. 41.50(b) provides that the Chief Administrative Patent Judge may remand an application to the examiner. This potential modification would designate that the Chief Administrative Patent Judge, rather than the Board, may remand an application to the examiner. This change to the rule is being considered as a matter of administrative efficiency because a large majority of remands from the Board are administrative remands made under the direction of the Chief Administrative Patent Judge due to procedural defects in the application, rather than remands made by an assigned panel of Administrative Patent Judges on the merits. For example, in Fiscal Year 2009, the Board issued 431 administrative remands of applications to the examiner and only 33 merits remands of applications to the examiner. The Chief Administrative Patent Judge can delegate to an assigned panel of Administrative Patent Judges the authority to remand an application. 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. An examiner may enter an examiner's answer in response to a remand. Should the examiner enter an 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 any examiner's answer mailed in response to the remand.

Bd.R. 41.50(b)(1) specifies a first option and provides 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 any examiner's answer mailed in response to the remand. 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 Bd.R. 41.50(b)(1) would be treated as a request to dismiss the appeal.

Bd.R. 41.50(b)(2) specifies a second option and provides 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 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 Bd.R. 41.50(b)(1).

Bd.R. 41.50(c) provides 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 judicial review. *Copelands' Enter., Inc. v. CNV, Inc.*, 887 F.2d 1065 (Fed. Cir. 1989) (en banc).

Bd.R. 41.50(d) provides 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 ground of rejection. The pending claim could be a claim not rejected by the examiner. A new ground of rejection would not be considered final for purposes of judicial review. A new ground of 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. Bd.R. 41.50(d) places an appellant under a burden to explain to the Board or the Office why a new ground of rejection is not proper before it burdens a court with judicial review. A response by an appellant may convince the Office that a new ground of rejection should be withdrawn. If the Board enters a new ground of rejection, appellant would have to exercise one of 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. Either option would have to be exercised within two months from the date of the new ground of rejection.

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

overcomes the new ground of rejection. In the event the examiner maintains the rejection, appellant would be able to again appeal to the Board.

Bd.R. 41.50(d)(2) specifies that a second option would be to request rehearing pursuant to 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.

Bd.R. 41.50(e) continues a long-standing practice 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 a rejection of a claim amended in conformity with a recommendation provided that the additional rejection constitutes a new ground of 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.

Bd.R. 41.50(f) provides 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. 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) Rule 41.50(d). Practice under Rule 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.

Bd.R. 41.50(g) provides for extensions of time to respond to actions of the Board under Bd.R. 41.50(b) and (d). Bd.R. 41.50(g) provides that a request for an extension of time to respond to a request for briefing and information under Bd.R. 41.50(f) is not authorized. A request for an extension of time to respond to Board action under Bd.R. 41.50(b) and (d) would be governed by the provisions of Rule 136(b) for extensions of time to reply for patent applications and Rule 550(c) for extensions of time to reply for ex parte reexamination proceedings.

#### *Rehearing*

Bd.R. 41.52(a) authorizes an appellant to file a single request for rehearing. In the past, appellants have filed a second request for rehearing, in effect supplementing a first request for rehearing. Filing a second or subsequent request for rehearing is not authorized. Any second or subsequent request for rehearing will not be considered.

Bd.R. 41.52(b) provides that a request for rehearing is due within two months from the date the decision by the Board is mailed.

Bd.R. 41.52(c) provides that extensions of time under Rule 136(a) do not apply and that a request for an extension of time would be governed by the provisions of Rule 136(b) for extensions of time to reply for patent applications and Rule 550(c) for extensions of time to reply for ex parte reexamination proceedings.

Bd.R. 41.52(d) provides that a request for rehearing would have to contain, under appropriate headings and in the order indicated, the following items: (1) [reserved], (2) [reserved], (3) [reserved], and (4) argument.

Bd.R. 41.52(e) is reserved.

Bd.R. 41.52(f) provides that a request for rehearing shall state with particularity the points believed to have been misapprehended or overlooked by the Board. A general restatement of the case will not be considered an argument that the Board misapprehended or overlooked a point. A new argument cannot be made in a request for rehearing, except in two instances.

Bd.R. 41.52(f)(1) would authorize in a first instance an appellant to respond to

a new ground of rejection entered pursuant to Bd.R. 41.50(d)(2).

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.

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

Bd.R. 41.52(h) provides 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*

Bd.R. 41.54 provides 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*

Bd.R. 41.56 is new and provides for sanctions. The rule is designed to put the public on notice of actions which the Office believes are detrimental to the efficient handling of ex parte appeals.

Bd.R. 41.56(a) provides that the Director may impose a sanction against an appellant for misconduct. Misconduct would include (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. A sanction would be entered by the Director. A sanction would be applied against the appellant, not against a registered practitioner. Conduct of a registered practitioner could result in a sanction against an appellant. Conduct of a registered practitioner believed to be inappropriate would be referred to the Office of Enrollment and Discipline for such action as may be appropriate.

Bd.R. 41.56(b) provides that the nature of possible sanctions includes entry of (a) an order declining to enter a docket notice, (b) an order holding certain facts to have been established in the appeal, (c) an order expunging a paper or precluding an appellant from filing a paper, (d) an order precluding

an appellant from presenting or contesting a particular issue, (e) an order excluding evidence, (f) an order holding an application on appeal to be abandoned or a reexamination proceeding terminated, (g) an order dismissing an appeal, (h) an order denying an oral hearing, or (i) an order terminating an oral hearing.

Whether and what sanction, if any, should be imposed against an appellant in any specific circumstance would be a discretionary action.

Previously submitted comments, particularly those submitted in response to the PRA notice [73 FR 32559], raised some public concerns. To the extent the potential modifications to the final rule have not obviated these concerns, we address them below in an effort to solicit more meaningful feedback from the public in response to this notice.

**Concern 1:** A concern was raised that the claim support and drawing analysis section (final rule 41.37(r)) and the means or step plus function analysis section (final rule 41.37(s)) significantly increase the burden of preparing a brief.

**Answer 1:** The potential modifications to the final rule are not intended to add any additional burden to appellants. It may be helpful to explain why the Office believes that no additional burden is likely. By way of comparison, current rule 41.37(c)(1)(v) is analogous to final rule sections 41.37(r) and (s). The current rule requires "a concise explanation of the subject matter defined" in each independent claim on appeal. The current rule also requires the explanation to refer to the specification by line and page number and the drawings, if any, by reference characters.

Potential modification to final rule 41.37(r) also requires that appellants refer to line and page numbers or paragraphs of the specification when mapping a claim. The potential modifications to the final rule differ, however, in that it requires not only a mapping of the independent claims on appeal but also a mapping of any dependent claim argued separately. For cases in which the appellants argue the dependent claims separately, this may minimally add to the burden in preparing the brief. Based upon the experience of the Office for the briefs coming before the Board, this additional burden will be realized in only a minority of cases. In the majority of cases coming before the Board, appellants have not argued dependent claims separately, and in such appeals the mapping burden is the same under both the current rule and the final rule.

With regard to claims containing means plus function and step plus

function limitations, the requirements of the current rule (41.37(c)(1)(v)) and those under consideration as potential modifications to final rule (41.37(s)) are the same. Both require a mapping of such limitations to the specification by reference to page and line numbers and drawing reference characters which describe the structure, material, or acts. Both rules also require a mapping of the independent and dependent claims argued separately for those claims containing means plus function and step plus function limitations. The potential modifications to the final rule correct the inconsistency of the current rule of mapping both independent claims and dependent claims argued separately only in the case of means plus function and step plus function claims. In the potential modifications to the final rule, all independent claims and dependent claims argued separately on appeal are required to be mapped to the specification.

In addition, the potential modification to final rules 41.37(r) and (s) are intended to benefit appellants by reducing the likelihood of a defective brief notice or a return from the Board for non-compliance with the rule. One of the primary reasons for a defective brief notice or a return under the current rules is an improper summary of the claimed subject matter (rule 41.37(c)(1)(v)). The current rule requires "a concise explanation of the subject matter." The phrase "a concise explanation of the subject matter" in the current rule has been interpreted in a myriad of ways by appellants. Appellants often misinterpret what the current rules require or have questions for which they seek guidance. The language in the current rule has also resulted in inconsistent interpretation by Office reviewers. The current rule has led to many appeals being returned before the Board will consider appeals on their merits. The potential modifications to the final rule would change the requirement to a clearly objective one. The potential modifications to the final rule would require "an annotated copy of the claim \* \* \* indicating in boldface between braces { } the page and line or paragraph after each limitation where the limitation is described in the specification as filed." The potential modifications to the final rule provide a standardized objective format for appellants to follow and for agency reviewers to apply. This removes appellant's burden of interpreting the rule and reduces the likelihood of incurring additional burden and delay due to a defective brief notice, return, or

remand. The Office, thus, has regarded this more precise requirement as a net benefit to appellants by reducing the delay that too frequently results from the current rule, while setting up the case better for decision. Objections, if any, to this approach should propose better ways to accomplish this goal.

**Concern 2:** A concern was raised that the sanctions rule (final rule 41.56) placed an additional burden on appellants in that sanctions in appeals are a new concept and create a new category of misconduct.

**Answer 2:** This concern is based on the mistaken premise that the final rule creates totally new misconduct sanctions. Potential modifications to final rule 41.56 are not new concepts and do not create a new category of misconduct. Existing 37 CFR 11.18 provides the Director the authority to impose procedural sanctions for misconduct for matters related to papers filed before the USPTO. Potential modifications to final rule 41.56 merely makes clear that the Director's existing 37 CFR 11.18 authority to impose procedural sanctions extends to misconduct that may occur during an ex parte appeal.

Additionally, potential modifications to final rule 41.56 parallel existing 37 CFR 41.128, which is limited to contested case appeals. Together these rules provide a comprehensive scope of procedural sanctions for misconduct before the Board beyond just those matters covered by 37 CFR 11.18. Finally, in addition to the Director's explicit authority to establish regulations which shall govern the conduct of proceedings in the Office (35 U.S.C. 2(b)(2)(A)), the Director has, and always has had, inherent authority to enforce the rules and to impose an appropriate sanction. In addition to existing 37 CFR 11.18 and 37 CFR 41.128, *see* existing 37 CFR 2.120(g) covering sanctions during inter partes trademark proceedings. The authority for potential modifications to final rule 41.56 spring from the same authority as these existing rules and is not a new concept. Potential modifications to final rule 41.56 provide for sanctions against an appellant when appropriate.

Also, the rule is meant to be employed for egregious cases of attorney misconduct, such as, for example, in the case where a practitioner consistently and repeatedly fails to follow the Board's rules.

**Concern 3:** A concern was raised that final rule 41.37(u) requiring copies of final decisions in Board or court proceedings related to the appeal places an additional burden on the appellants.

*Answer 3:* The requirement for such copies is not a new requirement. On the contrary, in both the current rule and the potential modifications to the final rule, appellants are required to file copies of any final decision of the Board or court proceeding related to the case on appeal. The potential modifications to the final rule would impose no additional burden.

*Concern 4:* A concern was raised that appellants have no way to respond to a new explanation in an examiner's answer.

*Answer 4:* It is not correct that the appellant cannot respond. Such a response is permitted in a reply brief authorized by the potential modification to final rule 41.41.

The United States Patent and Trademark Office (Office) is considering changes to its rules in 37 CFR part 41 governing prosecution in ex parte appeals at the Board of Patent Appeals and Interferences (Board). There are no fee changes associated with the proposed modified final rule. Additionally, as follows below, no additional cost burdens are anticipated as a result of the potential modifications to the final rule that are under consideration.

The primary potential modifications to these rules are: (1) The appeal brief must include sections for claim support and drawing analysis and means or step plus function analysis in the appendix of the appeal brief, (2) the reply brief must limit arguments made in the reply brief to those responsive to points made in the examiner's answer, (3) in a request for rehearing, a general restatement of the case will not be considered an argument that the Board misapprehended or overlooked a point, and (4) the examiner's response to a reply brief is eliminated. The rules described in (1), (2), and (4) will apply to all appeal briefs filed with the Board. The rule described in (3) will apply only to those applicants who file a request for rehearing.

#### *Appeal Brief (1)*

No additional cost is associated with the potential modifications to the appeal brief requirements.

The claim support and drawing analysis section and the means or step plus function analysis section are analogous to the current summary of the claimed subject matter section in the appeal brief. The information required for these two newly titled sections is the same as that required by the current rules. The potential modifications to the final rule, however, are explicit as to the format to be followed in these sections. The current rule requires an explanation

of the subject matter, whereas the potential modifications to the final rule set forth the precise format to be used in mapping claim limitations to the support and description of the limitations in the specification and drawings. Bd. R. 41.37(r) and (s). The current rule leaves the format for the explanation of the claimed subject matter open to interpretation by the applicant. Rule 41.37(c)(1)(v). The potential modifications to the final rule provide a standardized, easy to follow format for these sections. By following the prescribed format of the potential modifications to the final rule, the applicant will save time in not having to create their own format to explain the claimed subject matter. Moreover, the potential modifications to the final rule format are expected to reduce the number of applications returned to the examiner because the brief is not compliant with the explanation of the claimed subject matter section of the rule. Under the current rules, it is not uncommon for a case to be returned to the examiner because of deficiencies in the summary of the claimed subject matter section of the appeal brief. When a case is returned to the examiner for correction of a non-compliant brief, the applicant must prepare and file a corrected brief. This delays the applicant's appeal and costs the applicant money to prepare a compliant brief. By following the clear, standardized format in the potential modifications to the final rule for the claim support and drawing analysis section and means or step plus function section, applicants can prevent a return of their application on either or both of these bases. This will save the applicant the time and expense incurred for filing a corrected appeal brief. The claim support and drawing analysis section and the means or step plus function analysis section will not add cost to the appeal brief and will provide a savings to applicants in some cases.

#### *Reply Brief (2)*

No additional cost is associated with the new reply brief requirement under consideration in the potential modifications to the final rule.

Under the potential modifications to the final rule, the argument section of the reply brief has a new requirement that arguments be responsive to points made in the examiner's answer; otherwise, the argument will not be considered and will be treated as waived. This requirement does not impose any additional economic burden on the applicant. It only makes clear what arguments in the reply brief will be considered by the Board. It saves the

applicant the time and expense of preparing arguments that will not be considered.

#### *Request for Rehearing (3)*

No additional cost is associated with the potential modifications to the request for rehearing requirement.

Under the potential modifications to the final rule, it would be established that a restatement of the case will not be considered an argument that the Board misapprehended or overlooked a point. Under current Rule 41.52(a)(1), applicants are already required to "state with particularity the points believed to have been misapprehended or overlooked by the Board." As such, the clarification in the potential modifications to the rule as to what fails to constitute an argument that the Board misapprehended or overlooked a point do not impose any additional economic burden on the applicant. Rather, it makes clear what arguments in the request for rehearing will be considered by the Board. Thus, the potential modifications to the final rule save the applicant the time and expense of preparing arguments that will not be considered.

#### *Elimination of Examiner's Response to Reply Brief (4)*

The potential modifications to the final rule eliminate the requirement for an examiner's response following a reply brief. Under the current rule, examiners are required to respond to a reply brief either by filing a communication noting the reply brief or by filing a supplemental examiner's answer. Rule 41.43(a)(1). The potential modifications to the final rule eliminate both types of examiner response to a reply brief.

The elimination of the examiner's requirement to note the reply brief allows applications on appeal to proceed directly to the Board upon filing of the reply brief, without waiting for an examiner's response. This saves the applicant valuable time in the appeal process. It also saves the applicant the expense of tracking the examiner's response to the reply brief.

The elimination of a supplemental examiner's answer in response to a reply brief also allows applications on appeal to proceed directly to the Board upon filing of the reply brief. The applicant realizes an additional savings by elimination of the supplemental examiner's answer. Current practice provides that the applicant may file another reply brief in response to a supplemental examiner's answer. In almost every appeal where a supplemental examiner's answer is

provided, the applicant submits another reply brief. By eliminating the supplemental examiner's answer, it eliminates the need for applicant to respond with another reply brief. Therefore, elimination of the supplemental examiner's answer saves the applicant the cost of preparing another reply brief.

To summarize, the potential modifications to the final rule would result in no economic impact to an applicant, and may result in a net savings to the applicant when the savings outlined for the appeal brief, reply brief, and no examiner response to the reply brief are realized.

### Paperwork Reduction Act

Potential modifications to the final rule may involve 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 the existing rules, currently in effect, is under review and will be approved by OMB under OMB collection number 0651-0063. The collection of information involved in this notice would also be covered under OMB control number 0651-0063. The Office plans to submit any new information collection request related to modifications to the final rule to OMB prior to issuing any final rule.

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.

### Potential Modifications to the Rule for Discussion at Roundtable and for Written Comment

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 is proposing 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 revised 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. 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 limited under § 1.957(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, a brief, or a request for oral hearing (*see* §§ 41.31, 41.37, 41.41, 41.47, 41.61, 41.66, 41.67, 41.68, 41.71, and 41.73).

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

4. Revise § 41.12 to read as follows:

#### § 41.12 Citation of authority.

(a) *Authority.* Citations to authority must include:

(1) *United States Supreme Court decision.* A citation to a single source in the following order of priority: United States Reports, West's Supreme Court Reports, United States Patents Quarterly, Westlaw, or a slip opinion.

(2) *United States Court of Appeals decision.* A citation to a single source in the following order of priority: West's Federal Reporter (F., F.2d or F.3d), West's Federal Appendix (Fed. Appx.), United States Patents Quarterly, Westlaw, or a slip opinion.

(3) *United States District Court decision.* A citation to a single source in the following order of priority: West's Federal Supplement (F.Supp., F.Supp. 2d), United States Patents Quarterly, Westlaw, or a slip opinion.

(4) *Slip opinions.* If a slip opinion is relied upon, a copy of the slip opinion must accompany the first paper in which an authority is cited.

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

(b) *Non-binding authority.* Non-binding authority may be cited. If non-binding authority is not an authority of the Office and is not reproduced in one of the reporters listed in paragraph (a) of this section, a copy of the authority shall be filed with the first paper in which it is cited.

### Subpart B—Ex parte Appeals

5. In § 41.30, add the definition “Record” to read as follows:

#### § 41.30 Definitions.

\* \* \* \* \*

*Record* means the official content of the file of an application or reexamination proceeding on appeal.

6. 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 (*see* § 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 having that issue considered in the application or reexamination on appeal.

7. 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 reexamination proceeding on appeal, 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:

(1) The examiner determines that the evidence overcomes at least one rejection under appeal and does not necessitate any new ground of rejection, and

(2) 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.

8. 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 mailed by the Board.

(b) *End of jurisdiction.* The jurisdiction of the Board ends when:

(1) The Board mails a remand order (*see* § 41.50(b) or § 41.50(d)(1) of this subpart),

(2) The Board mails a final decision (*see* § 41.2 of this part) and judicial review is sought or the time for seeking judicial review has expired,

(3) An express abandonment is filed which complies with § 1.138 of this title, or

(4) A request for continued examination is filed which complies with § 1.114 of this title.

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

9. 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 (*see* § 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 (*see* paragraph (f) of this section).

(2) Statement of related cases (*see* paragraph (g) of this section).

(3) [Reserved.]

(4) [Reserved.]

(5) [Reserved.]

(6) [Reserved.]

(7) Status of amendments (*see* paragraph (l) of this section).

(8) Grounds of rejection to be reviewed (*see* paragraph (m) of this section).

(9) [Reserved.]

(10) Argument (*see* paragraph (o) of this section).

(11) An appendix containing a claims section (*see* paragraph (p) of this section), a claim support and drawing analysis section (*see* paragraph (r) of this section), a means or step plus function analysis section (*see* paragraph (s) of this section), an evidence section (*see* paragraph (t) of this section), and a related cases section (*see* paragraph (u) of this 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. If an appeal brief does not contain a statement of real party in interest, the Office will assume that the named inventors are the real party in interest.

(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 any inventors, any attorneys or agents who prepared or prosecuted the application on appeal and any other person who was substantively involved in the preparation or prosecution of the application on appeal, 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 related case includes any continuing application of the application on 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 (*see* paragraph (u) of this section) in the appendix. Appellant is under a continuing obligation to update this item during the pendency of the appeal. If an appeal brief does not contain a statement of related cases, the Office will assume that there are no related cases.

(h) [Reserved.]

(i) [Reserved.]

(j) [Reserved.]

(k) [Reserved.]

(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) *Grounds of rejection to be reviewed.* The “grounds of rejection to be reviewed” shall set out the grounds of rejection to be reviewed, including the statute applied, the claims subject to each rejection and references relied upon by the examiner.

(n) [Reserved.]

(o) *Argument.* The “argument” 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. Each ground of rejection shall be separately argued under a separate heading.

(1) Claims standing or falling together. For each ground of rejection applicable to two or more claims, the claims may be argued separately (claims are considered by appellants as separately patentable) or as a group (claims stand or fall together). When two or more claims subject to the same ground of rejection are argued as a group, the Board may select a single claim from the group of claims that are argued together to decide the appeal on the basis of the selected claim alone with respect to the group of claims as to the ground of rejection. Any doubt as to whether claims have been argued separately or as a group as to a ground of rejection will be resolved against appellant and the claims will be deemed to have been argued as a group. Any claim argued separately as to a ground of rejection 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 and drawing analysis section in the appendix will be considered. Appellant waives all other arguments in the appeal.

(p) *Claims section.* The “claims section” in 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 every claim shall be set out after the claim number and in parentheses (e.g., 1 (rejected), 2 (withdrawn), 3 (objected to), 4 (cancelled), and 5 (allowed)). A cancelled claim need not be reproduced.

(q) [Reserved.]

(r) *Claim support and drawing analysis section.* For each independent claim involved in the appeal and each dependent claim argued separately (see paragraph (o)(1) of this section), the claim support and drawing analysis section in the appendix shall consist of an annotated copy of the claim (and, if necessary, any claim from which the claim argued separately depends) indicating in boldface between braces ( { } ) the page and line or paragraph after each limitation where the limitation is described in the specification as filed. If there is a drawing or amino acid or nucleotide material sequence, and at least one limitation is illustrated in a drawing or amino acid or nucleotide material sequence, the “claims support and drawing analysis section” in the appendix shall also contain in boldface between the same braces ( { } ) where each limitation is shown in the drawings or sequence.

(s) *Means or step plus function analysis section.* For each independent claim involved in the appeal and each dependent claim argued separately (see paragraph (o)(1) of this section) having 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, for each such limitation, the “means or step plus function analysis section” in the appendix shall consist of an annotated copy of the claim (and, if necessary, any claim from which the claim argued separately depends) indicating in boldface 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.

(t) *Evidence section.* The “evidence section” shall contain only papers which have been entered by the examiner. The evidence section shall include:

(1) [Reserved.]

(2) [Reserved.]

(3) [Reserved.]

(4) [Reserved.]

(5) Affidavits and declarations.

Affidavits and declarations, if any, and attachments to declarations, before the examiner and which are relied upon by appellant in the appeal. An affidavit or declaration otherwise mentioned in the appeal brief which does not appear in the evidence section will not be considered.

(6) Other evidence filed prior to the notice of appeal. Other evidence, if any, before the examiner and filed prior to the date of the notice of appeal and relied upon by appellant in the appeal. Other evidence filed before the notice of

appeal that is otherwise mentioned in the appeal brief and which does not appear in the evidence section will not be considered.

(7) Other evidence filed after the notice of appeal. Other evidence relied upon by the appellant in the appeal and admitted into the file pursuant to § 41.33(d) of this subpart. Other evidence filed after the notice of appeal that is otherwise mentioned in the appeal brief and which does not appear in the evidence section will not be considered.

(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.

10. Revise § 41.39 to read as follows:

#### **§ 41.39 Examiner’s answer.**

(a)(1) *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 may enter an examiner’s answer responding to the appeal brief.

(2) *New ground of rejection.* An examiner’s answer may include a new ground of rejection.

(b) *Response to new ground of rejection.* If an examiner’s answer contains a rejection designated as a new ground of rejection, appellant shall within two months from the date of the examiner’s answer exercise one of the following two options to avoid dismissal of the appeal as to the claims subject to the new ground of rejection:

(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 relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request under this paragraph will be treated as a request to dismiss the appeal.

(2) Request to docket the appeal. Request that the Board docket the appeal (see § 41.35(a) of this subpart) and file a reply brief as set forth in § 41.41 of this subpart. Such a reply brief must address each new ground of rejection. A reply brief may not be accompanied by any amendment or evidence. If a reply brief filed pursuant to this section is accompanied by any amendment or evidence, it shall be treated as a request to reopen prosecution under paragraph (b)(1) of this section.

(c) *Extension of time to file reply brief.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

(d) *No supplemental examiner's answer.* The examiner shall not enter a supplemental examiner's answer in response to any reply brief filed under §§ 41.39(b)(2) and/or 41.41.

11. 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.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

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

- (1) [Reserved.]
- (2) [Reserved.]
- (3) [Reserved.]
- (4) [Reserved.]

(5) *Argument*—see paragraph (g) of this section.

(e) [Reserved.]

(f) [Reserved.]

(g) *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.

(h) [Reserved.]

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

#### § 41.43 [Removed]

12. Remove § 41.43.

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 part.

(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.

(d) *Extension of time to file request for oral hearing.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

(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) [Reserved.]

(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 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 paragraph (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 documents or artifacts in the Record or a model or an exhibit presented for demonstration purposes during an interview with the examiner. At the oral hearing, appellant shall provide one copy of each visual aid (photograph in the case of an artifact, a model or an exhibit) for each judge and one copy to be added to 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 Chief Administrative Patent Judge may remand an application to the examiner. If in response to a remand for further consideration of a rejection, the examiner enters an 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 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 re-docket 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 ground of rejection.* Should the Board have a basis not involved in the appeal for rejecting any pending claim, it may enter a new ground of rejection. A new ground of rejection shall be considered an interlocutory order and shall not be considered a final decision. 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:

(1) *Reopen prosecution.* Submit an amendment of the claims subject to a new ground of rejection or new evidence relating to the new ground of 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 ground of rejection by the Board is binding on the examiner unless, in the opinion of the examiner, the amendment or new evidence overcomes the new ground of rejection. In the event the examiner maintains the new ground of 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.

(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, upon return of the application or reexamination proceeding to the jurisdiction of the examiner, may enter a new ground of 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 under the provisions of § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

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 mailed by the Board.

(c) *Extension of time to file request for rehearing.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

(d) *Content of request for rehearing.* A request for rehearing must contain, under appropriate headings and in the order indicated, the following items:

(1) [Reserved.]

(2) [Reserved.]

(3) [Reserved.]

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

(e) [Reserved.]

(f) *Argument.* A request for rehearing shall state with particularity the points believed to have been misapprehended or overlooked by the Board. A general restatement of the case will not be considered an argument that the Board has misapprehended or overlooked a point. A new argument cannot be made in a request for rehearing, except:

(1) New ground of rejection.

Appellant may respond to a new ground of 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.* The Director may impose a sanction 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 docket 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) [Reserved.]

(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: December 14, 2009.

**David J. Kappos,**

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

[FR Doc. E9-30402 Filed 12-21-09; 8:45 am]

**BILLING CODE P**

## DEPARTMENT OF TRANSPORTATION

### Pipeline and Hazardous Materials Safety Administration

#### 49 CFR Parts 105, 107, 171, 173, 174, 176, 177, and 179

[Docket No. PHMSA-2009-0289 (HM-233A)]

RIN 2137-AE39

### Hazardous Materials: Incorporation of Special Permits Into Regulations

**AGENCY:** Pipeline and Hazardous Materials Safety Administration (PHMSA), DOT.

**ACTION:** Notice of proposed rulemaking (NPRM).

**SUMMARY:** The Pipeline and Hazardous Materials Safety Administration is proposing to amend the Hazardous