

Appealing to Higher Power

(Proposed Rule Changes for Appeals)



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

- On August 21, 2007 New Proposed Appeal Rules were Published in the Official Gazette at 1321 Off. Gaz. Pat. Office 95 (August 21, 2007)



- ◆ The Notable Changes In The Proposed Rules Are:
 - (1) providing additional delegated authority from the Director to the Chief Administrative Patent Judge to decide certain petitions authorized by Part 41 as proposed, including requests for extension of time to file certain papers after the appeal brief and requests to enlarge the page limit on certain appeal papers;
 - (2)* defining the record on appeal to clarify what documents the Board will consider in resolving the appeal;
 - (3) requiring the notice of appeal to be signed;
 - (4)* providing a definition of non-appealable issues;

◆ (Items marked with an asterisk (*) are discussed in further detail below)

- ◆ The Notable Changes In The Proposed Rules Are: (Con't)
 - (5) changing the format and content of the appeal brief to require the following additional sections:
 - ◆ (a)* jurisdictional statement,
 - ◆ (b) table of contents,
 - ◆ (c) table of authorities,
 - ◆ (d) *statement of facts,
 - (6) *identify where arguments were previously presented to the examiner;
 - (7) changing the format and content of the appeal brief appendix to include the following additional sections:
 - ◆ (a) *claim support section,
 - ◆ (b) *drawing analysis section,
 - ◆ (c) *means or step plus function analysis section, and
 - ◆ (d) *an expanded evidence section to include, inter alia, relevant Office action(s) and portions of papers filed by appellant during prosecution;
 - (8) *providing page limits for all briefs (25 pages);
 - (9) prohibiting incorporation by reference in briefs;

- ◆ The Notable Changes In The Proposed Rules Are: (Con't)
 - (10) establishing a format for a reply brief to include:
 - ◆ (a) table of contents,
 - ◆ (b) table of authorities,
 - ◆ (c) statement of timeliness,
 - ◆ (d) statement of facts in response to a new ground of rejection in examiner's answer,
 - ◆ (e) argument, and where appropriate,
 - ◆ (f) supplemental appendix;
 - (11) providing for a supplemental reply brief, if a supplemental examiner's answer is furnished by the examiner;
 - (12) establishing a format for a supplemental reply brief to include:
 - ◆ (a) table of contents,
 - ◆ (b) table of authorities,
 - ◆ (c) statement of timeliness, and
 - ◆ (d) argument;
 - (13) *providing sanctions to be imposed on the appellant for misconduct during prosecution of the appeal.

(2) Defining The Record On Appeal To Clarify What Documents The Board Will Consider In Resolving The Appeal;

- ◆ 37 C.F.R. §41.30 Definitions. Record on Appeal includes:
 - Specification, drawings,
 - U.S. patents/Publications cited by the examiner or appellant,
 - Appeal brief, examiner's answer, reply brief, supplemental examiner's answer, supplemental reply brief,
 - Request for rehearing,
 - Any order or decision entered by the Board or the Chief Administrative Patent Judge, and
 - Any other document or evidence which was considered by the Board as indicated in any opinion accompanying any order or decision.

(4) Providing A Definition Of Non-appealable Issues;

- ◆ 37 C.F.R. §41.31
- ◆ A non-appealable issue is an issue not subject to an appeal under 35 U.S.C. 134.
- ◆ Non-appealable issues are issues (1) over which the Board does not exercise authority in appeal proceedings and (2) which are handled by a petition.
- ◆ Non-appealable issues include such matters as an examiner's refusal to:
 - (1) enter a response to a final rejection,
 - (2) enter evidence presented after a final rejection,
 - (3) enter an appeal brief or a reply brief, or
 - (4) withdraw a restriction requirement.
- ◆ The proposed rules contemplate that some petitions relating to non-appealable issues are to be decided by the Chief Administrative Patent Judge. Some of those non-appealable issues include:
 - (1) a petition to exceed page limit and
 - (2) a petition to extend time for filing a paper in the appeal after the filing of the appeal brief.
- ◆ Failure to timely file a petition seeking review of a decision of the examiner related to a non-appealable issue may constitute a waiver to have that issue considered.

(5(a)) Jurisdictional Statement

- ◆ 37 C.F.R. §41.37(e)(3)
- ◆ The "jurisdictional statement" shall establish the jurisdiction of the Board to consider the appeal.
- ◆ The jurisdictional statement shall include
 - a statement of the statute under which the appeal is taken,
 - the date of the decision from which the appeal is taken,
 - the date the notice of appeal was filed, and
 - the date the appeal brief is being filed.
 - If a notice of appeal or an appeal brief is filed after the time specified, appellant must also indicate the date an extension of time was requested and, if known, the date the request was granted.

(5(d)) Statement of Facts

- ◆ 37 C.F.R. §41.37(e)(9)
- ◆ The statement of facts shall set out in an objective and non-argumentative manner the material facts relevant to the rejections on appeal.
- ◆ A fact shall be supported by a reference to a specific page number and, where applicable, a specific line or drawing numerals of the record on appeal.
- ◆ A general reference to a document as a whole or to large portions of a document does not comply with the requirements of this rule.

(6) Statements of Previously Made Arguments

- ◆ 37 C.F.R. § 41.37(o)(3)
- ◆ When responding to points made in the final rejection, the appeal brief shall specifically:
 - (1) identify each point made by the examiner and
 - (2) indicate where appellant previously responded to each point.
- ◆ In supporting any argument, the appellant shall refer to a page and, where appropriate a line, in the evidence section of the appendix, specification, drawings (if any), U.S. patents, and published U.S. applications.
- ◆ Examples of argument formats that would be acceptable are provided.

(7(a)) Claim Support Section

- ◆ 37 C.F.R. §41.37(q)
- ◆ Claim support section is part of the appendix
- ◆ The claim support section replaces the concise explanation of the subject matter
- ◆ For each claim argued separately, required is an annotated copy of the claim indicating in bold face between braces ({ }) after each limitation where, by page and line numbers, the limitation is described in the specification as filed.
- ◆ Braces ({ }) are used instead of brackets [] because brackets are used in reissue claim practice.

(7(b)) Drawing Analysis Section

- ◆ 37 C.F.R. §41.37(r)
- ◆ Drawing analysis section is part of the appendix
- ◆ For each claim argued separately, the drawing analysis section would consist of an annotated copy of the claim in numerical sequence, indicating in bold face between braces (**{ }**) after each limitation where, by reference or sequence residue number, each limitation is shown in the drawing or sequence.
- ◆ A drawing analysis has been required in interference cases since 1998 and has proven useful to the Board in understanding claimed inventions described in applications and patents involved in an interference.

(7(c)) Means Or Step Plus Function Analysis Section

- ◆ 37 C.F.R. §41.37(s)
- ◆ Means or step plus function analysis section is part of the appendix
- ◆ The means or step plus function analysis section would replace the requirement relating to identification of structure, material or acts for means or step plus function claims limitations contained in appealed claims.
- ◆ The means or step plus function analysis section would include each claim argued separately that contains a limitation that appellant regards as a means or step plus function limitation in the form permitted by the sixth paragraph of 35 U.S.C. 112.
- ◆ Further, for each such claim, a copy of the claim would be reproduced indicating in bold face between braces ({}) the specific portions of the specification and drawing that describe the structure material or acts corresponding to each claimed function
- ◆ If the appealed claims do not contain any means or step plus function limitations, the section would state that there is no means or step plus function limitation in any claim on appeal.

(7(d)) Expanded Evidence Section

- ✦ 37 C.F.R. §41.37(s)
- ✦ Evidence section is part of the appendix
- ✦ The evidence section shall include:
 - (1) A table of contents.
 - (2) The Office action setting out the rejection on appeal.
 - ✦ If the Office action incorporates by reference any other Office action, then the Office action incorporated by reference shall also appear in the evidence section.
 - (3) All evidence relied upon by the examiner in support of the rejection on appeal (including non-patent literature and foreign application and patent documents), except the specification, any drawings, U.S. patents or published U.S. applications.
 - (4) The relevant portion of a paper filed by the appellant before the examiner which shows that an argument being made on appeal was made in the first instance to the examiner.
 - (5) Affidavits and declarations, if any, and attachments to declarations, relied upon by appellant before the examiner.
 - (6) Other evidence, if any, relied upon by the appellant before the examiner.

(8) 25 Page Limit

- ✦ 37 C.F.R. §41.37(v)(2) requires that text in an appeal brief would be double spaced except in headings, tables of contents, tables of authorities, signature blocks and certificates of service. Block quotations would be indented. Footnotes, which are discouraged, would have to be double spaced.
- ✦ 37 C.F.R. §41.37(v)(3) requires that margins shall be at least one inch (2.5 centimeters) on all sides.
- ✦ 37 C.F.R. §41.37(v)(4) requires that the font would be readable and clean and equivalent to 14 point Times New Roman, including the font for block quotations and footnotes.
- ✦ 37 C.F.R. §41.37(v)(5) provides that an appeal brief may not exceed 25 pages, excluding any (1) statement of the real party in interest, (2) statement of related cases, (3) table of contents, (4) table of authorities, (5) signature block and (6) appendix.

(13) Providing Sanctions To Be Imposed On The Appellant

- ◆ 37 C.F.R. §41.56(a) provides that a sanction could be imposed against an appellant for misconduct, including:
 - (1) failure to comply with an order entered in the appeal or an applicable rule,
 - (2) advancing or maintaining a misleading or frivolous request for relief or argument, or
 - (3) engaging in dilatory tactics.
- ◆ 37 C.F.R. §41.56(b) provides that the nature of possible sanctions, includes entry of
 - (1) an order declining to enter a docketing notice,
 - (2) an order holding certain facts to have been established in the appeal,
 - (3) an order expunging a paper or precluding an appellant from filing a paper,
 - (4) an order precluding an appellant from presenting or contesting a particular issue,
 - (5) an order excluding evidence,
 - (6) an order requiring a terminal disclaimer of patent term,
 - (7) an order holding an application on appeal to be abandoned or a reexamination proceeding terminated,
 - (8) an order dismissing an appeal,
 - (9) an order denying an oral hearing, or
 - (10) an order terminating oral hearing.

Searchable Appeal Decisions

- ◆ A text searching capability is now available for searching publicly available final decisions of the Board of Patent Appeals and Interferences that are posted on the Board's Final Decision FOIA web page, <http://des.uspto.gov/Foia/BPAIReadingRoom.jsp>.

Thank You!

