

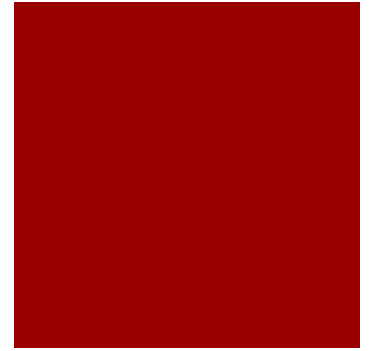


# Appeal Rules Update

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# Proposed Rule Changes

- Rule 41.31(c) proposes to revise the current rule so that an appeal, when taken, would be presumed to seek review of all of the claims under rejection unless canceled by an amendment filed by the appellant.
- Rule 41.40 would be added to allow appellants to file a petition to the Director under Rule 1.181 seeking review of the examiner's failure to designate a rejection as a new ground of rejection, if they feel that the examiner's answer contains a new ground of rejection that necessitates the filing of new amendments or new evidence.
  - a Rule 1.181 petition tolls the period for filing a reply brief



# Proposed Rule Changes

- Rule 41.37(c)(1)(i) would revise the current rule to allow the Board to assume, if the statement of real party in interest is omitted from the appeal brief, that the named inventors are the real party in interest
- Rule 41.37(c)(1)(ii) would be revised to limit the required disclosure of related appeals, interferences and judicial proceedings (collectively “related cases”) to only those which: (1) Involve an application or patent owned by the appellant or assignee, (2) are known to appellant, and (3) may have a bearing on the Board’s decision. The section would also be revised to permit appellants to omit the statement entirely if there are no such related cases, and to provide a default assumption for the Office in the event the statement is omitted.



# Proposed Rule Changes

- Proposed Bd.R. 41.37(c)(1)(iii) would omit the current requirement for the appeal brief to contain an indication of the status of claims.
- Proposed Bd.R. 41.37(c)(1)(iv) proposes to eliminate the current requirement to provide a statement of the status of any amendment filed subsequent to final rejection, and would require that appellants simply provide a statement identifying, by date of filing, the last entered amendment of the claims. The proposed rule also provides a default that the Office may assume no amendments to the claims exist if the appeal brief omits this statement.



# Proposed Rule Changes

- Rule 41.37(c)(1)(v) proposes to revise the current rule to require that the summary of claimed subject matter include an annotated copy of each rejected independent claim wherein the annotations would appear after each limitation in dispute by appellant and include a reference to the specification in the Record showing support for the claim language sufficient to allow the Board to understand the claim.
- Proposed Bd.R. 41.37(c)(1)(v) would require annotation only for those elements in dispute.



# Proposed Rule Changes

- Rule 41.37(c)(1)(vi) requires that the appeal brief include a statement of the grounds of rejection. The proposed rule eliminates the requirement for a statement of the grounds of rejection from the brief. Under Proposed Bd.R. 41.31(c), discussed supra, the Board would presume that all rejections made in the Office Action from which the appeal was taken are before it on appeal, unless appellant cancels the claim(s) subject to a particular rejection.
- Moreover, under Proposed Bd.R. 41.37(c)(1)(vii), discussed infra, the headings of the argument section of the brief shall reasonably identify the ground of rejection being contested. Therefore, it is unnecessary for the appeal brief to contain a separate statement of the grounds of rejection on appeal—a source of internal inconsistency in appeal briefs filed under the current rules.

# Proposed Rule Changes

- Rule 41.37(c)(1)(vii) proposes to revise the current rule to clarify that the argument section should specifically explain why the examiner erred as to each ground of rejection contested by appellants. The proposed revision would also provide that, except as provided for in Proposed Bd.R. 41.41, 41.47, and 41.52, any arguments not included in the appeal brief will not be considered by the Board “for purposes of the present appeal.” Additionally, Proposed Bd.R. 41.37(c)(1)(vii) would require that each ground of rejection argued be set forth in a separate section with a heading that reasonably identifies the ground being argued therein. Further, the proposed rule would require that any claim(s) argued separately or as a subgroup be placed under a separate subheading that identifies the claim(s) by number.
- The proposed rule in this NPRM omits the waiver language from the rule. Nonetheless, the case law supports the Office’s position on waiver, so despite the waiver language not being included in the rule, the Board will still treat as waived, for purposes of the present appeal, any arguments not raised by appellant



# Proposed Rule Changes

- Proposed Bd.R. 41.37(c)(1)(vii) also proposes to revise the current rule to clarify the proper use of headings and to require the use of subheadings in order to clearly set out the ground of rejection and the specific claims to which each argument presented applies.



# Proposed Rule Changes

- The proposed rule deletes Bd.R. 41.37(c)(1)(viii).Bd.R. 41.37(c)(1)(viii) and the ANPRM required appellants to include a claims appendix with the brief.
- The proposed rule deletes Bd.R. 41.37(c)(1)(ix).Bd.R. 41.37(c)(1)(ix) and the ANPRM required appellants to include an evidence appendix with the brief.
- The proposed rule deletes Bd.R. 41.37(c)(1)(x).Bd.R. 41.37(c)(1)(x) and the ANPRM required appellants to include a related proceedings appendix with the brief.



# Proposed Rule Changes

- Proposed Bd.R. 41.39(a)(1) proposes to revise the current rule to provide that the examiner's answer, by default, incorporates all the grounds of rejection set forth in the Office action which is the basis for the appeal, including any modifications made via advisory action or pre-appeal brief conference decision, except for any grounds of rejection indicated by the examiner as withdrawn in the answer. Proposed Bd.R. 41.39(a)(1) proposes to delete the requirement that the answer include an explanation of the invention claimed and of the grounds of rejection, since the Board would rely on appellant's specification and summary of claimed subject matter for an explanation of the invention claimed and would rely on the statement of the rejection(s) in the Office action from which the appeal is taken.



# Pre-Appeal Brief Statistics



## PRE-APPEAL BRIEF CONFERENCE EFFECTS: ACTIONS IN RESPONSE TO REQUEST FOR PRE-APPEAL BRIEF REVIEW

FY	Number of requests	Frequency of requests (percent)	Proceed to board (percent)	Prosecution reopened (percent)	All rejections withdrawn (percent)	Defective request (percent)
06 .....	6,525	24	55	37	5	3
07 .....	7,240	25	56	38	4	2
08 .....	8,255	27	59	37	2	2
09 .....	9,967	30	56	39	3	2
10 .....	12,019	34	56	38	5	1

## APPEAL CONFERENCE EFFECTS: ACTIONS IN RESPONSE TO APPEAL BRIEF

FY	Examiner's answer (percent)	Prosecution reopened (percent)	All rejections withdrawn (percent)	Other action (percent)
98 .....	58	12	29	1
99 .....	52	15	32	1
00 .....	46	21	32	1
01 .....	40	25	34	1
02 .....	38	26	34	1
03 .....	38	29	31	1
04 .....	39	32	27	2
05 .....	39	35	24	2
06 .....	49	30	19	2
07 .....	56	28	14	2
08 .....	59	28	12	1
09 .....	56	27	16	1
10 .....	59	23	17	1