

# Chapter 1200 Appeal

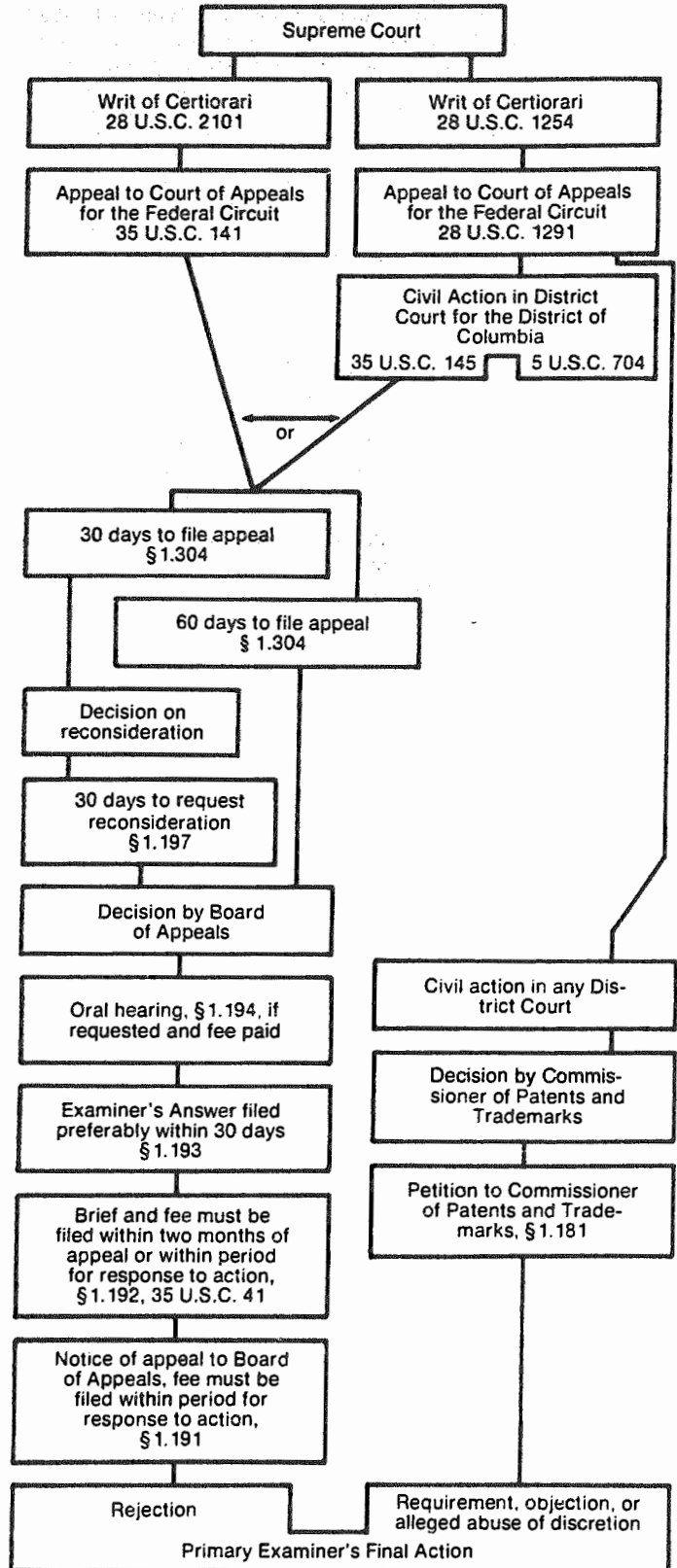
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## 1201 Introduction

The Patent and Trademark Office in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to merits, and appeal procedure within the Patent and Trademark Office and to the courts has long been provided by statute.

The line of demarcation between appealable matters for the Board of Appeals and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter. However, since 37 CFR 1.181(f) states that any petition not filed within two months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. Note *In re Hengehold*, 169 USPQ 473 (CCPA 1971).

## 1202 Channels of Ex Parte Review



### 1203 Composition of Board

35 U.S.C. 7 provides for a Board of Appeals as follows:

**35 U.S.C. 7 Board of Appeals.** The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, who shall be appointed under the classified civil service. The Commissioner, the deputy commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Appeals, which, on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents. Each appeal shall be heard by at least three members of the Board of Appeals, the members hearing such appeal to be designated by the Commissioner. The Board of Appeals has sole power to grant rehearings.

Whenever the Commissioner considers it necessary to maintain the work of the Board of Appeals current, he may designate any patent examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner-in-chief for periods not exceeding six months each. An examiner so designated shall be qualified to act as a member of the Board of Appeals. Not more than one such primary examiner shall be a member of the Board of Appeals hearing an appeal. The Secretary of Commerce is authorized to fix the per annum rate of basic compensation of each designated examiner-in-chief in the Patent and Trademark Office at not in excess of the maximum scheduled rate provided for positions in grade 16 of the General Schedule of the Classification Act of 1949, as amended. The per annum rate of basic compensation of each designated examiner-in-chief shall be adjusted, at the close of the period for which he was designated to act as examiner-in-chief, to the per annum rate of basic compensation which he would have been receiving at the close of such period if such designation had not been made.

If subsequent to the hearing, but prior to the decision, a Board member who heard the case becomes unable to participate in the decision for some reason, the applicant will be given the choice of having a rehearing or of having a different Board member substituted for the one who is incapacitated.

Should a member die or otherwise become unavailable (for example, retirement) to reconsider a decision, it is the Board's practice to have the remaining two Board members reconsider the case. However, if there is disagreement concerning the position of the Board on reconsideration, a third member may be designated as a substitute for the absent member.

### 1204 Administrative Handling

Ex parte appeals to the Board of Appeals, and all papers relating thereto, are forwarded to the examining group for docketing. All appeal papers, such as the notice of appeal, appeal brief and request for extension of time to file the brief are processed by the appropriate examining group.

The clerk in charge of handling appeals in the examining group is solely responsible for completion of all phases of appeal clerical procedure. All communications from the Board and all signed Office communications relating to appeals from the primary examiners should be given to the group appeals clerk.

To insure that all records are current, memorandum form PTO-262 is attached to the file wrapper when it is remanded by the Board of Appeals. It is important that this memorandum be promptly completed and forwarded by the group if the application is allowed, the prosecution is reopened, a continuation application is filed or if the appeal is discontinued for any other reason.

Complete clerical instructions appear in Chapter 700 of the Manual of Clerical Procedure.

If the brief is not filed within the time designated by 37 CFR 1.192, the clerk will notify the applicant that the appeal stands dismissed.

#### "SPECIAL" CASE

Subject alone to diligent prosecution by the applicant, and application for patent that once has been made special and advanced out of turn by the Commissioner or an Assistant Commissioner for examination will continue to be special throughout its entire course of prosecution in the Patent and Trademark Office, including appeal, if any, to the Board of Appeals.

A petition to make a case special after the appeal has been forwarded to the Board of Appeals may be addressed to the Board. However, no such petition will be granted unless the brief has been filed and applicant has made the same type of showing required by the Commissioner under 37 CFR 1.102. Therefore, diligent prosecution is essential to a favorable decision on a petition to make special.

### 1205 Notice of Appeal

**35 U.S.C. 134. Appeal to the Board of Appeals.** An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal.

*Extract from 35 U.S.C. 41, Patent fees.* (a) The Commissioner shall charge the following fees: 6. On appeal from the examiner to the Board of Appeals, \$115; in addition, on filing a brief in support of the appeal, \$115, and on requesting an oral hearing before the Board of Appeals, \$100.

**37 CFR 1.17 Patent application processing fees.**

	* * * * *	
(e) For filing a notice of appeal from the examiner to the Board of Appeals:		
By a small entity (§ 1.9(f)).....		\$57.50
By other than a small entity .....		115.00
(f) In addition to the fee for filing a notice of appeal, for filing a brief in support of an appeal:		
By a small entity (§ 1.9(f)).....		57.50
By other than a small entity .....		115.00
(g) For filing a request for an oral hearing before the Board of Appeals:		
By a small entity (§ 1.9(f)).....		50.00
By other than a small entity .....		100.00
	* * * * *	

**37 CFR 1.191. Appeal to Board of appeals.** (a) Every applicant for a patent or for reissue of a patent, or every owner of a patent under reexamination, any of the claims of which have been twice rejected, or who has been given a final rejection (§ 1.113), may, upon the payment of the fee set forth in § 1.17(e), appeal from the decision of the examiner to the Board of Appeals within the time allowed for response.

(b) The appeal in an application must identify the rejected claim or claims appealed, and must be signed by the applicant or duly authorized attorney or agent. An appeal in a reexamination proceeding must identify the rejected claim or claims appealed, and must be signed by the patent owner or duly authorized attorney or agent.

(c) Except as otherwise provided by § 1.206, an appeal when taken must be taken from the rejection of all claims under rejection which applicant or patent owner proposes to contest. Questions re-

lating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

An applicant or patent owner in a reexamination proceeding dissatisfied with the primary examiner's decision in the second or final rejection of his or her claims may appeal to the Board of Appeals for review of the examiner's rejection by filing a notice of appeal, signed by the applicant, patent owner or his or her attorney, and the required fee set forth in § 1.17(e).

The notice of appeal must be filed within the period for response set in the last Office action, which is normally three months for applications. See § 714.13. Failure to place an application in condition for allowance or to file an appeal after final rejection will result in the application becoming abandoned, even if one or more claims have been allowed except where claims suggested for interference have been copied. The Notice of Appeal and appropriate fee may be filed up to six months from the date of the final rejection, so long as an appropriate petition and fee for an extension of time is filed either prior to or with the Notice of Appeal. Failure to file an appeal in a reexamination proceeding will result in issuance of the certificate under § 1.570.

Section 1.191 provides for appeal to the Board of Appeals by the patent owner from any decision in a reexamination proceeding adverse to patentability, in accordance with 35 U.S.C. 306. See also § 2273.

The use of a separate letter containing the notice of appeal is strongly recommended. The wording of the letter could be as follows:

NOTICE OF APPEAL FROM THE PRIMARY EXAMINER TO THE BOARD OF APPEALS

In re application of:
Serial or Patent No:
For:
Filed:
Group Art Unit:
To Commissioner of Patents and Trademarks
Sir:

Applicant or patent owner hereby appeals to the Board of Appeals from the decision dated ..... of the Examiner finally rejecting claims .....

The item(s) checked below are appropriate:

- 1. [ ] An extension of time to respond to the final rejection was obtained on ..... for ..... months(s).
2. [ ] Fee amount .....
[ ] Enclosed
[ ] Not required (Fee paid in prior appeal.)
[ ] Charge to Deposit Account No. ....
(One additional copy of this Notice is enclosed herewith.)

(Signature (37 CFR 1.191(b))

(Correspondence address)

MATTERS HANDLED CONCURRENTLY WITH APPEAL

37 CFR 1.206 permits partial appeal in cases where there are both finally rejected claims copied from a patent and other claims not ready for appeal. See §§ 1210 and 1101.02(f).

Ex parte prosecution of an appeal under 37 CFR 1.191 may proceed concurrently with an interference

proceeding involving the same application provided the primary examiner who forwards the appeal certifies, in a memorandum to be placed in the file, that the subject matter of the interference does not conflict with the subject matter of the appeal claims. See 37 CFR 1.202, § 1103.

The Patent and Trademark Office does not acknowledge receipt of a Notice of Appeal by separate letter. However, if a self-addressed Post Card is included with the Notice of Appeal, it will be date stamped and mailed.

Form Paragraphs 12.01-12.07 may be used to indicate defects in a Notice of Appeal.

12.01 Notice of appeal unacceptable—fee unpaid

The Notice of Appeal filed on [1] is not acceptable because the appeal fee required under 35 U.S.C. 41(a)(6) was not filed, or was not timely filed. Applicant may obtain an extension of time under 37 CFR 1.136(a) to file the Notice of Appeal and the appropriate fee. The date on which the Notice of Appeal, the appeal fee, the petition under 37 CFR 1.36(a), and the petition fee are filed will be the date of the response and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant respond later than the maximum six months statutory period or obtain an extension for more than four months beyond the date of response set in an Office action.

12.02 Notice of appeal unacceptable—no 2nd rejection

The Notice of Appeal filed on [1] is not acceptable because there has been no second or final rejection in this application, as required under 37 CFR 1.191.

12.03 Notice of appeal unacceptable—not timely filed

The Notice of Appeal filed on [1] is not acceptable because it was filed after the expiration of the period set in the prior Office action. This application will become abandoned unless applicant obtains an extension under 37 CFR 1.136(a). The date on which the Notice of Appeal, the appeal fee, the petition under 37 CFR 1.136(a), and the petition fee are filed will be the date of the response and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant respond later than the maximum six months statutory period or obtain an extension for more than four months beyond the date of response set in an Office action.

12.04 Notice of appeal unacceptable—claims allowed

The Notice of Appeal filed [1] is not acceptable because a letter of allowability was mailed by the Office on [2].

12.05 Notice of appeal defective—unsigned

The Notice of Appeal filed on [1] is defective because it is unsigned. A Ratification, properly signed, is required.

APPLICANT IS GIVEN A TIME LIMIT OF ONE MONTH FROM THE DATE OF THIS LETTER OR UNTIL THE EXPIRATION OF THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION, WHICHEVER IS LONGER, WITHIN WHICH TO MAKE THE NECESSARY CORRECTION TO AVOID DISMISSAL OF THE APPEAL. NO EXTENSION OF THE ONE MONTH TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b).

12.06 Notice of appeal defective—claims unidentified

The Notice of Appeal filed on [1] is defective because it fails to identify the appealed claims(s) as required under 37 CFR 1.191(b).

APPLICANT IS GIVEN A TIME LIMIT OF ONE MONTH FROM THE DATE OF THIS LETTER OR UNTIL THE EXPIRATION OF THE RESPONSE PERIOD SET IN THE LAST OFFICE ACTION, WHICHEVER IS LONGER, WITHIN WHICH TO MAKE THE NECESSARY CORRECTION TO AVOID DISMISSAL OF THE APPEAL. NO EXTENSION OF THE ONE MONTH TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136 (a) OR (b).

*12.07 Notice of Appeal defective—other reasons*

The Notice of Appeal filed on [1] is defective because [2].

**APPLICANT IS GIVEN A TIME LIMIT OF ONE MONTH FROM THE DATE OF THIS LETTER OR UNTIL THE EXPIRATION OF THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION, WHICHEVER IS LONGER, WITHIN WHICH TO MAKE THE NECESSARY CORRECTION TO AVOID DISMISSAL OF THE APPEAL. NO EXTENSION OF THE ONE MONTH TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136 (a) OR (b).**

**1206 Appeal Brief**

*37 CFR 1.192. Appellant's brief. (a)* The appellant shall, within 2 months from the date of the notice of appeal under § 1.191 in an application, reissue application, or patent under reexamination, or within the time allowed for response to the action appealed from, if such time is later, file a brief in triplicate. The brief must be accompanied by the requisite fee set forth in § 1.17(f) and must set forth the authorities and arguments on which the appellant will rely to maintain his appeal. The brief must include a concise explanation of the invention which should refer to the drawing by reference characters, and a copy of the claims involved. The time periods set forth herein are subject to the provisions of § 1.136.

(b) On failure to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed.

Where the brief is not filed, but within the period allowed for filing the brief an amendment is presented which places the case in condition for allowance, the amendment may be entered since the application retains its pending status during said period. Amendments should not be included in the appeal briefs. Amendments should be filed as separate papers. See §§ 1207, 1215.01 and 1215.02.

The copy of the claims required in the brief should be a clean copy and should not include any brackets or underlining as required by 37 CFR 1.121(b).

Section 1.192 provides two months from the date of the Notice of Appeal for the patent owner to file an appeal brief in a reexamination proceeding. In a reexamination proceeding, the time period can be extended only under the provisions of § 1.550(c). See also § 2274.

**TIME FOR FILING APPEAL BRIEF**

The usual period of time in which appellant must file his or her brief is two months from the date of appeal. However, 37 CFR 1.192 alternatively permits the brief to be filed "within the time allowed for response to the action appealed from, if such time is later". These time periods may be extended under 37 CFR 1.136(a), and if § 1.136(a) has been exhausted, § 1.136(b).

In the event that the appellant finds that he or she is unable to file a brief within the time allotted by the rules, he or she may file a petition, with fee, to the examining group, requesting additional time under § 1.136(a). Additional time in excess or four months, will not be granted, unless extraordinary circumstances are involved under § 1.136(b). The time extended is added to the calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday or Federal holiday.

If after an appeal has been filed, but prior to the date for submitting a brief, an interference is declared,

appellant's brief need not be filed until two months after either the non-appealable decision of the Patent Interference Examiner or the expiration of the time for appealing from the Patent Interference Examiner's appealable decision, the decision of the Board of Patent Interferences or from any subsequent decision of a reviewing court. If a petition for reconsideration is filed, there is a 30 day appeal limit following the decision on petition. In the event that a seasonable petition to the Commissioner is filed with respect to the Patent Interference Examiner's decision, a 30 day period begins with the mailing of the decision on the petition. See §§ 1109.01 and 1109.02.

Likewise, when an application is revived after abandonment for failure on the part of the appellant to make appropriate action after final rejection, and the petition to revive was accompanied by a Notice of Appeal, appellant has two months, from the mailing date of the Commissioner's affirmative decision on the petition, in which to file the appeal brief.

With the exception of the institution of an interference or suggestion and timely copying of claims for an interference, the appeal ordinarily will be dismissed if the brief is not filed within the period provided by 37 CFR 1.192(a) or within such additional time as may be properly extended.

Attention is directed to the fact that a brief must be filed to preserve appellant's right to the appealed claims, notwithstanding circumstances such as:

(1) the possibility or imminence of an interference involving the subject application, but not resulting in withdrawal of the final rejection prior to the brief's due date;

(2) the filing of a petition for supervisory action under 37 CFR 1.181;

(3) the filing of an amendment, even if it is one which the examiner previously has indicated may place one or more claims in condition for allowance, unless the examiner, in acting on the amendment, disposes of all issues on appeal;

(4) the receipt of a letter from the examiner stating that prosecution is suspended, without the examiner either withdrawing the final rejection from which appeal has been taken, instituting an interference with the subject application or suggesting claims for an interference.

Although failure to file the brief within the permissible time will result in dismissal of the appeal, if any claims stand allowed, the application does not become abandoned by the dismissal, but is returned to the examiner for action on the allowed claims. See § 1215.04. If there are no allowed claims, the case is abandoned as of the date the brief was due. In a reexamination proceeding failure to file the brief will result in the issuance of the certificate under § 1.570.

If the time for filing a brief has passed and the application has consequently become abandoned, the applicant may petition to revive the application, as in other cases of abandonment, and to reinstate the appeal; if the appeal is dismissed, but the application is not abandoned, the petition would be to reinstate the



claims and the appeal, but a showing equivalent to that in a petition to revive under 37 CFR 1.137 is required. See § 1215.04. In either event, a proper brief must be filed before the petition will be considered on its merits.

Where the dismissal of the appeal is believed to be a mistake resulting from inadvertence, filing a petition, pointing out the error, may be sufficient.

#### APPEAL BRIEF

A fee under § 1.17(f) is required when the brief is filed for the first time in a particular application, 37 CFR 1.192 provides that the appellant shall file a brief of the authorities and arguments on which he or she will rely to maintain his or her appeal, including a concise explanation of the invention which should refer to the drawing by reference characters, and a copy of the claims involved. 37 CFR 1.192(a) requires the submission of three copies of the appeal brief.

For sake of convenience, the copy of the claims involved should be double spaced.

The brief, as well as every other paper relating to an appeal, should indicate the number of the examining group to which the application or patent under re-examination is assigned and the serial number. When the brief is received, it is forwarded to the group where it is entered in the file, and referred to the examiner.

Appellants are reminded that their briefs in appealed cases must be responsive to every ground of rejection stated by the examiner, including new grounds stated in his or her answer.

Where an appellant fails to respond by way of brief or reply brief to any ground of rejection, and it appears that the failure is inadvertent, appellant shall be notified by the examiner that he or she is allowed one month to correct the defect by filing a supplemental brief. Where this procedure has not been followed, the Board of Appeals should remand the application to the examiner for compliance. When the record clearly indicates intentional failure to respond by brief to any ground of rejection, for example, by failure to file a supplemental brief within the one-month period allowed for that purpose, the examiner should inform the Board of Appeals of this fact in the answer and merely specify the claims affected.

Where the failure to respond by brief appears to be intentional, the Board of Appeals may dismiss the appeal as to the claims involved. Oral argument at a hearing will not remedy such deficiency of a brief.

The mere filing of any paper whatever entitled as a brief cannot necessarily be considered a compliance with 37 CFR 1.192. The rule requires that the brief must set forth the authorities and arguments relied upon and to the extent that it fails to do so with respect to any ground of rejection, the appeal as to that ground may be dismissed. It is essential that the Board of Appeals should be provided with a brief fully stating the position of the applicant with respect to each issue involved in the appeal so that no search of the record is required in order to determine that position. The fact that appellant may consider a

ground to be clearly improper does not justify a failure to point out to the Board the reasons for that belief.

A distinction must be made between the lack of any argument and the presentation of arguments which carry no conviction. In the former case dismissal is in order, while in the latter case a decision on the merits is made, although it may well be merely an affirmation based on the grounds relied on by the examiner.

Appellant must traverse every ground of rejection set forth in the final rejection. Oral argument at the hearing will not remedy such a deficiency in the brief. Ignoring or acquiescing in any rejection, even one based upon formal matters which could be cured by subsequent amendment, will invite a dismissal of the appeal as to the claims affected. If this involves all of the claims, the proceedings in the case are considered terminated as of the date of the dismissal. Accordingly, any application filed thereafter will not be copending with the application on appeal. If in his or her brief, appellant relies on some reference, he or she is expected to provide the Board with at least one copy of it.

Once the brief has been filed, a petition to suspend proceedings may be considered on its merits, but will be granted only in exceptional cases, such as where the writing of the examiner's answer would be fruitless or the proceedings would work a hardship on the appellant.

For reply brief see § 1208.01.

Form Paragraphs 12.08-12.17 may be used in letters concerning the appeal brief.

#### 12.08 Appeal dismissed—fee unpaid, no allowed claims

The appeal under 37 CFR 1.191 is dismissed because the fee for filing the Brief, as required under 35 U.S.C. 41(a)(6), was not submitted or timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136 has expired.

As a result of this dismissal, the application is ABANDONED since there are no allowed claims.

#### 12.09 Appeal dismissed—fee unpaid, allowed claims

The appeal under 37 CFR 1.191 is dismissed because the fee for filing the Brief, as required under 35 U.S.C. 41(a), was not submitted or timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136 has expired.

As a result of this dismissal, the application is returned to the examiner for disposition since it contains allowed claims. Prosecution on the merits remains CLOSED.

#### 12.10 Extension to file brief—granted

The request for an extension of time under 37 CFR 1.136(b) for filing the Appeal Brief under 37 CFR 1.192 filed on [1] has been approved for [2].

#### 12.11 Extension to file brief—denied

The request for an extension of time under 37 CFR 1.136(b) for filing the Appeal Brief under 37 CFR 1.192 filed on [1] has been disapproved because no sufficient cause for the extension has been shown.

#### 12.13 Brief defective—three copies lacking

The Appeal Brief filed on [1] is defective because the three copies of the Brief required under 37 CFR 1.192(a) have not been submitted.

APPLICANT IS GIVEN A TIME LIMIT OF ONE MONTH FROM THE DATE OF THIS LETTER OR UNTIL THE EXPIRATION OF THE RESPONSE PERIOD SET IN THE LAST

**OFFICE ACTION, WHICHEVER IS LONGER, TO SUPPLY THE NECESSARY COPIES TO AVOID DISMISSAL OF THE APPEAL. NO EXTENSION OF THIS ONE MONTH TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136 (a) OR (b).**

#### 12.14 Brief defective—lacks copy of claims

The Appeal Brief filed on [1] is defective because a copy of the appealed claim(s) has not been provided.

**APPLICANT IS GIVEN A TIME LIMIT OF ONE MONTH FROM THE DATE OF THIS LETTER OR UNTIL THE EXPIRATION OF THE RESPONSE PERIOD SET IN THE PRIOR ACTION, WHICHEVER IS LONGER, WITHIN WHICH TO SUPPLY THE COPY OF THE APPEALED CLAIMS TO AVOID DISMISSAL OF THE APPEAL. NO EXTENSION OF THE ONE MONTH TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136 (a) OR (b).**

#### 12.15 Brief defective—other reasons

The Appeal Brief filed on [1] is defective because [2]. **APPLICANT IS GIVEN A TIME LIMIT OF ONE MONTH FROM THE DATE OF THIS LETTER OR UNTIL THE EXPIRATION OF THE RESPONSE PERIOD SET IN THE PRIOR ACTION, WHICHEVER IS LONGER, WITHIN WHICH TO SUPPLY THE INDICATED CORRECTION TO AVOID DISMISSAL OF THE APPEAL. NO EXTENSION OF THE ONE MONTH TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136 (a) OR (b).**

##### Examiner Note:

The second bracket should discuss the specific defect in the Brief, such as failure of appellant to argue or discuss a rejection, or other omissions.

#### 12.16 Brief unacceptable—fee unpaid

The Appeal Brief filed on [1] is unacceptable because the fee required under 37 CFR 1.17(f) was not timely filed. This application will become abandoned unless applicant obtains an extension of time under 37 CFR 1.136(a) to file the Appeal Brief. The date on which the Brief, the fee for filing the Brief, the petition under 37 CFR 1.136(a), and the petition fee are filed will be the date of the response and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant obtain an extension under 37 CFR 1.136(a), for more than four months beyond the two month period originally set for filing the Brief.

#### 12.17 Brief unacceptable—not timely filed

The Appeal Brief filed on [1] is unacceptable because it was filed after the expiration of the required period for response. This application will become abandoned unless applicant obtains an extension of time under 37 CFR 1.136(a). The date on which the Brief, the fee for filing the Brief, the petition under 37 CFR 1.136(a), and the petition fee are filed will be the date of the response and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant respond later than the maximum six month statutory period or obtain an extension for more than four months beyond the date of response originally set for filing the Brief.

## 1207 Amendment Filed With or After Appeal

To expedite the resolution of cases under final rejection, an amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal provided the total effect of the amendment is to (1) remove issues from appeal, and/or (2) adopt examiner suggestions. Of course, if the amendment necessitates a new search, raises the issue of new matter, presents additional claims without cancelling a corresponding number of finally rejected claims, or otherwise introduces new issues, it will not be entered. Examiners must respond to all non-entered amendments after final rejection, and indicate the status of each claim of

record or proposed, including the designation of claims that would be entered on the filing of an appeal if filed in a separate paper. It should be noted that an amendment placing a case in condition for allowance will be enterable by the examiner at any stage prior to forwarding the answer on appeal. Except where an amendment merely cancels claims and/or adopts examiner suggestions, removes issues from appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b) will be expected of all amendments after final rejection.

If after appeal has been taken, a paper is presented which *on its face* clearly places the application in condition for allowance, such paper should be entered and a notice of allowability (PTOL-327) or an examiner's amendment promptly sent to applicant.

In accordance with the above, the brief must be directed to the claims and to the record of the case as they appeared at the time of the appeal, but it may, of course, withdraw from consideration on appeal any claims or issues as desired by applicant.

A timely filed brief will be referred to the examiner for his consideration of its propriety as to the appeal issues and for preparation of an examiner's answer if the brief is proper and the application is not allowable. The examiner's answer will normally be of the shortened type referring to and relying on the final action; it may withdraw rejection of claims or any objection or requirement as desired by the examiner. Note § 1201. No new ground of rejection or objection should be incorporated in the examiner's answer *without express approval in each case by the supervisory primary examiner*. See § 1002.02(d)(3) and 1208.01. See § 714.13 for procedure on handling amendments filed after final action and before appeal.

## 1208 Examiner's Answer

**37 CFR 1.193. Examiner's answer.** (a) The primary examiner may, within such time as may be directed by the Commissioner, furnish a written statement in answer to the appellant's brief including such explanation of the invention claimed and of the references and grounds of rejection as may be necessary, supplying a copy to the appellant. If the primary examiner shall find that the appeal is not regular in form or does not relate to an appealable action, he shall so state and a petition from such decision may be taken to the Commissioner as provided in § 1.181.

(b) The appellant may file a reply brief directed only to such new points of argument as may be raised in the examiner's answer, within twenty days from the date of such answer. However, if the examiner's answer states a new ground of rejection appellant may file a reply thereto within two months from the date of such answer; such reply may include any amendment or material appropriate to the new ground.

(c) Any decision pursuant to § 1.56(d) rejecting claims in an application already under appeal of a rejection based on other grounds shall constitute a supplemental examiner's answer introducing a new ground of rejection and removing the suspension of the appeal introduced pursuant to § 1.56(e), in which case appellant may file a reply thereto within two months from the date of the supplemental examiner's answer. Such reply will be considered and responded to as necessary. Appellant may file a reply brief directed to any such response within one month of the date of the response or within such other time as may be set in the response.

## APPEAL CONFERENCE

Appealed cases in which the brief has been filed may be reviewed by conference in the group, those participating being (1) a primary examiner, (2) the examiner charged with preparation of the examiner's answer and (3) another examiner, known as the conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal.

Non-examining time is allowed for all examiners participating in an appeal conference. This includes the examiner whose application or reexamination proceeding is being reviewed during the conference.

The group director has the discretion as to whether or not appeal conferences are necessary in his group and, if so, in which instances they are to be held.

If a conference is held, the primary examiner responsible for signing the examiner's answer should weigh the arguments of the other examiners but it is his responsibility to make the final decision. During the conference, consideration should be given to the possibility of dropping cumulative art rejections and eliminating technical rejections of doubtful value.

On the examiner's answer, the third person (conferee) should place his or her initials below those of the examiner who prepared the answer, thus: ABC (conf.). This does not indicate, necessarily, concurrence with the position taken in the answer.

If the examiner charged with the responsibility of preparing the answer reaches the conclusion that the appeal should not be forwarded and the primary examiner approves, no conference is held.

Before preparing the answer, the examiner should make certain that all amendments approved for entry, including those to the drawing, have in fact been physically entered. The clerk of the board will return to the group any application in which approved amendments have not been entered.

## ANSWER

The examiner should furnish the appellant with a written statement in answer to the appellant's brief within 2 months after the filing of the brief.

The answer should contain a response to the allegations or arguments in the brief and should call attention to any errors in appellant's copy of the claims. Grounds of rejection not argued in the examiner's answer are usually treated as having been dropped, but may be considered by the Board if it desires to do so. The examiner should treat affidavits, declarations or exhibits in accordance with 37 CFR 1.195, reporting his or her conclusions only on those admitted. Any affidavits or declarations in the file swearing behind a patent should be clearly identified by the examiner as being considered under either § 1.131 or § 1.204. The distinction is important since the Board of Appeals will usually consider holdings on § 1.131 affidavits or declarations but not on § 1.204 affidavits or declarations.

If the brief fails to respond to any or all grounds of rejection advanced by the examiner, he or she should follow the indicated procedure for handling such

briefs set forth in § 1206. If the failure to respond appears intentional or is not corrected within the period allowed by the notice calling the defect to appellant's attention, the examiner should simply inform the Board of Appeals of this fact in his or her answer and specify the particular claims affected. Since such intentional lack of response to any ground of rejection may result in dismissal of the appeal as to the claims affected, the claims involved need not be treated further by the examiner in his or her answer. A dismissal of the appeal will result if all the claims are involved and the Board concurs in the examiner's conclusion.

Because of the practice of the Patent and Trademark Office in entering amendments after final action under justifiable circumstances for purposes of appeal, many cases coming before the Board of Appeals for consideration contain claims which are not the claims treated in the examiner's final rejection. They are either entirely new claims or amended versions of the finally rejected claims or both. The new claims or finally rejected claims, as amended, frequently contain limitations not in the claims treated in the final rejection and the arguments in the appellant's brief are directed to the new claims. Under such circumstances the mere reference in the examiner's answer to the final rejection for a statement of his or her position would leave the Board, insofar as the new claims are concerned, with an uncrystallized issue and without the benefit of the examiner's view, which complicates the task of rendering a decision.

It also frequently happens that an examiner will state his or her position in the answer in a manner that represents a shift from the position stated in the final rejection without indicating that the last stated position supersedes the former. Such a situation confuses the issue and likewise poses difficulties for the Board since it is not clear exactly what the examiner's ultimate position is.

In view of the complete and thorough development of the issues at the time of final rejection it is possible to save time in preparing the examiner's answer required by 37 CFR 1.193 by taking the following step:

A. Examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection (or a single other action on which it is based, § 706.07). Only those statements of grounds of rejection as appear in *single* prior action may be incorporated by reference. An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action. Statements of grounds of rejection appearing in actions other than the aforementioned single prior action should be *quoted* in the answer. The page and paragraph of the final action or other single prior action which it is desired to incorporate by reference should be explicitly identified. Of course, if the examiner feels that some further explanation of the rejection is necessary he or she should include it in the answer but ordinarily he or she may avoid another recital of the issues and another elaboration of the grounds of rejection. The answer should also include any necessary rebuttal of



arguments presented in the appellant's brief if the final action does not adequately meet the arguments.

B. If the appellant (1) fails to describe the invention, as required by 37 CFR 1.192, or (2) fails to describe the reference, the examiner is no longer required to provide these omissions. The examiner should, however, include such description and explanation in the answer if he or she feels it necessary to present properly and effectively his or her case to the Board of Appeals.

The examiner should reevaluate his or her position in the light of the arguments presented in the brief, and should expressly withdraw any rejections not adhered to, especially if the rejection was made in an action which is incorporated by reference. This should be done even though any rejection not repeated and discussed in the answer may be taken by the Board as having been withdrawn.

The Board has authority to remand a case to the examiner for a fuller description of the claimed invention and, in the case of a machine, a statement of its mode of operation. In certain cases where the pertinence of the references is not clear, the Board may call upon the examiner for a further explanation. In the case of multiple rejections of a cumulative nature, the Board may also remand for selection of the preferred or best ground. The Board may also remand a case to the examiner for further search where it feels that the most pertinent art has not been cited.

All correspondence with the Board of Appeals, whether by the examiner or the appellant must be on the record. No unpublished decisions which are unavailable to the general public by reason of 35 U.S.C. 122 can be cited by the examiner or the appellant except that either the examiner or the appellant has the right to cite an unpublished decision in an application having common ownership with the application on appeal.

When files are forwarded, soft copies and prints of references therein should not be disturbed.

If an examiner's answer is believed to contain a new interpretation or application of the existing patent law, the examiner's answer, application file and an explanatory memorandum should be forwarded to the group director for consideration, see § 1003, item 16. If approved by the group director, the examiner's answer should be forwarded to the Office of the Assistant Commissioner for Patents for final approval.

A form suitable for the examiner's answer is as follows:

#### IN RE APPLICATION OF

Ser. No. ....  
 Filed ..... Before the Board of Appeals  
 For .....

#### EXAMINER'S ANSWER

"This is an appeal from the final rejection of claims ..... Claims ..... are allowable."

"A correct copy of the appealed claims appears on page — of the appellant's brief." (If any claims are incorrect, they should be correctly reproduced in the

answer in clean copy without any underlining or brackets as required by 37 CFR 1.121(b)).

Statement as to any ground of rejection not argued or responded to by appellant and the particular claims affected by such lack of response.

"The references of record relied on are:

1,736,481 Smith—6-20  
 1,894,324 Jones—7-23

"New References" See § 1208.01.

(The examiner's answer must cite all references relied on in the appeal and cannot refer to other papers for this information. In citing non-patent references, the current location of the reference should be specified by class and subclass or, if not classified, the particular location in the Office where a copy can be found. In addition, the citation should specify the precise page or pages of the reference relied on. Omit listing of references not involved in the appeal.)

"Statement of the grounds of rejection."

Reference may be made to a final rejection or single prior action for a clear exposition of the rejection. If not all of the prior rejections in such a referred to prior action are maintained, they should be specifically noted as not being applied. If necessary, a description and explanation of the alleged invention and references may be made to present the examiner's case properly. If pertinent, a statement should be included that a new ground of rejection is contained in the answer.

Response to the allegations and arguments in the brief not already met by the final rejection.

If a new ground of rejection is raised, see § 1208.01.

For case having patentability report, see § 705.01(a).

Request by the examiner to present arguments at the oral hearing.

#### 1208.01 New Reference, New Objection or New Ground of Rejection in Examiner's Answer

At the time of preparing the answer to an appeal brief, the examiner may decide that he or she should cite a new reference, raise a new objection, or apply a new ground of rejection (new reference, double patenting, statutory bar or other reason for rejection) against some or all of the appealed claims. All answers citing new references or containing new grounds of rejection or objection must be routed over the supervisory primary examiner's desk for review and approval. The supervisory primary examiner will stamp "approved" and sign his or her approval. Note § 1002.02(d), item 3. If approval is given to the citation of new references, the answer will be mailed by the group and will include copies of the new references. Also, a PTO-892 must be completed for the file for use by the printer in case of issuance as a patent. The Board will return to the group director's office any answer containing (1) any newly cited reference (for purpose) or (2) a new ground of rejection, where such answer does not bear an approved stamp.

In order to introduce a new ground of rejection it is necessary either to reopen the ex parte prosecution before the examiner or to include the new rejection in



the examiner's answer, depending on existing circumstances. The choice of action to be followed will depend on such factors as (1) the history of the prosecution, (2) the number of claims affected, (3) the importance of the new ground of rejection, (4) the significance of the new reference and (5) the nature of the response to be expected. For example, if the reference is basic and materially better in meeting all of the claims, reopening of the prosecution and making the action final would ordinarily be approved if the requirements for making an action final under § 706.07(a) are met. Should appellant desire later to have the Board review the examiner's new final action, the appellant must file a new Notice of Appeal (without fee) and a new brief (without fee). On the other hand, if the new reference anticipates some but not all of the claims or supplies a minor lack in art already relied on, inclusion of the new ground in the examiner's answer would normally be the approved procedure. Of course, if the new ground of rejection applies to any claim standing allowed the prosecution should be reopened.

It is important that the new ground with regard to which the supervisory primary examiner has been consulted be clearly indicated as such so that the Board of Appeals can readily identify those cases where appellant is entitled to a period of two months for reply. Any new reference should be cited under the caption "New Reference(s)."

Likewise when a ground of rejection not involving a new reference is raised for the first time in the answer after consultation with the supervisory primary examiner the fact that it is a new ground should be clearly indicated, thus: **THIS IS A NEW GROUND OF REJECTION**, or some equivalent statement.

The examiner's answer which includes a new ground of rejection should conclude with Form Paragraph 12.18:

*12.18 New ground of rejection, examiner's answer*

In view of the new ground of rejection applicant has TWO MONTHS from the mailing date of this answer within which to file a reply. Such reply may include any amendment or material appropriate to the new ground. Prosecution otherwise remains closed. Failure to respond to the new ground of rejection will result in dismissal of the appeal of the claims so rejected.

In the case of non-entry of any amendment filed in response to a new ground of rejection, the examiner should *notify* the appellant *in writing* to begin the two month period for petition under 37 CFR 1.181.

**REPLY BRIEF**

Where a new ground of rejection is raised in the examiner's answer, the appellant, under 37 CFR 1.193(b) has two months within which he may file a reply brief. This time period may be extended under 37 CFR 1.136(a), and 37 CFR 1.136(b) once 1.136(a) has been exhausted. The appellant's reply, insofar as the new ground of rejection is concerned, may include any amendment or material appropriate to the new ground. Consideration will be limited to amendments and facts pertinent to the new ground rejection.

An amendment limited to the new ground of rejection is entitled to entry: *Ex parte Abseck et al.*, 133 USPQ 411 (Supervisory Examiner, 1960).

In the case of non-entry of a reply brief, the examiner should *notify* the appellant *in writing* to begin the two month period for petition under 37 CFR 1.181.

Where new points of argument have been raised in the examiner's answer, appellant may file a reply brief within twenty days from the date of such answer. Appellants should clearly and specifically indicate in their reply briefs the new points of argument "raised in the examiner's answer" to which said reply briefs are directed. 37 CFR 1.193(b) does not permit general rebuttal of each statement made in the examiner's answer.

Appellants are reminded that their briefs in appealed cases must be responsive to every ground of rejection stated by the examiner, including new grounds stated in his answer.

Where an appellant fails to respond by way of brief or reply brief to any ground of rejection, and it appears that the failure is inadvertent, appellant shall be notified by the examiner that he or she is allowed one month to correct the defect by filing a supplemental brief. Where this procedure has not been followed, the Board of Appeals should remand the application to the examiner for compliance. When the record clearly indicates intentional failure to respond by brief to any ground of rejection, for example, by failure to file a supplemental brief within the one-month period allowed for that purpose, the examiner should inform the Board of Appeals of this fact in his or her answer and merely specify the claim affected.

Where the failure to respond by brief appears to be intentional, the Board of Appeals may dismiss the appeal as to the claims involved. Oral argument at a hearing will not remedy such deficiency of a brief.

In those situations where a reply brief is *clearly* unwarranted (e.g., no new grounds of rejection or new points of argument in the examiner's answer), the examiner should refuse entry of the reply brief. See 37 CFR 1.193(b).

**SUPPLEMENTAL EXAMINER'S ANSWER**

Normally, when a reply brief has been filed by the appellant following an examiner's answer, the case should be forwarded to the Board of Appeals without any need for the preparation of a supplemental answer by the examiner. The examiner should simply write "noted" on the reply brief along with his or her initials and the date. This will indicate to the clerical staff and the Board of Appeals that the examiner has seen the reply brief. However, where good reason to respond is apparent, the examiner may issue a supplemental answer in response to the reply brief before forwarding the case to the Board.

A supplemental examiner's answer may not normally contain a new ground of rejection.

*37 CFR 1.193. Examiner's answer*

\* \* \* \* \*

(c) Any decision pursuant to § 1.56(d) rejecting claims in an application already under appeal of a rejection based on other grounds shall constitute a supplemental examiner's answer introducing a new ground of rejection and removing the suspension of the appeal introduced pursuant to § 1.56(e), in which case appellant may file a reply thereto within two months from the date of the supplemental examiner's answer. Such reply will be considered and responded to as necessary. Appellant may file a reply brief directed to any such response within one month of the date of the response or within such other time as may be set in the response.

Paragraph (c) of § 1.193 provides that any decision rejecting claims pursuant to § 1.56(d) in an application already on appeal from a rejection based on other grounds shall constitute a supplemental examiner's answer introducing a new ground of rejection and removing the suspension of the appeal introduced pursuant to § 1.56(e). Prior to entering any such supplemental examiner's answer under paragraph (c), the Office may require information from applicant pursuant to paragraph (i) of § 1.56. Under paragraph (c) of § 1.193, the appellant may file a reply to the supplemental examiner's answer. Paragraph (c) provides that the appellant's reply to the supplemental examiner's answer will be considered and responded to as necessary with appellant being provided with an additional month, or such other time as may be set, within which to reply to any such response from the Office. After introduction of a supplemental examiner's answer pursuant to paragraph (c) and any replies and response thereto, the application will be forwarded to the Board of Appeals for consideration.

### 1208.02 Withdrawal of Final Rejection

The examiner may withdraw the final rejection at any time prior to the mailing of the examiner's answer. It is possible that after reading the brief, the examiner may be convinced that some or all of the finally rejected claims are allowable. Where the examiner is of the opinion that some of the claims are allowable, he or she should so specify in the examiner's answer and confine the arguments to the remaining rejected claims. If the examiner finds, upon reconsideration, that all the rejected claims are allowable, or where the appellant in the brief withdraws the appeal as to some of the rejected claims and the examiner finds the remaining claims to be allowable, the examiner should pass the case to issue. The Group Director should approve and Board should be notified whenever a remanded application is withdrawn from appeal under any circumstance. See §§ 706.07(c) to 706.07(e).

In applications where an interference has resulted from the applicant copying claims from the patent which provided the basis for final rejection, the rejection based on that patent should be withdrawn and the appeal dismissed as to the involved claims.

### 1209 Oral Hearing

37 CFR 1.194. *Oral hearing.* (a) An oral hearing should be requested only in those circumstances in which the appellant considers such a hearing necessary or desirable for a proper presentation of his appeal. An appeal decided without an oral hearing will receive the same consideration by the Board of Appeals as appeals decided after oral hearing.

(b) If appellant desires an oral hearing, appellant must file a written request for such hearing accompanied by the fee set forth in

§ 1.17(g) within one month after the date of the examiner's answer. If appellant requests an oral hearing and submits therewith the fee set forth in § 1.17(g), an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board.

(c) If no request and fee for oral hearing have been timely filed by the appellant, the appeal will be assigned for consideration and decision. If the appellant has requested an oral hearing and has submitted the fee set forth in § 1.17(g), a day of hearing will be set, and due notice thereof given to the appellant and to the primary examiner. Hearing will be held as stated in the notice, and oral argument will be limited to twenty minutes for the appellant and fifteen minutes for the primary examiner unless otherwise ordered before the hearing begins.

The following procedures are in effect under § 1.194:

(1) In accordance with § 1.192, appellants who desire an oral hearing must request and pay the fee for an oral hearing within one month after the date of the examiner's answer. This period can be extended under 37 CFR 1.136(a).

(2) If the primary examiner intends to present an oral argument, the last paragraph of the examiner's answer will indicate this intention.

(3) Notice of the oral hearing will be given to the appellant and, at the same time, to the primary examiner in those cases in which the primary examiner has indicated an intention to present an oral argument.

(4) After an oral hearing has been confirmed and the date set as provided in § 1.194(c), the application file will be delivered to the examiner via the appropriate Group Director at least one week prior to the date of the hearing for those cases in which the examiner is expected to be present at the hearing. In those cases where the Board requests the presentation of an oral argument by, or on behalf of, the primary examiner, the appellant will be so notified. The Board's request for an oral argument may, where appropriate, indicate specific points or questions to which the argument should be particularly directed. The application file will be returned to the Board before the hearing.

(5) In those appeals in which an oral hearing has been confirmed and either the primary examiner or the Board has indicated a desire for oral argument, such oral argument may be presented whether or not appellant appears. If appellant desires to argue his or her case before the Board, he or she must file a brief and within one month of the examiner's answer indicate if he or she desires an oral hearing. If no request has been made by appellant, the appeal will be assigned for consideration and decision. That is, the decision will be rendered on the brief.

A notice of hearing, stating the date, the time and the docket, is forwarded to the appellant in due course. If appellant fails to confirm within the stated time (14 days), the appeal is removed from the hearing docket and assigned on brief in due course. No refund of the fee for requesting an oral hearing will be made. Similarly, after confirmation, if no appearance is made at the scheduled hearing, the appeal is decided on brief. Since failure to notify the Board of waiver of hearing in advance of the assigned date re-

sults in a waste of the Board's resources, appellant should inform the Board of a change in plans at the earliest possible opportunity.

If the time set in the notice conflicts with prior commitments or if subsequent events make appearance impossible, the hearing may be rescheduled on written request. However, postponements are discouraged and will not be granted in the absence of convincing reasons in support of the requested change.

If appellant has any special request, such as for a particular date or day of the week, this will be taken into consideration in setting the cases, if made known to the Board in advance, as long as such request does not unduly delay a decision in the case.

The arguments at the hearing may be presented by appellant's attorney or agent if he or she is duly authorized in accordance with 37 CFR 1.34(a).

Currently, twenty minutes are allowed for appellant to explain his or her position. If appellant believes that additional time will be necessary, a request for such time should be made well in advance and will be taken into consideration in assigning the hearing date. The final decision on whether additional time is to be granted rests within the discretion of the senior member of the panel hearing the case.

Primary examiners are permitted to present oral arguments before the Board of Appeals in appeals where the appellant has been granted an oral hearing. After the appellant has made his or her presentation, the examiner will be allowed fifteen minutes to reply as well as to present a statement which clearly sets forth his or her position with respect to the issues and rejections of record. Appellant may utilize any allotted time not used in the initial presentation for rebuttal.

Currently, up to two examiners are permitted to attend any one hearing as observers, where the case is related to the examiners' field of technology.

Participation by examiners is considered to be desirable not only from the standpoint of improving the overall presentation of the argument, particularly in complex cases, but also for the educational and experience benefits to the examiners themselves.

In any appeal where oral argument is to be presented by, or on behalf of, the primary examiner, the appellant will be given due notice of that fact.

The examiner's request for an oral hearing should appear in the last paragraph of the examiner's answer.

The examiner should make a pencil notation "Examiner requests an Oral Hearing" on the face of the file wrapper below the box for the examiner's name when an oral hearing is requested.

### **1210 Actions Subsequent to Examiner's Answer but Before Board's Decision**

#### **JURISDICTION OF BOARD**

The application file and jurisdiction of the application are normally transferred from the examining groups to the Board of Appeals at one of the following times:

(1) After 2 months from the examiner's answer, plus mail room time, if a "new ground of rejection" has

been indicated in the examiner's answer and no reply brief has been timely filed.

(2) After 20 days from the examiner's answer, plus mail room time, where no new ground of rejection has been indicated in the examiner's answer and no reply brief has been timely filed.

(3) After a supplemental examiner's answer has been mailed in reply to a timely reply brief.

(4) After the examiner has determined by initialing and dating the reply brief, that he or she will not prepare a supplemental examiner's answer in response to a timely reply brief.

(5) After examination pursuant to § 1.56(e) where the appeal has been suspended for examination for compliance with § 1.56(d).

Any amendment, affidavit, or other paper relating to the appeal, filed thereafter but prior to the decision of the Board, may be considered by the examiner only in the event the case is remanded by the Board for that purpose.

#### **DIVIDED JURISDICTION**

Where appeal is taken from the final rejection of one or more copied claims only, jurisdiction of the rest of the case remains with the examiner, and prosecution of the remaining claims may proceed as though the entire case was under his jurisdiction. Also, where the examiner certifies in writing that there is no conflict of subject matter, an appeal to the Board of Appeal may proceed concurrently with an interference.

#### **ABANDONMENT OF APPEAL**

To avoid the rendering of decisions by the Board of Appeals in applications which have already been refiled as continuations, appellants should promptly inform the clerk of the Board in writing as soon as they have positively decided to refile or to abandon an application containing an appeal awaiting a decision. Failure to exercise appropriate diligence in this matter may result in the Board's refusing an otherwise proper request to vacate its decision.

Except in those instances where a withdrawal of an appeal would result in abandonment of the application, an attorney not of record in an application may file a paper under 37 CFR 1.34(a) withdrawing an appeal. In such instances where no allowable claims appear in the application, the withdrawal of an appeal is in fact an express abandonment and does not comply with 37 CFR 1.138.

### **1211 Remand by the Board To Consider Amendment**

There is no obligation resting on the Board to consider new or amended claims submitted while it has jurisdiction of the appeal. *In re Sweet*, 1943 C.D. 535, 58 USPQ 327, 30 CCPA 1124. A proposed amendment, affidavit, declaration, or other paper may be remanded for such consideration as the examiner may see fit to give. Such an amendment, unless filed under § 1.193(b), will be treated as an amendment filed after appeal. See § 1207.

If the proposed amendment is in effect an abandonment of the appeal, as, by canceling the appealed claims other claims being present which are patentable in the opinion of the examiner, the amendment should be entered and the clerk of the Board notified in order that the case may be removed from the Board's docket.

### 1212 Remand by the Board To Consider Affidavits or Declarations

*37 CFR 1.195. Affidavits or declarations after appeal.* Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented.

Affidavits or declarations filed with or after appeal but before the mailing of the examiner's answer will be considered for entry only if the appellant makes the necessary showing under § 1.195 as to why they were not earlier presented. Authority from the Board is not necessary to consider such affidavits or declarations. Affidavits or declarations filed after a final rejection and prior to a notice of appeal are handled as provided in §§ 715.09 and 716.

In the case of affidavits or declarations filed after the application has been forwarded to the Board of Appeals, but before a decision thereon by the Board of Appeals, the examiner is without authority to consider the same in the absence of a remand by the Board. When a case is remanded to the examiner for the consideration of such affidavits or declarations, the examiner, after having given such consideration as the facts in the case require, will return the case to the Board of Appeals with his or her answer on remand, a copy of which should be forwarded to the appellant. If such an affidavit or declaration is not accompanied by the showing required under § 1.195, the examiner will not consider its merits. If the delay in filing such affidavit or declaration is satisfactorily explained, the examiner will admit the same and consider its merits. If this affidavit or declaration is accepted as overcoming the reference, or references, used in the final rejection, and a new reference having a filing date prior to the date of invention established in the record, or having a publication date more than one year prior to the appellant's filing date, is found, it may be substituted for the one overcome without thereby reopening the case to further prosecution before the examiner. *Ex parte Bowyer*, 1939 C.D. 5, 42 USPQ 526.

It is not the custom of the Board to remand affidavits or declarations offered in connection with a request for reconsideration of its decision where no rejection has been made under § 1.196(b). Affidavits or declarations submitted for this purpose, not remanded to the examiner, are considered only as arguments. In *re Martin*, 1946 C.D. 180, 69 USPQ 75, 33 CCPA 842.

For remand to the examiner to consider appellant's remarks relating to a § 1.196(b) rejection see § 1214.01.

### 1213 Decision by Board

*37 CFR 1.196. Decision by the board of Appeals.* (a) The board of Appeals, in its decision, may affirm or reverse the decision of the primary examiner in whole or in part on the grounds and on the claims specified by the examiner. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the primary examiner on that claim, except as to any ground specifically reversed.

After consideration of the record including appellant's brief and the examiner's answer, the Board writes its decision, affirming the examiner in whole or in part, or reversing the examiner's decision, sometimes also setting forth a new ground of rejection.

On occasion the Board of Appeals has refused to consider an appeal until after the conclusion of a pending civil action or appeal to the C.A.F.C. involving issues identical with and/or similar to those presented in the later appeal. Such suspension of action, postponing consideration of the appeal until the Board has the benefit of a court decision which may be determinative of the issues involved, has been recognized as sound practice. An appellant is not entitled, after obtaining a final decision by the Patent and Trademark Office on an issue in a case, to utilize the prolonged pendency of a court proceeding as a means for avoiding *res judicata* while relitigating the same, or substantially the same issue in another application.

An applicant may request that the decision be withheld to permit the refiling of the application at any time prior to the mailing of the decision. Up to 30 days may be granted, although the time is usually limited as much as possible. The Board will be more prone to entertain the application's request where the request is filed early, obviating the necessity for an oral hearing or even for the setting of the oral hearing date. If the case has already been set for oral hearing, the petition should include a request to vacate the hearing date, *not* to postpone it.

In a situation where a withdrawal of the appeal is filed on the same day that the decision is mailed, a petition to vacate the decision will be denied.

Since review of the decisions of the Board is committed by statute to the courts, its decisions are properly reviewable on petition only to the extent of determining whether they involve obvious error or abuse of discretion. Reasonable rulings made by the Board on matters resting in its discretion will not be disturbed upon petition. Thus, for example, the Board's opinion as to whether it has employed a new ground of rejection will not be set aside on petition unless said opinion is found to be clearly unwarranted.

#### 1213.01 Recommendations of Board

*37 CFR 1.196. Decision by the Board of Appeals.*

(c) Should the decision of the Board of Appeals include an explicit statement that a claim may be allowed in amended form, appellant shall have the right to amend in conformity with such state-



ment, which shall be binding on the primary examiner in the absence of new references or grounds of rejection.

If the examiner knows of references or reasons which were not before the Board, such a favorable recommendation is not binding. Likewise, any change in a favorably recommended claim other than the amendments recommended would tend to destroy the force of such recommendation. *Ex parte Young*, 18 Gour. 24, 31.

In the absence of an express recommendation, a remark by the Board that a certain feature does not appear in a claim is not to be taken as a recommendation that the claim be allowed if the feature is supplied by amendment. *Ex parte Norlund*, 1913 C.D. 161, 192 O.G. 989.

Appellant's right to amend in conformity with the recommendation may only be exercised within the period allowed for seeking court review, ordinarily sixty days from the date of the Board's decision.

### 1213.02 Statement as to Rejection of an Allowed Claim

37 CFR 1.196. *Decision by the Board of Appeals.*

(d) Although the Board of Appeals normally will confine its decision to a review of rejections made by the primary examiner, should it have knowledge of any grounds for rejecting any allowed claim that it believes should be considered, it may include in its decision a statement to that effect and remand the case to the primary examiner for consideration thereof. In such event, the Board shall set a period, not less than one month, within which the appellant may submit to the primary examiner an appropriate amendment, or a showing of facts or reasons, or both, in order to avoid the grounds set forth in the statement of the Board of Appeals. If the primary examiner rejects the previously allowed claim or claims on the basis of such statement, the appellant may appeal to the Board of Appeals from the rejection. Whenever a decision of the Board of Appeals includes a remand, that decision shall not be considered as a final decision in the case, but the Board of Appeals shall, upon conclusion of the proceedings before the primary examiner on remand, either adopt its decision as final or render a new decision on all of the claims on appeal, as it may deem appropriate.

37 CFR 1.196(d) provides express authority for the Board of Appeals to include, in its decision, a statement of any grounds for rejecting any allowed claim that it believes should be considered by the primary examiner. Section 1.196(d) also provides that the Board may remand the case to the examiner for such consideration, and that the appellant shall have an opportunity to respond to the grounds set forth by the Board prior to consideration by the examiner. If the previously allowed claims are rejected by the examiner, the rejection may be appealed to the Board.

The section further provides that a decision of the Board which includes a remand will not be considered as a final decision in the case, but that the Board, following conclusion of the proceedings before the primary examiner, will either adopt its earlier decision as final or will render a new decision based on all appealed claims, as it considers appropriate. In either case, final action by the Board will give rise to the alternatives available to an appellant following a decision by the Board.

In situations where the primary examiner concludes after consideration of all the evidence and argument that the remanded claims should be allowed, the rule dealing with reasons for allowance (§ 1.109) provides an appropriate mechanism for him or her to explain, on the record, his or her reasoning for coming to this conclusion, notwithstanding the grounds set forth by the Board in its statement.

Section 1.196(d) does not affect the Board's authority to remand a case to the primary examiner without rendering a decision in appropriate circumstances. Section 1.196(d) is not intended as an instruction to the Board to reexamine every allowed claim in every appealed application. It is, rather, intended to give the Board express authority to act when it becomes apparent, during the consideration of rejected claims, that one or more allowed claims may be subject to rejection on either the same or on different grounds from those applied against the rejected claims.

### 1214 Actions Following Decision by Board

Board of Appeals decisions may be published, if requested by the Board or group. In the event that the application has become abandoned, applicant is notified prior to publication. 37 CFR 1.14(d)

#### 1214.01 New Ground of Rejection

37 CFR 1.196. *Decisions by the Board of Appeals* . . . (b) Should the Board of Appeals have knowledge of any grounds not involved in the appeal for rejecting any appealed claim, it may include in the decision a statement to that effect with its reasons for so holding, which statement shall constitute a rejection of the claims. The appellant may submit an appropriate amendment of the claims so rejected or a showing of facts, or both, and have the matter considered by the primary examiner. The statement shall be binding upon the primary examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the primary examiner, avoids the additional ground for rejection stated in the decision. The appellant may waive such reconsideration before the primary examiner and have the case reconsidered by the Board of Appeals upon the same record before them. Where request for such reconsideration is made the Board of Appeals shall, if necessary, render a new decision which shall include all grounds upon which a patent is refused. The appellant may waive reconsideration by the Board of Appeals and treat the decision, including the added grounds for rejection given by the Board of Appeals, as a final decision in the case.

A. A request for reconsideration by the Board must be filed within thirty days from the date of the decision, the period set by § 1.197(b). By proceeding in this manner the appellant waives his or her right to further prosecution before the examiner. In *re Greenfield*, 1930 C.D. 531, 5 USPQ 474.

However, an appellant's request for reconsideration accompanied by an affidavit containing a showing of facts to be added to the record does not afford reconsideration by the Board as a matter of right under § 1.196(b). The Board of Appeals has authority to remand the application to the examiner and the examiner has authority to consider a new showing of facts following a new rejection by the Board and withdraw the Board's rejection based on the appellant's affidavit and accompanying remarks. In such an instance, the examiner also has authority to make any appropriate

new rejection under § 1.198 with the Group Director's approval.

B. Where the Board's decision completely removes the examiner's rejection as to one or more claims and substitutes a new one under § 1.196(b), the appellant, if he or she elects to proceed before the examiner, must take such action within the period for response set in the Board's decision, which may not exceed six months from the Board's decision. See *In re application* filed July 13, 1950 at 693 O.G. 136, 1955 C.D. 3. A shortened period for response of thirty days ordinarily is set in the Board's decision. A rejection under 37 CFR 1.196(b) in effect nullifies the final rejection and reopens the prosecution of the subject matter of the claims so rejected by the Board of Appeals.

The appellant may amend the claims involved, or substitute new claims to avoid the art or reasons adduced by the Board. *Ex parte Burrowes*, 1904 C.D. 155, 110 O.G. 599. Such amended or new claims must be directed to the same subject matter as the appealed claims, *Ex parte Comstock*, 1923 C.D. 82, 317 O.G. 4.

Argument without amendment of the claims so rejected can result only in a final rejection of the claims, since the examiner is without authority to allow the claims unless amended or unless the rejection is overcome by a showing of facts not before the Board. The new ground of rejection raised by the Board does not reopen the prosecution except as to that subject matter to which the new rejection was applied.

C. As a third option, appellant may treat such decision of the Board as final and file either a direct appeal therefrom to the C.C.P.A., or a civil action under 35 U.S.C. 145. *In re Crowell*, 1930 C.D. 360, 397 O.G. 3. Where the appellant makes use of the third option, he or she waives his or her right to reconsideration by the Board, or by the examiner, discussed above. *In re Heinz*, 1910 C.D. 292, 151 O.G. 1014.

### 1214.02 Procedure After Decision

37 CFR 1.197. *Action following decision.* (a) After decision by the Board of Appeals, the case shall be returned to the primary examiner, subject to the appellant's right of appeal or other review, for such further action by the appellant or by the primary examiner, as the condition of the case may require, to carry into effect the decision.

After an appeal to the Board of Appeals has been decided, a copy of the decision is mailed to the appellant and the original placed in the file. The clerk of the Board notes the decision on the file wrapper and in the record of appeals, and then forwards the file to the primary examiner through the office of the group director immediately if the examiner is reversed, and after 5 months if the examiner is affirmed or after a decision on a request for reconsideration is rendered.

### 1214.03 Rehearing and Reconsideration

37 CFR 1.197. *Action following decision.* . . . (b) A single request for rehearing or reconsideration, or modification of the decision, may be made if filed within thirty days from the date of the original decision, unless that decision is so modified as to become, in

effect, a new decision, and the Board of Appeals so states. Such time may be extended under the provisions of § 1.136.

All copies of references in the file wrapper should be retained therein.

For extension of time to appeal to the Court of Appeals for the Federal Circuit or commence a civil action under 37 CFR § 1.304(a) see section 1002.02(n).

For requests for reconsideration by the examiner see § 1214.04.

### 1214.04 Examiner Reversed

A complete reversal of the examiner's rejection brings the case up for immediate action by the examiner.

The examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references. This is particularly so where the application has meanwhile been transferred or assigned to an examiner other than the one who finally rejected the claims. The second examiner should give full faith and credit to his or her predecessor's search.

If the examiner has specific knowledge of the existence of a particular reference or references which indicate non-patentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the group director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. Note §§ 1002.02(c), item 2, and 1214.07. The group director's approval is placed on the action reopening prosecution.

The examiner may request reconsideration of the Board decision. Such a request should normally be made within one month of the receipt of the Board decision in the group. The group director's secretary should therefore date stamp all Board decisions upon receipt in the group.

All requests by the examiner to the Board of Appeals for reconsideration of a decision, must be approved by the group director and must also be forwarded to the Office of the Deputy Assistant Commissioner for Patents for approval before mailing.

If approved, the Office of the Deputy Assistant Commissioner for Patents will mail a copy of the request for reconsideration to the appellant and forward the application file and the request to the Board of Appeals.

### 1214.05 Cancellation of Withdrawn Claims

Where an appellant withdraws some of the appealed claims, and the Board reverses the examiner on the remaining appealed claims the withdrawal is treated as an authorization to cancel the withdrawn claims. It is not necessary to notify the appellant of the cancellation of the withdrawn claims.

### 1214.06 Examiner Sustained in Whole or in Part

37 CFR § 1.197. *Action following decision.* . . . (c) Proceedings are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action (§ 1.304) except (1) where claims stand allowed in an application or (2) where the nature of the decision requires further action by the examiner. In

such cases, the date of termination of proceedings is the date on which the appeal is dismissed or the date on which the time for appeal to the court or review by civil action (§ 1.304) expires. If an appeal to the court or a civil action has been filed, proceedings are similarly considered terminated when the appeal or civil action is terminated.

If the examiner was sustained either in whole or in part, it is improper to notify appellant of the status of the case unless asked to do so. See *Ex parte Buchenberg* 1924 C.D. 55, 327 O.G. 216.

The time for seeking review of a decision of the Board of Appeals by the Court of Appeals for the Federal Circuit or the District Court is the same for both tribunals, that is, sixty days, or sixty days with the extension provided by § 1.304 in the event a petition for reconsideration or rehearing is seasonably filed before the Board, or as extended by the Commissioner. See § 1214.03. When the time for seeking court review (plus two weeks to allow for information as to the filing of an appeal or civil action, if any, to reach the examiner) has passed without such review, being sought, the examiner must take up the case for consideration. The situations which can arise will involve one or more of the following six circumstances:

**A. No claims stand allowed.** The proceedings in the application are terminated as of the date of the expiration of the time for filing court action. The application is no longer considered as pending. It is to be stamped abandoned and sent to abandoned files without notifying applicant.

**B. Claims stand allowed.** The appellant is not required to file a response. The examiner takes the case up and passes it to issue on the claims which stand allowed. A red ink line should be drawn through the refused claims and the notion "Board Decision" written in the margin in red ink.

If uncorrected matters of form which cannot be handled without written correspondence remain in the case, the examiner should take appropriate action but prosecution is otherwise closed. A letter such as set forth in Form Paragraph 12.20 is suggested:

**12.20 Period for seeking court review has lapsed**

The period for seeking court review of the decision by the Board of Appeals rendered [1] has expired and no further action has been taken by applicant. The proceedings as to the rejected claims are considered terminated; see 37 CFR 1.197(c).

The application will be passed to issue on allowed claim [2] provided the following formal matters are promptly corrected: [3] Prosecution is otherwise closed.

**Examiner Note:**

*In bracket 1, enter the date of the decision.*

*In bracket 2, identify the allowed claims.*

(Set a thirty day Shortened Statutory period for response.)

**C. Claims require action.** If The decision of the Board is an affirmance in part and includes a reversal of a rejection that brings certain claims up for action on the merits, such as a decision reversing the rejection of generic claims in a case containing claims to nonelected species not previously acted upon, the examiner will take the case up for appropriate action on the matters thus brought up, but the case is not con-

sidered open to further prosecution except as to such matters.

**D. Section 1.196(b) rejection.** Where the Board makes a new rejection under 37 CFR 1.196(b) and no action is taken with reference thereto by appellant within six months, or such shortened period as may be set in the Board's decision, the examiner should proceed in the manner indicated for situations A, B, or C, depending on which is appropriate to the case. See § 1214.01.

If the Board sustains the examiner's rejection, but also enters a new ground of rejection under 37 CFR 1.196(b), the filing of a request for reconsideration on the affirmed rejection will defer the end of the period for appeal to the courts until 30 days after the decision on reconsideration, to allow time for the examiner to consider any amendments and/or evidence offered to traverse the new ground of rejection.

**E. Section 1.196(c) recommendation.** Where the Board makes a recommendation under 37 CFR 1.196(c) and no action is taken with reference thereto by the appellant within the time permitted for court review, ordinarily sixty days from the date of the decision, the examiner should proceed in the manner indicated for situations A, B, or C, depending on which is appropriate to the case. See § 1213.01.

**F. Appeal dismissed.** Where the appeal has been dismissed for failure to argue a ground of rejection involving all the appealed claims see § 1215.04.

The practice under situations A, B, and C is similar to the practice after a decision of the court outlined in § 1216.01.

In view of the above practice, examiners must be very careful that applications which come back from the Board of Appeals are not overlooked because every case, except those in which all claims stand rejected after the Board's decision, is up for action by the examiner in the event no court review has been sought. Consequently, when a file is received after decision by the Board of Appeals, it must be examined and appropriate precautions taken to indicate the presence of allowed claims, if any. This may be done by writing the notation "Allowed Claims" or "Rejection Reversed" on "Contents" of file wrapper immediately below endorsement "Decision by Board".

See §§ 1216.01 and 1216.02 for procedure where court review is sought.

### 1214.07 Reopening of Prosecution

**37 CFR 1.198. Reopening after decision.** Cases which have been decided by the Board of Appeals will not be reopened or reconsidered by the primary examiner, except under the provisions of § 1.196, without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

Sometimes an amendment is filed after the Board's decision which does not carry into effect any recommendation made by the Board and which presents a new or amended claim or claims. In view of the fact that the prosecution of the case is definitely closed, the appellant clearly is not entitled to have such amendment entered as a matter of right. However, if



the amendment obviously places the case in condition for allowance, the primary examiner should endorse on the amendatory paper a recommendation that the amendment be admitted, and with the concurrence of the group director, the amendment will be entered. Note § 1003, item 14.

Where the amendment cannot be entered, the examiner should write to the appellant notifying him or her that the amendment cannot be entered and stating the reason why. The refusal should never be made to appear arbitrary or capricious.

Form Paragraph 12.19 should be used:

*12.19 Amendment after board decision*

The amendment filed [1] after the Board's decision is refused entry under 37 CFR 1.116(c) because prosecution is closed and the proposed claim(s) raise new issues which require further consideration or search.

**Examiner Note:**

*Identify the new issues.*

*This paragraph is not to be used in a response to a 196(b) rejection.*

In the event that claims stand allowed in the case under the conditions set forth in § 1214.06 (paragraph B), the case should be passed to issue.

Petitions under 37 CFR 1.198 to reopen or reconsider prosecution of a patent application after decision by the Board of Appeals, where no court action has been filed, are decided by group director, § 1002.02(c), item 2.

The Commissioner also entertains petitions under 37 CFR 1.198 to reopen certain cases in which an appellant has sought review under 35 U.S.C. 141 or 145. This procedure is restricted to cases which have been decided by the Board of Appeals and which are amenable to settlement without the need for going forward with the court proceeding. Such petitions will ordinarily be granted only in the following categories of cases:

1. When the decision of the Board of Appeals asserts that the rejection of the claims is proper because the claims do not include a disclosed limitation or because they suffer from some other curable defect, and the decision reasonably is suggestive that claims including the limitation or devoid of the defect will be allowable;

2. When the decision of the Board of Appeals asserts that the rejection of the claims is proper because the record does not include evidence of a specified character, and is reasonably suggestive that if such evidence were presented, the appealed claims would be allowable, and it is demonstrated that such evidence presently exists and can be offered; or

3. When the decision of the Board of Appeals is based on a practice, rule, law, or judicial precedent which, since the Board's decision, has been rescinded, repealed, or overruled.

Any such petition must be accompanied by the proposed amendment, evidence, or argument said to justify allowance of the claims. The petition further must point out how the case falls within one of the preceding categories. Failure to do so or failure of the case to qualify as coming within one of the categories will usually constitute basis for denying the petition. In

any event, no case will be reopened unless it is for the consideration of matters not already adjudicated, and sufficient cause has been shown.

Such petitions will not be ordinarily entertained after the filing of the Commissioner's brief in cases in which review has been sought under 35 U.S.C. 141, or after trial in a 35 U.S.C. 145 case.

In the case of an appeal under 35 U.S.C. 141, if the petition is granted, steps will be taken to request the court to remand the case to the Patent and Trademark Office and if so remanded the proposed amendments, evidence, and arguments will be entered of record in the application file for consideration, and further action will be taken by the Board of Appeals in the first instance or by the examiner as may be appropriate. In the case of civil action under 35 U.S.C. 145, steps will be taken for obtaining dismissal of the action without prejudice to consideration of the proposals.

## 1215 Withdrawal or Dismissal of Appeal

### 1215.01 Withdrawal of Appeal

Except in those instances where a withdrawal of an appeal would result in abandonment of the application, an attorney not of record in an application may file a paper under 37 CFR 1.34(a) withdrawing an appeal. In such instances where no allowable claims appear in the application, the withdrawal of an appeal is in fact an express abandonment and does not comply with 37 CFR 1.138 except where a continuing application is being filed on the same date.

Where, after appeal has been filed and before decision by the Board of Appeals, an applicant withdraws the appeal after the period for response to the final rejection has expired, the application is to be considered abandoned as of the date on which the appeal was withdrawn unless there are allowed claims in the case.

Where a letter abandoning the application is filed in accordance with § 1.138, the effective date of abandonment is the date of filing of such letter.

If a brief has been filed within the time permitted by 37 CFR 1.192 (or any extension thereof) and an answer mailed and appellant withdraws the appeal, the case is returned to the examiner.

To avoid the rendering of decisions by the Board of Appeals in applications which have already been refiled as continuations, applicants should promptly inform the clerk of the Board in writing as soon as they have positively decided to refile or to abandon an application containing an appeal awaiting a decision. Failure to exercise appropriate diligence in this matter may result in the Board's refusing an otherwise proper request to vacate its decision.

### 1215.02 Claims Standing Allowed

If the application contains allowed claims, as well as claims on appeal, the withdrawal of the appeal does not operate as an abandonment of the application, but is considered a withdrawal of the appeal as to those claims and authority to the examiner to



cancel the same. An amendment canceling the appealed claims is equivalent to a withdrawal of the appeal.

### 1215.03 Partial Withdrawal

A withdrawal of the appeal as to some of the claims on appeal operates as a cancellation of those claims from the case and the appeal continues as to the remaining claims. The withdrawn claims will be canceled from an application by direction of the examiner when necessary without further action by the applicant.

### 1215.04 Dismissal of Appeal

If no brief is filed within the time prescribed by 37 CFR 1.192, the appeal stands dismissed by operation of the rule. The letter (form PTOL-333) notifying the appellant that the appeal stands dismissed is not an action in the case and does not start any period for reply. If no claims stand allowed the application is considered as abandoned on the date the brief was due. No notification to the applicant that the application is abandoned is necessary. If claims stand allowed in the application, the failure to file a brief and consequent dismissal of the appeal is to be treated as a withdrawal of the appeal and of any claim not standing allowed. The application should be passed to issue forthwith. Unless appellant specifically withdraws the appeal as to rejected claims, the appeal should not be dismissed until the extended period (4 months under 37 CFR 1.136(a)) to file the brief has expired.

However, if formal matters remain to be attended to, the examiner should take appropriate action on such matters, setting a shortened period for reply, but the application is to be considered closed to further prosecution except as to such matters. A letter such as the following is suggested:

"In view of applicant's failure to file a brief within the time prescribed by 37 CFR 1.192, the appeal stands dismissed and the proceedings as to the rejected claims are considered terminated; see 37 CFR 1.197(c).

"This application will be passed to issue on claims (*identify*) which stand allowed provided the following formal matter(s) is (are) corrected. Prosecution is otherwise closed."

(Set out formal matter(s) requiring correction.)

(Set a thirty day shortened statutory period for response.)

### 1215.05 Case Before the Court

When the case is before the court either on appeal, 35 U.S.C. 141, or in a civil action under 35 U.S.C. 145, the status of the application in the event of a dismissal must be determined according to the circumstances leading to the dismissal. In no event will the application be considered abandoned as of a date prior to the date of the dismissal by reason of the dismissal alone.

### 1216 Appeals to Courts

37 CFR 1.304. *Time for appeal or civil action.* (a) The time for filing the notice and reasons of appeal to the U.S. Court of Appeals

for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) is sixty days from the date of the decision of the Board of Appeals or the Board of Patent Interferences. If a request for rehearing or reconsideration, or modification of the decision, is filed within the time provided pursuant to § 1.197(b) or § 1.256(b), the time for filing an appeal or commencing a civil action shall expire at the end of the sixty-day period or thirty days after action on the request, whichever is later. The time periods set forth herein are subject to the provisions of § 1.136.

(b) The times specified herein are calendar days. If the last day of the time specified for appeal or commencing a civil action falls on a Saturday, Sunday, or legal holiday, the time is extended to the next day which is neither a Saturday, Sunday, nor a holiday.

(c) If a defeated party to an interference has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under 35 U.S.C. 141 that he elects to have all further proceedings conducted under 35 U.S.C. 146 (§ 1.303(c)), the time for filing a civil action thereafter is specified in 35 U.S.C. 141.

Files of cases carried to the courts, either by appeal to the Court of Appeals for the Federal Circuit or by civil action in the District Court for the District of Columbia, are not opened by the Patent and Trademark Office to the public.

During the pendency of a suit the application is not under the jurisdiction of the examiner; and any amendment, as one copying claims from a patent for interference purposes, can be admitted only under the provisions of 37 C.F.R. § 1.198.

### Service of Court Papers on Commissioner of Patents and Trademarks

Those having occasion to serve on the Commissioner of Patents and Trademarks papers having to do with court proceedings are reminded that proper service by mail may be effected only by mailing the papers to the Solicitor of the Patent and Trademarks Office as counsel for the Commissioner. Rule 5(b) of the Federal Rules of Civil Procedure provides in pertinent part:

Whenever under these rules service is required or permitted to be made upon a party represented by an attorney the service shall be made upon the attorney unless service upon the party himself is ordered by the court. Service upon the attorney \* \* \* shall be made by delivering a copy to him or by mailing it to him at his last known address \* \* \*.

Rule 25(b) of the Federal Rules of Appellate Procedure similarly provides, "Service on a party represented by counsel shall be made on counsel."

Accordingly, all service copies of papers filed in court proceedings in which the Commissioner of Patents and Trademarks is a party which are served by mail should be addressed:

"(Name of Solicitor), Solicitor  
U.S. Patent and Trademark Office  
Washington, D.C. 20231."

### 1216.01 To Court of Appeals for the Federal Circuit

37 CFR 1.301. *Appeal to U.S. Court of Appeals for the Federal Circuit.* Any applicant or any owner of a patent involved in a reexamination proceeding dissatisfied with the decision of the Board of Appeals, and any party to an interference dissatisfied with the decision of the Board of Patent Interferences, may appeal to the U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal: (a) In the Patent and Trademark Office give notice to the Commissioner and file the reasons of

appeal (see §§ 1.302 and 1.304); (b) in the court, file a copy of the notice and reasons of appeal, and pay the fee for appeal, as provided by the rules of the court. The certified list required by the rules of the Court will be transmitted to the Court by the Patent and Trademark Office.

**35 U.S.C. 141. Appeal to Court of Appeals for the Federal Circuit.** An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Appeals for the Federal Circuit, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

**35 U.S.C. 142. Notice of appeal.** When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent and Trademark Office his reasons of appeal, specifically set forth in writing within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints.

**35 U.S.C. 143. Proceedings on appeal.** The United States Court of Appeals for the Federal Circuit shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee and in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent and Trademark Office, in writing, touching all the points involved by reasons of appeal.

**35 U.S.C. 144. Decision on appeal.** The United States Court of Appeals for the Federal Circuit, on petition, shall hear and determine such appeal on the evidence produced before the Patent and Trademark Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent and Trademark Office and govern the further proceedings in the case.

**37 CFR 1.302. Notice and reasons of appeal.** (a) When an appeal is taken to the U.S. Court of Appeals for the Federal Circuit, the appellant shall give notice thereof to the Commissioner, and file in the Patent and Trademark Office, within the time specified in § 1.304, his or her reasons of appeal specifically set forth in writing.

(b) In interferences and other contested cases, the notice and reasons must be served as provided in § 1.248.

If an appellant is dissatisfied with the decision of the Board of Appeals and desires to have said decision reviewed on the record, he or she must file a "Notice of Appeal" in the Patent and Trademark Office, within 60 days after the date of the Board's decision or 30 days from a decision on reconsideration, in order to have the Court of Appeals for the Federal Circuit consider his or her appeal. See 35 U.S.C. 142.

At the same time the original Notice of Appeal is filed in the Patent and Trademark Office, the appellant should file a copy thereof along with the \$65 docket fee with the Clerk of the Court of Appeals for the Federal Circuit. The appeal is docketed and acknowledged by the court upon receipt of a certified listing of contents from the solicitor, who secures and forwards same automatically upon receipt of the original notice of appeal.

After the court has heard and decided the appeal, a copy of the decision is sent to the Patent and Trademark Office and one to the appellant. Where the appellant files a petition for rehearing, the Court's ruling thereon is communicated to the Office and to the appellant by the Clerk of the Court.

Finally, the Clerk of the Court forwards to the Office a certified copy of the Court's decision on the appealed claims. This copy is a duplicate of the uncertified copy first forwarded, unless modified as a result of the petition for rehearing or possibly, altered to correct some minor error. The date of receipt of this copy by the Patent and Trademark Office marks the conclusion of the appeal. *Continental Can Company, Inc. v. Schuyler*, 168 USPQ 625. The decision of the Court is published; but unless the application becomes a patent, the Patent and Trademark Office does not give the public access to the application file. Since a transcript of the application becomes a part of the court record, it may of course be inspected there by anyone, *In re Mosher*, 45 CCPA 701, 115 USPQ 140.

The Solicitor enters the certified copy of the Court's decision in the application or patent file and returns it to the primary examiner.

#### ACTION FOLLOWING DECISION BY COURT

1. All claims rejected. If all claims in the case stand rejected, proceedings on the application are considered terminated on the date of receipt of the Court's certificate and the application is not open to subsequent amendment and prosecution by the applicant since the application is no longer considered pending. *Continental Can Company, Inc. V. Schuyler*, 168 USPQ 625 (D.C.D.C. 1970). Exceptions may occur where the court mandate clearly indicates that another action is to be taken.

2. Some claims allowed. If some claims in the case stand allowed, either by reversal of the Office decision by the Court or the Board of Appeals or by having been allowed by the examiner, proceedings are considered terminated as to the rejected claims. Action by the applicant canceling the rejected claims is not considered necessary. The examiner will pass the case for issue forthwith on the allowed claims, the applicant being advised of such action. The rejected claims may be canceled by the examiner with an appropriate notation on the margin, to avoid confusion of the printer. However, if formal matters remain to be attended to, the examiner should take appropriate action on such matters, setting a 30 day shortened period for reply, but the application is considered closed to further prosecution except as to such matters. If all claims in the case stand allowed after the Court's decision formal matters if any should be taken care of and the case passed for issue.

3. Remand. If the decision of the Court is such that it brings certain claims up for action on the merits, such as a decision allowing generic claims in a case containing claims to non-elected species not previously acted upon, the examiner will take the case up for appropriate action on the matters thus brought up, but

the case is not considered open to further prosecution except as to such matters. A remand by the Court is a remand to the Board of Appeals and not to the examiner. The examiner may only act on the application if it is remanded to him or her by the Board. Note In re Fisher, 171 USPQ 292.

4. Reopening of prosecution. In unusual situations it may be desirable to reopen prosecution of an application after a court decision. Office actions proposing to reopen prosecution after a court decision must be forwarded to the Deputy Assistant Commissioner for Patents for approval. The Deputy Assistant Commissioner for Patents will indicate his approval to reopen on the Office action.

#### DISMISSAL OF APPEAL

After the appeal is docketed in the Court, failure to prosecute the appeal, as by failure to print the record or failure to file the brief, will result in dismissal of the appeal by the Court; or there may be a dismissal by the Court at the request of the appellant. The proceedings are considered terminated and the application abandoned if applicable as of the date of dismissal, see § 1215.05.

After dismissal, if no claims stand allowed the action taken by the examiner will be the same as set forth in paragraph 1 above; if claims stand allowed the action is in accordance with paragraph 2.

#### 1216.02 Civil Suits

37 CFR 1.303. *Civil action under 35 U.S.C. 145, 146, 306.* (a) Any applicant or any owner of a patent involved in a reexamination proceeding dissatisfied with the decision of the Board of Appeals, and any party dissatisfied with the decision of the Board of Patent Interferences, may, instead of appealing to the U.S. Court of Appeals for the Federal Circuit (§ 1.301), have remedy by civil action under 35 U.S.C. 145 or 146, as appropriate. Such civil action must be commenced within the time specified in § 1.304.

(b) If an applicant in an ex parte case or an owner of a patent involved in a reexamination proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit, he or she thereby waives his or her right to proceed under 35 U.S.C. 145.

(c) If any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an interference proceeding files notice with the Commissioner within twenty days after the filing of the defeated party's notice of appeal to the court (§ 1.302), that he or she elects to have all further proceedings conducted as provided in 35 U.S.C. 146, certified copies of such notices will be transmitted to the U.S. Court of Appeals for the Federal Circuit for such action as may be necessary. The notice of election must be served as provided in § 1.248.

35 U.S.C. 145. *Civil action to obtain patent.* An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Appeals for the Federal Circuit, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

If an appellant is dissatisfied with the decision of the Board of Appeals and desires to have said decision reviewed, within 60 days after the date of the Board's decision or 30 days after the date of the Board's decision on reconsideration, he or she must file a complaint in the United States District Court for the District of Columbia and have the marshal serve a summons on the Commissioner of Patents and Trademarks.

When a suit under 35 U.S.C. 145 is filed a notice thereof signed by the Solicitor of the Patent and Trademark Office is placed in the application or patent file. The file is kept in the Solicitor's office pending termination of the suit. When the suit is terminated, a statement indicating the final disposition of it by the Court is placed on the original notice by the Solicitor and the application is returned to the examiner, whose subsequent procedure is the same as action following appeal, described in § 1216.01. If the exact date when proceedings were terminated is material, it may be ascertained by inquiring at the Solicitor's office.

The appellant ordinarily furnishes to the court a certified copy of the file wrapper and contents at the time of the trial (28 U.S.C. 1744). If the suit is dismissed before coming to trial, no disclosure of the application to the public necessarily results. Unlike an appeal to the U.S. Court of Appeals for the Federal Circuit, the filing of a civil action does not require the immediate filing of a transcript of the application. The complaint, however, is open to the public.

Files subpoenaed by the Court may be sent to the Court in care of a Patent and Trademark Office employee along with a certified copy, under stipulation that the copy be retained by the court and the original brought back to the Office by said employee.