

by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief may not be extended.

(c) The examiner will consider both the appellant's and respondent's briefs and may prepare an examiner's answer under § 1.969.

(d) Any appellant may file a rebuttal brief under § 1.971 within one month of the date of the examiner's answer. The time for filing a rebuttal brief may not be extended.

(e) No further submission will be considered and any such submission will be treated in accordance with § 1.939.

§ 1.965 Appellant's brief in *inter partes* reexamination.

(a) Appellant(s) may once, within time limits for filing set forth in § 1.963, file a brief in triplicate and serve the brief on all other parties to the *inter partes* reexamination proceeding in accordance with § 1.903. The brief must be signed by the appellant, or the appellant's duly authorized attorney or agent and must be accompanied by the requisite fee set forth in § 1.17(c). The brief must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

(b) A party's appeal shall stand dismissed upon failure of that party to file an appellant's brief, accompanied by the requisite fee, within the time allowed.

(c) The appellant's brief shall contain the following items under appropriate headings and in the order indicated below, unless the brief is filed by a party who is not represented by a registered practitioner. The brief may include an appendix containing only those portions of the record on which reliance has been made.

(1) *Real Party in Interest.* A statement identifying the real party in interest.

(2) *Related Appeals and Interferences.* A statement identifying by number and filing date all other appeals or interferences known to the appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing

on the decision of the Board of Patent Appeals and Interferences in the pending appeal.

(3) *Status of Claims.* A statement of the status of all the claims, pending or canceled. If the appellant is the patent owner, the appellant must also identify the rejected claims whose rejection is being appealed. If the appellant is a third party requester, the appellant must identify the claims that the examiner has made a determination favorable to patentability, which determination is being appealed.

(4) *Status of Amendments.* A statement of the status of any amendment filed subsequent to the close of prosecution.

(5) *Summary of Invention.* A concise explanation of the invention or subject matter defined in the claims involved in the appeal, which shall refer to the specification by column and line number, and to the drawing(s), if any, by reference characters.

(6) *Issues.* A concise statement of the issues presented for review. No new ground of rejection can be proposed by a third party requester appellant.

(7) *Grouping of Claims.* If the appellant is the patent owner, for each ground of rejection in the Right of Appeal Notice which appellant contests and which applies to a group of two or more claims, the Board of Patent Appeals and Interferences shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together; and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of this group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

(8) *Argument.* The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the bases therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate, numbered heading.

(i) For each rejection under 35 U.S.C. 112, first paragraph, or for each determination favorable to patentability, including a determination not to make a proposed rejection under 35 U.S.C. 112, first paragraph, which appellant contests, the argument shall specify the errors in the rejection or the determination and how the first paragraph of 35 U.S.C. 112 is complied with, if the appellant is the patent owner, or is not complied with, if the appellant is a third party requester, including, as appropriate, how the specification and drawing(s), if any,

(A) Describe, if the appellant is the patent owner, or fail to describe, if the appellant is a third party requester, the subject matter defined by each of the appealed claims; and

(B) Enable, if the appellant is the patent owner, or fail to enable, if the appellant is a third party requester, any person skilled in the art to make and use the subject matter defined by each of the appealed claims.

(ii) For each rejection under 35 U.S.C. 112, second paragraph, or for each determination favorable to patentability including a determination not to make a proposed rejection under 35 U.S.C. 112, second paragraph, which appellant contests, the argument shall specify the errors in the rejection, if the appellant is the patent owner, or the determination, if the appellant is a third party requester, and how the claims do, if the appellant is the patent owner, or do not, if the appellant is a third party requester, particularly point out and distinctly claim the subject matter which the inventor regards as the invention.

(iii) For each rejection under 35 U.S.C. 102 or for each determination favorable to patentability including a determination not to make a proposed rejection under 35 U.S.C. 102 which appellant contests, the argument shall specify the errors in the rejection, if the appellant is the patent owner, or determination, if the appellant is a third party requester, and why the appealed claims are, if the appellant is the patent owner, or are not, if the appellant is a third party requester, patentable under 35 U.S.C. 102, including any specific limitations in the appealed

claims which are or are not described in the prior art.

(iv) For each rejection under 35 U.S.C. 103 or for each determination favorable to patentability, including a determination not to make a proposed rejection under 35 U.S.C. 103 which appellant contests, the argument shall specify the errors in the rejection, if the appellant is the patent owner, or determination, if the appellant is a third party requester. If appropriate, also state the specific limitations in the appealed claims which are or are not described in the prior art and explain how such limitations render the claimed subject matter obvious, if the appellant is a third party requester, or unobvious, if the appellant is the patent owner, over the prior art. If the rejection or determination is based upon a combination of references, the argument shall explain why the references, taken as a whole, do or do not suggest the claimed subject matter. The argument should include, as may be appropriate, an explanation of why features disclosed in one reference may or may not properly be combined with features disclosed in another reference. A general argument that all the limitations are or are not described in a single reference does not satisfy the requirements of this paragraph.

(v) For any rejection other than those referred to in paragraphs (c)(8)(i) to (iv) of this section or for each determination favorable to patentability, including any determination not to make a proposed rejection other than those referred to in paragraphs (c)(8)(i) to (iv) of this section which appellant contests, the argument shall specify the errors in the rejection, if the appellant is the patent owner, or determination, if the appellant is a third party requester, and the specific limitations in the appealed claims, if appropriate, or other reasons, which cause the rejection or determination to be in error.

(9) *Appendix*. An appendix containing a copy of the claims appealed by the appellant.

(10) *Certificate of Service*. A certification that a copy of the brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended brief. If the appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

§ 1.967 Respondent's brief in *inter partes* reexamination.

(a) Respondent(s) in an *inter partes* reexamination appeal may once, within the time limit for filing set forth in § 1.963, file a respondent brief in triplicate and serve the brief on all parties in accordance with § 1.903. The brief must be signed by the party, or the party's duly authorized attorney or agent, and must be accompanied by the requisite fee set forth in § 1.17(c). The brief must state the authorities and arguments on which respondent will rely. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown. The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed. A third party respondent brief may not address any brief of any other third party.

(b) The respondent brief shall contain the following items under appropriate headings and in the order here indicated, and may include an appendix containing only those portions of the record on which reliance has been made.

(1) *Real Party in Interest*. A statement identifying the real party in interest.

(2) *Related Appeals and Interferences*. A statement identifying by number and filing date all other appeals or interferences known to the respondent, the respondent's legal representative, or assignee (if any) which will directly affect or be directly affected by or have a bearing on the decision of the Board of Patent Appeals and Interferences in the pending appeal.

(3) *Status of claims*. A statement accepting or disputing appellant's state-

ment of the status of claims. If appellant's statement of the status of claims is disputed, the errors in appellant's statement must be specified with particularity.

(4) *Status of amendments*. A statement accepting or disputing appellant's statement of the status of amendments. If appellant's statement of the status of amendments is disputed, the errors in appellant's statement must be specified with particularity.

(5) *Summary of invention*. A statement accepting or disputing appellant's summary of the invention or subject matter defined in the claims involved in the appeal. If appellant's summary of the invention or subject matter defined in the claims involved in the appeal is disputed, the errors in appellant's summary must be specified.

(6) *Issues*. A statement accepting or disputing appellant's statement of the issues presented for review. If appellant's statement of the issues presented for review is disputed, the errors in appellant's statement must be specified. A counter statement of the issues for review may be made. No new ground of rejection can be proposed by a third party requester respondent.

(7) *Argument*. A statement accepting or disputing the contentions of the appellant with each of the issues. If a contention of the appellant is disputed, the errors in appellant's argument must be specified, stating the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading. An argument may be made with each of the issues stated in the counter statement of the issues, with each counter-stated issue being treated under a separate heading. The provisions of § 1.965 (c)(8)(iii) and (iv) of these regulations shall apply to any argument raised under 35 U.S.C. 102 or sec. 103.

(8) *Certificate of Service*. A certification that a copy of the respondent brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

(c) If a respondent brief is filed which does not comply with all the requirements of paragraph (b) of this section,