DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO–P–2009–0020]

Procedure for Treating Rejected Claims That Are Not Being Appealed

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Request for comments.

SUMMARY: The United States Patent and Trademark Office (USPTO) is considering changes to the procedure for handling notices of appeal and appeal briefs that identify fewer than all of the rejected claims as being appealed. Under the proposed procedure, if appellant files a notice of appeal, or an appeal brief, that clearly identifies fewer than all of the rejected claims as being appealed, the non-appealed rejected claims would be deemed canceled by operation of this action on the part of the appellant as of the date on which such a notice of appeal, or appeal brief, is filed, regardless of whether the appellant also files an amendment canceling the non-appealed rejected claims. The USPTO is requesting comments from the public regarding the proposed procedure set forth in this notice.

COMMENT DEADLINE DATE: To be ensured of consideration, written comments must be received on or before January 13, 2010. No public hearing will be held.

ADDRESSES: Written comments should be sent by electronic mail message over the Internet addressed to *PatentPractice@uspto.gov.* Comments may also be submitted by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313–1450, marked to the attention of Joni Y. Chang. Although comments may be submitted by mail, the Office prefers to receive comments via the Internet.

The written comments will be available for public inspection at the Office of the Commissioner for Patents, located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia, and will be available via the Office's Internet Web site (address: *http://www.uspto.gov*). Because comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT: Joni Y. Chang, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, directly by telephone to (571) 272–7720, or by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313–1450.

SUPPLEMENTARY INFORMATION: The USPTO is considering changes to the procedure for handling notices of appeal and appeal briefs that identify fewer than all of the rejected claims as being appealed, in view of *Ex parte Ghuman,* 88 USPQ2d 1478 (Bd. Pat. App. & Int. 2008) (precedential) (provides for remand by the Board of Patent Appeals and Interferences (BPAI) if the examiner does not cancel claims identified as being not on appeal; the non-appealed rejected claims were considered withdrawn from the appeal where appellant limited the appeal to fewer than all of the pending rejected claims in the appeal brief). The USPTO is requesting comments from the public regarding the proposed procedure set forth in this notice because the USPTO desires the benefit of public comment. The USPTO will consider and address any relevant comments received.

Background: After receiving a notification of an Office action that contains one or more rejections, applicant must file a reply to the Office action within the time period for reply set forth in the Office action to avoid abandonment of the application. *See* 35 U.S.C. 133. Pursuant to 35 U.S.C. 134, applicant may appeal the examiner's decision to the BPAI by filing a notice of appeal under 37 CFR 41.31 if at least one claim has been twice rejected. 37 CFR 1.113(c) provides that a reply to a final Office action is required to include cancellation of each rejected claim or appeal from the rejection of each rejected claim. For a reply to a non-final Office action, the applicant must address every ground of rejection set forth in the non-final action or cancel each rejected claim subject to any ground of rejection not addressed in the reply. *See* 37 CFR 1.111(b).

There is no provision in 35 U.S.C. 134 or 37 CFR 1.113 for an applicant to appeal only a part of the examiner's decision. An appeal under 37 CFR 41.31 must be taken from the rejection of all claims under rejection which the applicant proposes to contest. *See* 37 CFR 41.31(c). In order to treat a notice of appeal as a proper reply to the Office action, the notice of appeal is considered an appeal to the entire examiner's decision, provided that the notice of appeal is accompanied by the required fee set forth in 37 CFR 41.20(b)(1) and is filed within the time period for reply set forth in the Office action. Therefore, if appellant does not wish to contest one of the rejected claims, appellant must file an amendment canceling that claim. The amendment must be filed separately from the notice of appeal and appeal brief.

Notwithstanding the provisions of 35 U.S.C. 133 and 134, and 37 CFR 1.111(b) and 1.113(c), some appellants file notices of appeal or appeal briefs that attempt to limit the appeal to fewer than all of the rejected claims without filing an amendment to cancel the non-appealed rejected claims. It has long been USPTO practice that an appellant must either appeal from the rejection of all of the rejected claims or cancel those claims not being appealed. *See Ex parte Benjamin,* 1903 Dec. Comm. Pat. 132, 134 (1903). Thus, attempts to limit an appeal to fewer than all of the rejected claims, either by filing a notice of appeal or appeal brief that attempts to limit the appeal to fewer than all of the rejected claims, operates to withdraw the appeal as to the non-appealed rejected claims and operates as a cancellation of those claims from the application. *See* Manual of Patent Examining Procedure (MPEP) § 1215.03.

Proposed Procedure: Under the proposed procedure, if appellant clearly limits the appeal to fewer than all of the rejected claims in a notice of appeal, or an appeal brief, the non-appealed rejected claims would be deemed canceled by operation of this action on the part of the appellant as of the date on which such a notice of appeal, or appeal brief, is filed. The examiner should note in the examiner's answer that the non-appealed rejected claims are deemed canceled. However, a failure to note the cancellation of non-appealed rejected claims will not affect the canceled status of these claims because the non-appealed rejected claims are deemed canceled as of the date on which the notice of appeal, or appeal brief, is filed. Therefore, an application will not be returned or remanded by the BPAI for correction merely due to a failure of an examiner's answer to note the cancellation of non-appealed rejected claims. After the decision by the BPAI and the jurisdiction is transferred back to the examiner for further action, or the prosecution is reopened without a decision by the BPAI, the examiner will notify appellant of the cancellation of the non-appealed rejected claims in the next Office action, unless the application is abandoned. For example, the examiner may include the following statement in the examiner's answer or in the next Office action after a BPAI decision: ''Claims 4–5 are deemed canceled because appellant

attempted to limit the appeal to fewer than all of the rejected claims by submitting an identification of claims being appealed that did not include these rejected claims in the notice of appeal or the appeal brief.''

37 CFR 41.31 does not provide for an identification of the claims whose rejection is being appealed. A notice of appeal that does not identify any claims would be accepted as an appeal of all of the rejected claims, unless the appeal brief indicates otherwise. Therefore, if appellant files a notice of appeal and appeal brief that do not clearly limit the appeal to fewer than all of the rejected claims, all of the rejected claims would be considered to be on appeal. The BPAI will have the jurisdiction to review the examiner's decision as to all of the rejected claims and all of the grounds of rejection set forth by the examiner.

If a notice of appeal does not identify the claims on appeal and its appeal brief contains inconsistency regarding whether all of the rejected claims are being appealed (*e.g.,* appellant lists fewer than all of the rejected claims in the status of claims section of the appeal brief and then lists all of the rejected claims in the grounds of rejection to be reviewed on appeal section, or other sections, of the appeal brief), all of the rejected claims would be considered to be on appeal. If a notice of appeal does not identify the claims on appeal and all of the sections of its appeal brief consistently identify fewer than all of the rejected claims being appealed, then the appeal brief has clearly limited the appeal to fewer than all of the rejected claims and the non-appealed rejected claims will be deemed canceled by operation of the filing of such an appeal brief as of the date on which the appeal brief is filed.

The proposed procedure will apply to notices of appeal and appeal briefs filed under 37 CFR 41.31 and 41.37. Similarly, the proposed procedure will also apply to notices of appeal or cross appeal and appeal briefs filed by patent owners in *ex parte* and *inter partes* reexamination proceedings.

Dated: December 8, 2009.

David J. Kappos,

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

[FR Doc. E9–29641 Filed 12–11–09; 8:45 am]

BILLING CODE 3510–16–P

DEPARTMENT OF COMMERCE

International Trade Administration

Quarterly Update to Annual Listing of Foreign Government Subsidies on Articles of Cheese Subject to an In–Quota Rate of Duty

AGENCY: Import Administration, International Trade Administration, Department of Commerce.

EFFECTIVE DATE: December 14, 2009.

FOR FURTHER INFORMATION CONTACT: Gayle Longest, AD/CVD Operations, Office 3, Import Administration, International Trade Administration, U.S. Department of Commerce, 14th Street and Constitution Ave., NW, Washington, DC 20230, telephone: (202) 482–3338.

SUPPLEMENTARY INFORMATION: Section 702 of the Trade Agreements Act of 1979 (as amended) (''the Act'') requires the Department of Commerce (''the Department'') to determine, in consultation with the Secretary of Agriculture, whether any foreign government is providing a subsidy with respect to any article of cheese subject to an in–quota rate of duty, as defined in section 701(c)(1) of the Act, and to publish an annual list and quarterly updates to the type and amount of those subsidies. We hereby provide the Department's quarterly update of subsidies onarticles of cheese that were imported during the period July 1, 2009, through September 30, 2009.

The Department has developed, in consultation with the Secretary of Agriculture, information on subsidies (as defined in section 702(h)(2) of the Act and section 771(5) of the Tariff Act of 1930, as amended (''Tariff Act'')), being provided either directly or indirectly by foreign governments on articles of cheese subject to an in–quota rate of duty. The appendix to this notice lists the country, the subsidy program or programs, and the gross and net amounts of each subsidy for which information is currently available. The Department will incorporate additional programs which are found to constitute subsidies, and additional information on the subsidy programs listed, as the information is developed.

The Department encourages any person having information on foreign government subsidy programs which benefit articles of cheese subject to an in–quota rate of duty to submit such information in writing to the Assistant Secretary for Import Administration, U.S. Department of Commerce, 14th Street and Constitution Ave., NW, Washington, DC 20230.

This determination and notice are in accordance with section 702(a)(2) of the Act.

Dated: December 3, 2009.

Ronald K. Lorentzen,

Deputy Assistant Secretary for Import Administration.

APPENDIX

SUBSIDY PROGRAMS ON CHEESE SUBJECT TO AN IN–QUOTA RATE OF DUTY

Country	Program(s)	Gross[1] Subsidy($/lb)	Net[2] Subsidy($/lb)
27 European Union Member States[3] ..	European Union Restitution Payments	$0.00	$0.00
Canada	Export Assistance on Certain Types of Cheese	$ 0.32	$0.32
Norway	Indirect (Milk) Subsidy	$ 0.00	$0.00
.....	Consumer Subsidy	$ 0.00	$ 0.00
.....	Total	$ 0.00	$ 0.00
Switzerland	Deficiency Payments	$ 0.00	$ 0.00

[1] Defined in 19 U.S.C. 1677(5).

[2] Defined in 19 U.S.C. 1677(6).

[3] The 27 member states of the European Union are: Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden, and the United Kingdom.