

## MEMORANDUM

To: All PTAB Users

From: Scott R. Boalick, Chief Administrative Patent Judge

Subject: Guidance Memorandum for the *Ex Parte* Appeals Process

Date: July 13, 2023

This memorandum provides, in a streamlined and single source, information regarding existing practice as it pertains to opinion writing and other internal procedures for *ex parte* appeals at the Patent Trial and Appeal Board (“PTAB” or “Board”). Previous memoranda on this topic issued by the Board are no longer in effect. Some of the guidance overridden by this memorandum had been outdated and not in effect for years. This memorandum clarifies the Board’s current, operable written guidance and reaffirms that there is no oral or other guidance that controls Board action other than formal written guidance.

### I. FORM OF OPINION

#### *A. Reaching All Issues in the Case of an Affirmance, With Certain Exceptions*

In an appeal, panels are expected to reach all grounds of rejection for an affirmance, with certain limited exceptions, in order to provide a comprehensive review of the rejections on appeal.

The exceptions are as follows.

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1) In a case of claim indefiniteness, where application of the prior art to the claims would require speculation as to the scope of the claims, the panel may reverse *pro forma* the prior art rejections. *See In re Steele*, 305 F.2d 859, 862 (CCPA 1962).

2) The panel need not reach certain provisional obviousness-type double patenting (ODP) rejections, as discussed in Section II.E below.

### *B. Selecting Dispositive Issues in the Case of a Reversal*

A panel is encouraged to use the Appellant's arguments and the Examiner's response to frame a dispositive issue (or issues) in the case of a reversal. Therefore, when a panel analyzes the properly-framed issue in the decision, only arguments directed to the dispositive issue(s) need to be addressed. Consolidating or summarizing repetitive arguments can be helpful in this regard. This technique will avoid needlessly addressing irrelevant arguments.

As an example, an Appellant argues that the cited prior art in a rejection does not disclose four different limitations, and the panel agrees with the Appellant regarding one of the four limitations. The lack of that one limitation in the prior art is dispositive regarding that rejection (i.e., the rejection will be reversed). In these situations, there is generally no need to address any of the Appellant's other arguments for that rejection.

As another example, an Appellant relies on only one argument with respect to multiple rejections (e.g., alleging no reason to combine two references that are the basis for multiple rejections). In that case, the same issue is dispositive for each of the rejections, and the rejections can be addressed together.

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### *C. Handling of Claim Grouping*

The rule on claim grouping, 37 C.F.R. § 41.37(c)(1)(iv), provides for the situation “[w]hen multiple claims subject to the same ground of rejection are argued as a group or subgroup by appellant.” Thus, the rule on claim grouping applies to claims subject to the **same ground of rejection**.

A panel must look to the arguments raised in the Appellant’s briefs to determine whether claims subject to the same ground of rejection have been argued as a group or whether the Appellant has presented separate arguments for certain claims. It is best practice to clearly explain in our opinions how and why we are considering the claims to be grouped.

The following are specific issues for claim grouping.

1) A panel should not treat claims subject to different grounds of rejection as a group. If the same analysis applies across multiple grounds of rejection, it is best practice to make it clear why and how the analysis applies to each ground of rejection.

2) An opinion should focus on the Appellant’s arguments and address Appellant’s arguments as relevant.

If an argued limitation appears in some, but not all, of the grouped claims, then the opinion should make clear that the argument has been considered but applies only to claims containing the limitation. The opinion must, in any event, clearly explain whether Appellant’s arguments overcome a rejection of those claims containing the argued limitation. If Appellant fails to present arguments that apply to all the grouped claims, then it is appropriate to say that no argument has been presented with respect to claims which do not contain the argued limitation(s).

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### *D. Concurrences and Dissents*

As has been customary, where judges on a panel have additional or dissenting views, they may express them in concurring or dissenting opinions as they deem appropriate. Such views are an important part of the judicial process.

## II. GUIDANCE FOR MERITS REVIEW OF APPEAL BRIEFS, REPLY BRIEFS, AND EXAMINER'S ANSWERS

### *A. Remands*

A panel does not have the authority to hold the Appellant's appeal brief as non-compliant.<sup>1</sup> Rather, the appeal should be decided based on the briefing as it stands in the official record. If a panel has any concerns regarding the completeness of a prosecution file, it should contact the Case Management Branch (under the Chief Clerk of the Board). *See* 37 C.F.R. § 41.35(e). A panel may also optionally reach out to Management review on whether a case needs to be remanded.<sup>2,3</sup>

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<sup>1</sup> MPEP § 1205.03 (Non-Compliant Appeal Brief and Amended Brief) provides that “[t]he Patent Appeal Center has the responsibility for determining whether appeal briefs filed in patent applications comply with 37 CFR 41.37, and will complete the determination before the appeal brief is forwarded to the examiner for consideration.” This section of the MPEP continues “[o]nce an appeal brief is accepted by the Board as in compliance with 37 CFR 41.37, the appeal brief will not later be held as defective by the Patent Appeal Center or the examiner. The Board will not return or remand the application to the examiner for issues related to a non-compliant appeal brief.” *Id.*

<sup>2</sup> In addition to an administrative remand by the Case Management Branch, a panel may remand a case (resulting in a “panel remand”) in the rare occasion when there is a procedural issue that must be addressed by the Examiner because without the issue being addressed, the panel is precluded from a practical point of view from reviewing the rejection.

<sup>3</sup> The Board no longer uses returns to Patents.

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If the record does not indicate whether an after-final amendment was entered or not entered by the Examiner, the panel must bring this problem to the attention of the Case Management Branch (under the Chief Clerk of the Board) for an administrative remand to the Examiner.

### *B. Mooted Appeals – Request for Continued Examination (RCE), Application Abandoned, or Appeal Withdrawn*

If the merits panel finds that the appeal is moot (e.g., an RCE was filed, the appeal was withdrawn, or the application was abandoned), then the panel must bring this situation to the attention of the Case Management Branch (under the Chief Clerk of the Board) for appropriate administrative processing.

### *C. Petitions and Petitionable Matters*

The line of demarcation between appealable matters for the Patent Trial and Appeal Board (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board. MPEP § 1201.

#### *1. Failure to Timely Petition a Petitionable (Non-Appealable) Matter*

The Board ordinarily lacks authority to review a petitionable matter.<sup>4</sup> When an Appellant has failed to timely file a petition on a petitionable

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<sup>4</sup> See, e.g., *Ex parte Oates*, 2015 WL 4035960, Appeal No. 2013-006966 (PTAB June 29, 2015) (non-precedential) (citing, e.g., *In re Berger*, 279 F.3d 975, 984 (Fed. Cir. 2002)); *but cf.* MPEP § 2163.06(II) (“If both the claims and specification contain new matter either directly or indirectly, and

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matter, the matter will stand as unchallenged and the panel will decide the appeal accordingly.

### 2. *Decided Petitions*

The Board lacks authority to review a petition decision of the Director or his designee. Before the Board, a petition decision will stand and the panel will decide the appeal accordingly.

### 3. *Undecided Petitions*

If the merits panel finds that a petition has not been decided which is critical to a decision on the merits (i.e., decision of the petition would change or moot the panel's decision on the merits, such as granting claim amendment entry), then the panel must bring this problem to the attention of the Case Management Branch (under the Chief Clerk of the Board) for appropriate administrative processing.

If a decision on the petition is not critical to a decision on the merits, then the panel will decide the appeal accordingly.

### D. *Missing Reference*

Copies of United States patents and United States published applications are not included in the official electronic record of an application on appeal. When a panel needs a copy of such a reference, the reference is retrieved from USPTO electronic databases. The panel can contact the PTAB Appeals Admin mailbox for assistance.

All other types of references (e.g., published articles, foreign patents) are routinely made part of the official record of an application. When a panel finds that such a reference is missing from the official record (PE2E),

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there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition.”)

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it is recommended that the merits panel decide the appeal according to how the reference was used in the office action from which the appeal has arisen and what the Appellant has argued on appeal. The following are examples of diverse situations that may be found:

1) The Appellant's arguments in the Appeal Brief challenge the propriety of the rejection due to the USPTO's failure to supply the reference, and the Appellant does not dispute the Examiner's characterization of the missing reference's disclosure.

Failure to supply the reference is a petitionable matter and is not within the jurisdiction of the Board. It is recommended that the merits panel acknowledge both (1) that the Appellant does not dispute or challenge the Examiner's characterization of the reference, and (2) the panel's own reliance upon the Examiner's characterization of the reference in the opinion. The panel will then decide the appeal accordingly.

2) The Appellant's arguments challenge the propriety of the rejection due to the USPTO's failure to supply the reference, and the Appellant disputes the Examiner's characterization of the missing reference's disclosure. Typically, it is recommended that the merits panel vacate the rejection based upon the Board's inability to address the Appellant's arguments directed to the Examiner's characterization of the reference. The Board's decision should not be based on the USPTO's failure to supply the reference. See the discussion in 1) above.

3) The Appellant does not dispute the Examiner's characterization of the missing reference's disclosure. It is recommended that the panel rely on the Examiner's characterization of the reference and decide the appeal based thereon. It is recommended that the merits panel acknowledge both (1) that the Appellant does not dispute or challenge the Examiner's characterization

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of the reference, and (2) the panel's own reliance upon the Examiner's characterization of the reference in the opinion. The panel will then decide the appeal accordingly.

(Note: Same result when the Appellant does not challenge the propriety of the rejection based on the missing reference's disclosure.)

Under these circumstances, it is also recommended that the merits panel include a statement (or footnote) in the opinion indicating that the Appellant had the opportunity (during examination before the Examiner or on appeal to the Board) to challenge the accuracy of the references relied upon, but did not do so and therefore has waived any right on further appellate review to challenge the accuracy of the Examiner's representations.

### *E. Obviousness-Type Double Patenting (ODP) and Provisional ODP*

If an appeal brief reaches a merits panel that contains an ODP rejection or a provisional ODP rejection, it is recommended that the panel handle the ODP rejection based on the particular facts of that appeal. The following are examples of diverse situations that may be found:

1) If the Appellant traverses the merits of the ODP or provisional ODP rejection in the Appeal Brief, then it is recommended that the merits panel decide the merits of the ODP appeal accordingly. But see the discussion of provisional ODP rejections in subparagraphs 2a and 2b below.

2) If the Appellant does not traverse the merits of the ODP or provisional ODP rejection in the Appeal Brief but the Appellant agrees to submit the necessary papers to overcome the double patenting rejection (i.e., a terminal disclaimer), then it is recommended that the panel summarily affirm the ODP rejection. But see the discussion of provisional ODP

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rejections in subparagraphs a and b below. This same recommendation applies if the Appellant has filed a terminal disclaimer but the Examiner has not yet considered it.

a) If there is a provisional ODP rejection and the claims in the other application (that is the basis for the rejection) have been amended subsequent to the rejection at issue, it is recommended that the panel decline to decide the appeal as to the provisional ODP rejection. *See In re Jerg*, Appeal No. 2011-000044 (BPAI Apr. 17, 2012) (informative).

b) If the application on appeal is senior (has earliest filing date) to the other application (that is the basis for the rejection), and the panel decides to reverse all other rejections on appeal, it is recommended that the panel decline to decide the appeal as to the provisional ODP rejection and specify that the Examiner process the provisional ODP rejection consistent with MPEP § 804. *See In re Moncla*, Appeal No. 2009-006448 (BPAI June 22, 2010) (precedential).

### *F. The Examiner's Answer Contains a New Ground of Rejection*<sup>5</sup>

If an appeal reaches a merits panel wherein the Examiner's answer contains a new ground of rejection (designated as such or not), it is recommended that the panel decide the appeal as to the new ground based on

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<sup>5</sup> MPEP § 1207.03(I) requires that any new ground of rejection made by an examiner in an answer must provide the appellant a two-month time period for reply, and must be:

(A) approved by a Technology Center (TC) Director or designee;

and

(B) prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section under the subheading "New Grounds of Rejection" of the answer (see MPEP § 1207.02).

The examiner may use form paragraph 12.256.

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the particular facts of that appeal. The following are examples of diverse situations that may be found:

1) If the Appellant alleges that the Examiner's answer contains an undesignated new ground of rejection and files a petition under 37 C.F.R. § 1.181(a) within two (2) months of the answer, then

a) the panel must report an undecided petition to the attention of the Case Management Branch (under the Chief Clerk of the Board) for appropriate administrative processing, or

b) the panel may follow the recommended appropriate guidance below based on the petition decision and any subsequent prosecution and/or briefing.

2) If the Examiner's answer **properly notified** the Appellant that a new ground of rejection has been presented, and the Appellant did not respond to the new ground of rejection in its reply brief or reopen prosecution, then the appeal is dismissed as to the claims subject to the new ground of rejection. *See* 37 C.F.R. § 41.39(b). It is recommended that the merits panel note this fact in its decision and decide the appeal as to only those claims not included in the new ground of rejection.

3) If the Examiner's answer appears to contain a new ground of rejection, but the answer **does not** comply with the new ground of rejection requirements (i.e., alerting the appellant that the answer contains a new ground), but the Appellant does not dispute the procedural propriety of the new rejection, then the merits panel shall decide the appeal based upon the rejections, including the new ground of rejection, as stated in the answer.

Important note: The appeal of the claims included in the undesignated new ground of rejection cannot be dismissed under 37 C.F.R. § 41.39(b)

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because that rule requires that the new ground of rejection be designated as such before the appeal of the claims can be dismissed for failure to respond.

4) If the Examiner's answer appears to have a new ground of rejection, but **does not** comply with the new ground of rejection requirements, and the Appellant disputes the procedural propriety of the new rejection by reply brief (without a petition), then the merits panel shall decide the appeal based upon the rejections, including the new ground of rejection, as stated in the answer. By failing to file a petition within two months of the answer, the Appellant is limited to submitting arguments in response to the rejections in the answer. *See* 37 C.F.R. § 41.40; MPEP § 1207.03(b).

### III. NEW GROUNDS OF REJECTION

An overriding principle of the Board is to ensure that Appellants are afforded due process. In cases that come before the Board, “due process” means that the Board must ensure that Appellants are given a fair opportunity to respond to the thrust of a rejection. *See In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005) (citing *In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976)). If the Board affirms an adverse decision of an Examiner based on new information or a new rationale, the Board must consider whether this decision changes the Examiner's decision in such a way that the Appellant has not been given a fair opportunity to respond to the thrust of the rejection. In such cases, the Board should consider designating the Board's decision as containing a new ground of rejection.

What constitutes a “new ground of rejection” is a highly fact-specific question. *See, e.g., In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976) (finding no new ground of rejection based upon “facts of this case” and rejecting other cases as controlling given “distinctive facts at bar”); *In re*

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*Ahlert*, 424 F.2d 1088, 1092 (CCPA 1970) (“[l]ooking at the facts of this case, we are constrained to hold” that a new ground was entered). There are no absolute rules for when a new ground of rejection has been made. The following are some general rules that may apply in some situations:

- If new evidence (such as a new prior art reference) is applied or cited for the first time in the Board’s decision (even in a minor capacity), and if the citation of a new prior art reference is necessary to support a rejection, then it should probably be included in the statement of rejection, which would be considered to introduce a new ground of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3 (CCPA 1970).

- A “position or rationale new to the proceedings”—even if based on evidence previously of record—may give rise to a new ground of rejection. *In re De Blauwe*, 736 F.2d 699, 706 n.9 (Fed. Cir. 1984) (stating that where the Office advances “a position or rationale new to the proceedings, an applicant must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence”).

- It is generally not a new ground of rejection, for example, if the Board’s decision responds to Appellant’s arguments using different language, or restates the reasoning of the rejection in a different way, so long as the evidence relied upon is the same and the “basic thrust of the rejection” is the same. *In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976); *see also In re Noznick*, 391 F.2d 946, 949 (CCPA 1968) (no new ground of rejection made when “explaining to appellants why their arguments were ineffective to overcome the rejection made by the examiner”); *In re Krammes*, 314 F.2d 813, 817 (CCPA 1963) (“It is well established that mere difference in form of expression of the reasons for finding claims unpatentable or unobvious over the references does not amount to reliance on a different ground of

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rejection.”); *In re Cowles*, 156 F.2d 551, 555 (CCPA 1946) (holding that the use of “different language” does not necessarily trigger a new ground of rejection).

### *A. Statutory and Regulatory Background; Discretionary Nature of New Ground*

It is optional, not mandatory, for a Board panel to issue a new ground of rejection, where it identifies such a ground. Our statutory role is not to determine patentability, but to review rejections made by primary examiners.

Our statutory role in *ex parte* appeals is set forth in 35 U.S.C. §§ 6(b) and 134. For *ex parte* appeals, § 6(b) provides that “[t]he Patent Trial and Appeal Board shall — (1) on written appeal of an applicant, *review* adverse decisions of examiners upon applications for patents” (emphasis added). Our statutory role as administrative patent judges is to review the grounds of rejection made by the Examiner to determine if the Examiner has erred.

In contrast, the Director’s statutory role for applications for patents is to determine patentability. This is set forth in 35 U.S.C. § 131. “The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, *the Director* shall issue a patent therefor.” *Id.* (emphasis added).

By rule, we have been delegated discretion to add a new ground of rejection. Section 41.50(b) of 37 C.F.R. states “[s]hould the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it *may* include in its opinion a statement to that effect with its reasons for so holding, and designate such a statement as a new ground of rejection of the claim” (emphasis added). The rule is permissive and merely

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provides the Board panel the option of making a new ground of rejection. Making a new ground of rejection is therefore an exercise of discretion.

### *B. Requirement of Unanimity*

A new ground of rejection in an opinion deciding an appeal shall only be entered when the panel is thoroughly convinced that the new ground of rejection is proper. Furthermore, the new ground of rejection shall be the unanimous decision of the panel. Finally, because making a new ground is an exercise of discretion, it is made solely at the option of the panel and thereby making such a ground is not a mandatory requirement.

### *C. An Affirmance May be Designated as a New Ground of Rejection*

A proper exercise of discretion is to designate an affirmance as a new ground of rejection where the panel provides a new or modified rationale for the grounds of rejection made by the Examiner and the panel determines that it would be unfair, i.e., a violation of due process, not to give an Appellant an opportunity to respond to the new or modified rationale. *See supra* Section III.A.

## IV. REQUESTS FOR ADDITIONAL BRIEFING UNDER 37 C.F.R. § 41.50(D)

In rare circumstances, the panel may send an order under § 41.50(d) requesting additional briefing from the Appellant for “assistance in reaching a reasoned decision on the pending appeal.” 37 C.F.R. § 41.50(d). For example, a panel might request additional briefing from the Appellant if there has been an intervening change in the law since the filing of the last brief. Nevertheless, we observe that by the time the appeal reaches the Board, the Appellant will already have had the opportunity to file an Appeal Brief and a Reply Brief and will be anticipating a decision on appeal. Based

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on historical practice, it is expected that in the vast majority of cases, the panel will be able to reach the merits of an appeal based on the existing briefing in docketed cases.

### V. TRANSLATIONS IN APPEALS

The Board receives a certain number of appeals in which the Examiner or the Appellant relies on a document (“translation”) translated from a non-English (foreign language) version of the document. Certified translations are not mandated by the Board in *ex parte* appeals.

*But cf.* 37 C.F.R. § 41.154(b) (form of evidence in contested cases); 37 C.F.R. § 42.63(b) (form of evidence in AIA trials).

Typically, a certified translation includes (1) a copy of the original document written in a language other than English, (2) an English language translation of the copy of the document, and (3) a certification by the translator that (a) the translator is competent to translate the document and (b) the translation is true and accurate. Such a translation, of course, is the best evidence of what the underlying document actually states.<sup>6</sup>

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<sup>6</sup> A certified translation is typically given the same force and effect as the original document. “By definition, a certified translation is a faithful reflection of the original—it neither adds nor subtracts. As such, a certified translation . . . is a facilitator, rather than a modifier . . .” *Torres Santa v. Rey Hernandez*, 279 F. Supp. 2d 124, 126–127 (D.P.R. 2003). *See for example*, 8 C.F.R. § 1003.33 Executive Office for Immigration Review, Department of Justice - Translation of documents:

Any foreign language document offered by a party in a proceeding shall be accompanied by an English language translation and a certification signed by the translator that must be printed legibly or typed. Such certification must include a statement that the translator is competent to translate the document, and that the translation is true and accurate to the best of the translator’s abilities.

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However, other forms of translation are often of record and have been relied upon during prosecution of the patent application. For instance, there may be an English language “equivalent” publication, a machine generated translation, or other uncertified translation. These forms of translation are uncertified hearsay evidence,<sup>7</sup> and they are accordingly of lesser evidentiary value than a certified translation. Although the Board may rely on such hearsay evidence,<sup>8</sup> appropriate care should be taken when weighing such evidence.

Certified translations are significantly more expensive compared to uncertified translations. In an effort to reduce unjustified costs, the Board will no longer request from the Examining Corps a certified translation. An appeal including an uncertified translation provided by the Examiner will now generally be decided based on the uncertified translation, unless challenged by the Appellant with evidence and/or argument supporting that challenge.

When the accuracy is unchallenged, the issue of the translation’s evidentiary value will be considered as being waived. For example, if the Examiner relies on an uncertified translation<sup>9</sup> and the Appellant does not

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<sup>7</sup> *United States v. Kramer*, 741 F. Supp. 893, 896 (S.D. Fla. 1990) (stating that uncertified translations are “technically hearsay”).

<sup>8</sup> *See In re Epstein*, 32 F.3d 1559, 1565 (Fed. Cir. 1994) (“The [hearsay] statements are out-of-court written assertions offered by the PTO to prove the truth of the matter asserted . . . . The inapplicability of hearsay evidence rules in *ex parte* PTO examination is appropriate in light of the purpose and reason for the hearsay rule.”).

<sup>9</sup> *See* MPEP § 2120 (Rejection of Prior Art) (“Examiners may rely on a machine translation of a foreign language document unless the machine translation is not of sufficient quality to be adequate evidence of the contents of the document. A request by the applicant for the examiner to obtain a human language translation should be granted if the applicant provides

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challenge the accuracy of the translation, the Board will generally rely on and decide the appeal on the basis of the translation.<sup>10</sup>

Under these circumstances, the panel may wish to include a statement (or a footnote) in the opinion to the effect that the Appellant had the opportunity (during examination before the Examiner or on appeal) to challenge the accuracy of the uncertified translation, but did not do so and therefore has waived any right to challenge on appeal before the Board the accuracy of the translation.<sup>11</sup> Use of the statement will preemptively address potential future arguments raised by Appellants pertaining to the translation and will preserve the record for appeal.

When an Appellant questions the accuracy of an uncertified translation, the Appellant bears the burden of demonstrating that the translation is not accurate.<sup>12</sup> The Examiner may respond to Appellant's challenge.

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evidence (e.g., a translation inconsistent with the machine translation) showing the machine translation does not accurately represent the document's contents." (citing *In re Orbital Technologies Corporation*, 603 F. App'x 924, 932 (Fed. Cir. 2015)); MPEP § 1207.02 (Examiner's Answer) ("If a document being relied upon by the examiner in support of a rejection is in a language other than English, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The translation may be a machine translation or an English equivalent of the non-English document.").

<sup>10</sup> The panel retains the discretion to assess the credibility of the translation if, for example, the translation appears on its face to be inaccurate. In this situation, the panel's analysis should include appropriate "credibility findings."

<sup>11</sup> See *U.S. v. Haywood*, 363 F.3d 200, 212–13 (3d Cir. 2004) (Defendant's failure to raise any issue concerning an interpreter's certification or qualifications resulted in waiver of this issue).

<sup>12</sup> See *Forest Labs., Inc. v. Ivax Pharms.*, 237 F.R.D. 106, 117 (D. Del. 2006) (holding that where the defendants had opportunity to provide a

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### A. *Challenge with Evidence*

During prosecution before the Examiner, an Appellant may challenge the accuracy of the uncertified translation and timely submit a certified translation or a second uncertified translation. If new evidence in the form of a second translation is timely submitted by the Appellant,<sup>13</sup> then on appeal the Board will determine how much weight will be given to each translation. While assessing the weight to be given competing uncertified translations is a matter to be decided on a case-by-case basis, a timely provided certified translation presumptively and generally would be more accurate and thus be given greater weight than one which is uncertified.

### B. *Challenge with Argument*

When timely arguments present good reason to suspect the accuracy of the translation (e.g., grammatically unclear or confusing) and demonstrate that the issue of accuracy is central to resolution of the appeal, the panel will give the translation its appropriate weight and decide the appeal accordingly. In this situation, the panel's analysis should set forth appropriate "credibility findings" of fact relied upon to give weight (or give no weight) to the translation evidence.

## VI. USE OF *PER CURIAM*

A panel of the Board may issue a *per curiam* decision. The definition of "per curiam," appearing in Black's Law Dictionary (11th ed. 2019) is "(Of an appellate judicial opinion) attributed to the entire panel of judges

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certified translation, they cannot complain that the lack of a certified translation prejudiced them. Additionally, the exhibit was introduced to demonstrate the existence of a Danish patent (not the substance of the patent) and so a certified translation was not necessary).

<sup>13</sup> *Cf.* 37 C.F.R. § 41.33(d) (prohibiting the submission of new evidence after the filing of an appeal with certain limited exceptions).

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who have heard the appeal and not signed by any particular judge on the panel.”<sup>14</sup> For example, where a panel of three judges issues an opinion or order under a *per curiam* authorship, this indicates that the opinion or order is attributed to all three judges on the panel.

Scott R. Boalick  
Chief Administrative Patent Judge

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<sup>14</sup> Black’s Law Dictionary also provides a definition for “per curiam opinion” as “[a]n opinion handed down by an appellate court without identifying the individual judge who wrote the opinion.”