

United States Patent and Trademark Office OG Notices: 02 July 2002Revised Docketing Procedures for
Appeals Arriving at the
Board of Patent Appeals and Interferences

Notice of revised appeal docketing procedures

Effective June 1, 2002, the Board of Patent Appeals and Interferences (Board) is adopting new docketing procedures which are designed to result in notification to the appellant within one month of receipt of an appealed application at the Board that (1) the appeal has been received at the Board and docketed, or (2) the appeal is being returned to the examiner for attention to unresolved matters.

Under procedures long in effect, each application containing an appeal under 35 U.S.C. 134 is subjected to a brief intake review (known as "outlining") upon arrival at the Board and a more in-depth review (known as "final paralegal specialist and administrator review") at a time immediately preceding assignment to a panel of administrative patent judges (APJs) for decision. Under existing procedures, an appeal number is assigned during the "outlining" review phase. The appeal, however, is not docketed to an APJ until the conclusion of the "final paralegal specialist and administrator review" phase. Sometimes the Board finds it necessary to remand an application under appeal to the examiner, prior to docketing the appeal to an APJ's docket, to permit the examiner or the appellant to attend to matters in the application.

It would be more efficient for all concerned (appellant, examiner and Board) if these reviews were to occur immediately after arrival of the application under appeal at the Board, so that any matters requiring further attention by the examiner or the appellant might be addressed while the necessary records remain readily available and individual recollections concerning the application are still fresh. Moreover, reserving the act of assigning an appeal number until such time as the appeal is ready for decision will result in a more accurate picture of the number of appeals actually pending before the Board at any particular time.

To allow such administrative corrections to occur more promptly and to ensure as much as possible that a case is properly in condition for deliberation when referred to a panel of administrative patent judges, the Board adopts the following appeal docketing procedures:

When an application appearing to include an appeal under 35 U.S.C. 134 for decision by the Board is received from the Patents operation, it will be reviewed for

1) gross formalities (including, but not limited to, matters such as the presence of a notice of appeal, appellant's brief, examiner's answer, and evidence of an appeal conference having been held, as in the present "outlining" and appeal conference review),

2) fine formalities (including, but not limited to, matters such as unacknowledged Information Disclosure Statements or other papers, and deficiencies in the brief or answer, as now in "final paralegal specialist and administrator review"), and,

3) status matters (including, but not limited to, matters such as the presence of communications from appellant beyond the brief, such as a reply brief or a request for oral hearing).

If the appeal is ready for docketing (that is, if no return of the case to the examiner is required per the review) three events will occur:

1) an appeal number will be assigned,

2) the Board will issue a docketing notice, identifying the relevant appeal contents (brief, reply brief if any, request for oral hearing if any, and the filing date of each such item), and

3) the appeal will be assigned to a master docket for subsequent reassignment to the docket of an individual APJ, or directly to the docket of an individual APJ.

If the appeal cannot be docketed due to matters requiring further attention in the Patents operation, the appeal will be administratively returned to the Patents operation with an order indicating why the appeal cannot be docketed (essentially those reasons that exist today for administrative remands) and notification of that return, in the form of a copy of the order, will be mailed to the appellant. No appeal number will be assigned until the appeal is ready for docketing.

The docketing notice or order indicating why the appeal cannot be docketed will provide the appellant and examiner with notification that the appeal is:

- 1) at the Board in condition for referral to a panel, or
- 2) that the appeal is being returned to the Patents operation to resolve matters requiring attention prior to decision of the appeal.

Accordingly, the appellant will know to which organization to look for the next communication in the appealed application.

Within one month of receipt of the application file at the Board, the Board expects to (1) complete all reviews and issue a docketing notice, or (2) return the application file to the Patents operation with an order indicating why the appeal cannot be docketed.

The Board plans to implement these revised docketing procedures beginning June 1, 2002.

April 15, 2002

BRUCE H. STONER, JR.
Chief Administrative Patent Judge
Board of Patent Appeals and Interferences