

# Chapter 1200 Appeal

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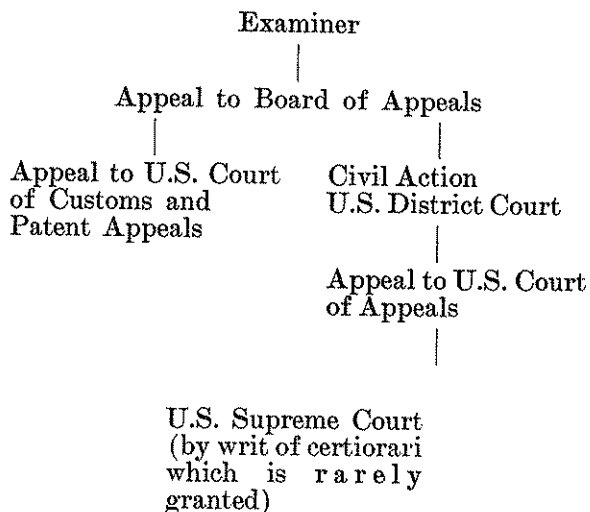
## 1201 Introductory

The Patent Office in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him the patent protection to which he 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 Office and to the courts has long been provided by statute.

The line of demarcation between appealable matters for the Board and petitionable matters for the Commissioner 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.

## 1202 Ex Parte Review of Matters Pertaining to Merits



## 1203 Constitution of Board

35 U.S.C. 7, provides for constitution of the Board of Appeals as follows:

### § 7. Board of Appeals

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The 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.

### 1204 Administrative Handling

Ex parte appeals to the Board of Appeals, and all papers relating thereto, are forwarded directly to the Board for docketing. The application file is then obtained from the division on a charge which gives the Docket Clerk the date of appeal and appeal number for entry on her records. On receipt of the brief, the case is returned to the Examining Division for the answer required by Rule 193.

The dates of the brief and of the Examiner's answer thereto are entered on the cards. When the Examiner's answer is mailed, the file, together with the photographic copies of the drawings is returned to the Board of Appeals. It is not necessary to send copies of the references relied upon as these are ordered by the Administrative Officer to the Board.

If the brief is not filed within the time designated by Rule 192, the Administrative Officer to the Board will notify the appellant that the appeal stands dismissed.

#### "SPECIAL" CASE

Subject alone to diligent prosecution by the applicant, an 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 Office, including appeal, if any, to the Board of Appeals. (Basis: Notice of Dec. 3, 1954.)

### 1205 Prerequisites for Appeal

*Rule 191. Appeal to Board of Appeals.* (a) Every applicant for a patent or for reissue of a patent, any of the claims of which have been twice rejected, or who has been given a final rejection (rule 113), may, upon the payment of the fee required by law, appeal from the decision of the primary examiner to the Board of Appeals within the time allowed for response.

(b) The appeal must identify the rejected claim or claims appealed, and must be signed by the applicant or his duly authorized attorney or agent.

(c) Except as otherwise provided by rule 206, appeal when taken must be taken from the rejection of all claims under rejection which applicant proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

The appeal will not ordinarily be forwarded where only some of the rejected claims have been twice or finally rejected. Ex parte Brown, 1902 C.D. 51; 98 O.G. 1705. Rule 206 permits partial appeal in cases where there are finally rejected claims copied from a patent.

### 1206 Time for Filing Brief

*Rule 192. Appellant's brief.* (a) The appellant shall, within sixty days from the date of the appeal, or within the time allowed for response to the action appealed from if such time is later, file a brief of the authorities and arguments on which he will rely to maintain his appeal, including a concise explanation of the invention which should refer to the drawing by reference characters, and a copy of the claims involved, at the same time indicating if he desires an oral hearing. Two extra copies of the brief are required if an oral hearing is requested. The Board of Appeals may, for sufficient cause shown, extend the time for filing the brief to a date not later than sixty days after the original expiration date. Any longer or further extensions must be sought from the Commissioner. All requests for extensions must be filed prior to the expiration of the period sought to be extended.

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

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

See 1215.04 for practice relating to dismissal of appeal.

### 1207 Amendment Filed With or After Appeal but Before Examiner's Answer

An amendment filed with or after appeal should ordinarily be given immediate consideration to determine if it places the case in condition for allowance or in better form for appeal. If the amendment places the case in condition for allowance, the Notice of Allowance is sufficient notification that it has been entered. If it is not possible to process the application and mail the Notice of Allowance immediately, the Examiner should promptly write a letter substantially as follows:

"In view of the amendment filed (date), this application has been reconsidered and found allowable. PROSECUTION ON THE MERITS IS CLOSED. The Notice of Allowance will be sent in due course."

Where the amendment is filed a reasonable time before the brief is due, and the Examiner believes the amendment qualifies for entry, the amendment is entered forthwith and appellant notified as soon as possible so that the brief may be directed to the claims as amended. Entry may be denied because the proposed amendment would cancel the finally rejected claims and substitute others, only some of which are admissible for purpose of appeal. If entry is denied, appellant should be advised to this effect promptly so that he may petition, if he so desires, from the Examiner's refusal to admit the amendment.

Where the amendment is filed with or after the brief or too late to be considered before the brief is due and the Examiner believes that it qualifies for entry, the amendment is entered forthwith and a notification to that effect in the Examiner's Answer suffices. If entry is denied, appellant should be advised to this effect promptly so that he may petition, if he so desires, from the Examiner's refusal to admit the amendment, and the preparation of the Examiner's Answer should be delayed for twenty days for that reason. The above is taken from the Notice of January 5, 1953.

In the consideration of an amendment presented before the filing of the brief, a new or better reference, not previously of record, may be discovered, which reference is pertinent not only to the claims as amended but also to the claims as finally rejected. In such a case, the examiner should consider the propriety of reopening the prosecution. If such a course of action is determined upon, the matter should be referred to the Supervisory Examiner in accordance with Sec. 1208.01.

On the other hand, the new reference may not affect the status of the finally rejected claims but be pertinent to the claims as amended. If the examiner believes that they should be considered by the Board, either with or in place of the finally rejected claims, the new reference should be cited and applied to the amended claims. Applicant should be informed that the amendment has not been entered since it does not place the application in condition for allowance, but that the amendment may be entered for purposes of appeal subject to the provision that the prosecution will not be reopened before the examiner. This action should be submitted to the Supervisory Examiner before mailing. Sec. 1208.01. The applicant (or his attorney) should also be

informed that in his brief, he should clearly indicate whether he accepts the entry of the amendment under the condition specified or whether he is proceeding with the appeal as to the claims as finally rejected.

## 1208 Examiner's Answer

*Rule 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 rule 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 sixty days from the date of such answer; such reply may include any amendment or material appropriate to the new ground.

The brief should be inspected to see if it answers all grounds of rejection. If not, it should be returned to the Board with an explanatory memorandum. The Board usually gives appellant 20 days within which to make the brief complete, stating that failure to do so may result in the appeal being dismissed under Rule 192(b).

Appealed cases in which the brief has been filed should 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 having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal. A conference should be held even though the Primary Examiner has, himself, examined the application and made the final rejection. Discussion with the other Examiners may be helpful.

If a conference is held, the Primary Examiner 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 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. (Basis: Memorandum of February 16, 1959).

Before preparing the answer, the Examiner should make certain that all amendments approved for entry have in fact been physically entered in the application. (Basis: Notice of Dec. 1, 1952.)

This is important to insure that the claims considered by the Board are the same as those forming the basis of the appeal.

The Examiner should furnish the appellant with a written statement in answer to the appellant's brief within sixty calendar days 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. The Examiner should treat affidavits or exhibits in accordance with Rule 195, reporting his conclusions only on those admitted.

Because of the practice of the Patent Office in entering amendments after final action under justifiable circumstances for purpose 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. 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 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 not infrequently happens that an Examiner will state his 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 supercedes 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.

The Examiner should not rely on the final rejection for a statement of his position but should *in every case*, whether or not the claims have been amended after final rejection, include in his answer a full statement of all of the grounds of rejection on which he *then*

relies. He should point out the particular part of each reference relied on and apply the references to the claims actually before the Board for consideration so that the Board will have in *one paper* a complete exposition of the Examiner's position.

The Examiner should reconsider his position in the light of the arguments presented in the brief, and should expressly withdraw any rejections not adhered to. 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. (Basis: Notice of April 8, 1957.)

When files are forwarded, soft copies and prints of references fastened therein should not be disturbed. The Service Branch of the Board will discard any unnecessary copies. (Basis: Notice of February 19, 1965.)

A form suitable for the Examiner's Answer is as follows:

POL-84

IN RE APPLICATION OF

|                |                             |                  |
|----------------|-----------------------------|------------------|
| Ser. No. ----- | Before the Board of Appeals |                  |
| Filed -----    |                             | Appeal No. ----- |
| 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.)

"The references of record relied on are:

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

(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 all references not involved in the appeal.)

Description of the invention. (If adequately described in applicant's brief, merely so state.)

Brief description of the references. (If adequately described in applicant's brief, merely so state.)

Application of the references to the claims before the Board.

Response to the allegations and arguments in the brief.

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

For case having patentability report see 705.01(a). (Basis: Notice of April 8, 1957.)

### 1208.01 New Ground of Rejection in Examiner's Answer

At the time of preparing his answer to an appeal brief, the Examiner may discover a new ground of rejection (new reference, double patenting, statutory bar or other reason for rejection) which should be used against some or all of the appealed claims. In order to introduce this new ground of rejection, it is necessary to reopen the ex parte prosecution before the Examiner or to include the new rejection in the Examiner's Answer depending on existing circumstances. Except in the case of a full signatory examiner, the Supervisory Primary Examiner's approval must be obtained in each such situation in determining the procedure to be followed. The Group Manager should be consulted before such action is taken.

The choice of action to be followed will depend on such factors as the history of the prosecution, the number of claims affected, the importance of the new ground of rejection, the significance of the new reference and 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 would ordinarily be approved. 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.

Where a new ground of rejection is raised in the Examiner's Answer, the Appellant, under Rule 193(b) has sixty days within which he may file a reply. The appellant's reply, insofar as the new ground of rejection is concerned, may include any amendment of material appropriate to the new ground. The

Board of Appeals in its discretion may remand the case to the examiner to consider such amendment or material. In the event of remand, consideration will be limited to amendments and facts pertinent to the new ground of rejection. (Basis: Notice of March 13, 1952.)

It is important that the new ground be clearly indicated as such so that the Board of Appeals can readily identify those applications where the appellant is entitled to a period of sixty days for reply. The reference should be cited under the caption "New Reference(s)." The references of record relied upon, if listed in the Answer, should appear under a caption to that effect, i.e., "The references of record relied on are:" even though no new references are cited.

Likewise when a ground of rejection not involving a new reference is raised for the first time in the Answer after consultation with the Group Manager 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 the following paragraph:

"In view of the new ground of rejection appellant has sixty days within which he may file a reply to this Answer. Such reply may include any amendment or material appropriate to the new ground and may request remand to the Examiner to consider such amendment or material. Prosecution otherwise remains closed. Failure to respond to the new ground of rejection may be construed as an acquiescence in this rejection." (Basis: Notice of March 18, 1952.)

If the Examiner discovers a new ground of rejection while considering claims presented in a proposed amendment filed after final rejection or appeal, he should follow the practice set forth in Section 1207. (Basis: Notice of February 14, 1957.)

### 1208.02 Withdrawal of Final Rejection

The Examiner may withdraw the final rejection at any time prior to the hearing. 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 he is of the opinion that some of the claims are allowable he should so specify in the Examiner's Answer and confine his arguments to the remaining rejected claims. If he

finds, upon reconsideration, that all the rejected claims are allowable, or where the applicant in his brief withdraws the appeal as to some of the rejected claims and the Examiner finds the remaining claims to be allowable, he should notify the Administrative Officer of the Board of this fact so that the appeal may be removed from the records. See 706.07(c) to 706.07(e).

### 1209 Oral Hearing

*Rule 194. Hearing.* If no request for oral hearing has been made by the appellant, the appeal will be assigned for consideration and decision. If the appellant has requested an oral hearing, a day of hearing will be set, and due notice thereof given to the appellant. Hearing will be held as stated in the notice, and oral argument will be limited to one-half hour unless otherwise ordered before the hearing begins.

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

#### JURISDICTION OF BOARD

With the mailing of the Examiner's answer on appeal, jurisdiction of the case passes to the Board of Appeals; and any amendment, or affidavit filed thereafter but prior to the decision of the Board will be considered by the Examiner only in the event the case is remanded to him by the Board.

#### DIVIDED JURISDICTION

Where appeal is taken from the final rejection of a copied patent claim or claims only, jurisdiction of the rest of the case remains with the Examiner, and prosecution of the unallowed claims may proceed as though the entire case was under the jurisdiction of the Examiner.

### 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. *Ex parte Moore*, 1923 C.D. 13; 307 O.G. 4. In *re Sweet*, 1943 C.D. 535; 556 O.G. 726. In *re Shea*, 1944 C.D. 535; 568 O.G. 201. In unusual situations a proposed amendment may be remanded for such consideration as the Examiner may see fit to give. In such cases the amendment will be treated in the same way as an amendment after final rejection (see 714.12).

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 will be entered, the Administrative Officer to the Board of Appeals being so notified in order that the case may be removed from the Board's docket.

(See 1208.01.)

### 1212 Remand To Consider Affidavits

*Rule 195. Affidavits after appeal.* Affidavits 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 filed with or after appeal but before the mailing of the Examiner's answer will be treated in the same manner as affidavits filed after final rejection. Authority from the Board is not necessary to consider such affidavits. See 1210.

In the case of affidavits filed after the mailing of the Examiner's answer, 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 affidavits, the Examiner, after having given the affidavits such consideration as the facts in the case require, will return the case to the Board of Appeals with his report, a copy of which should be forwarded to the applicant's attorney.

If an affidavit is not accompanied by the showing required under Rule 195, the Examiner will not consider the merits of such affidavit.

If, however, the delay in filing such affidavit is satisfactorily explained, the Examiner will then admit the same and consider its merits. If this affidavit 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 affidavit, or having a publication date more

than one year prior to the applicant's filing date, is found, it may be substituted by the Examiner for the one overcome without thereby reopening the case to further prosecution before the Examiner. *Ex parte Bowyer*, 1939 C.D. 5; 505 O.G. 759.

It is not the custom of the Board to remand affidavits offered in connection with a request for reconsideration of its decision. Affidavits submitted for this purpose, not remanded to the Examiner, are considered only as arguments. In *re Martin*, 1946 C.D. 180; 586 O.G. 347.

### 1213 Decision by Board

*Rule 196 (first paragraph). 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.

#### 1213.01 Recommendations of Board

*Rule 196 (third paragraph). 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, applicant shall have the right to amend in conformity with such statement, which shall be binding on the primary examiner in the absence of new references or grounds of rejection.

However, if the Examiner knows of references or reasons which were not before the Board, such a favorable recommendation is not binding upon him. Likewise, should applicant make any change in a favorably recommended claim (other than the amendments recommended), the same 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 as a claim is not to be taken as a recommendation that the claim be allowed if the feature is supplied by amendment. *Ex parte LeBlanc*, 1902 C.D. 1; 98 O.G. 225. *Ex parte Norlund*, 1913 C.D. 161; 192 O.G. 989.

Applicant's right to amend in conformity with the recommendation must be exercised within the period allowed for seeking court review, ordinarily sixty days from the date of the Board's decision. (Basis: Notice of March 10, 1953.)

## 1214 Actions Following Decision by Board

### 1214.01 New Ground of Rejection

*Rule 196 (second paragraph). Decision 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 its 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 applicant 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 applicant 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.

The request for reconsideration by the Board must be filed within thirty days from the date of the decision, the period set by Rule 197, second paragraph. By proceeding in this manner the applicant waives his right to further prosecution before the Examiner. In re Greenfield, 1930 C.D. 531; 400 O.G. 226.

Where the Board's decision completely removes the Examiner's rejection as to one or more claims and substitutes a new one under Rule 196(b), the applicant, if he elects to proceed before the Examiner, must take such action within six months from the Board's decision. See the decision at 693 O.G. 136 modifying the Notice of March 10, 1953. A shortened period for response may be set in the Board's decision.

The applicant 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 be 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.

As a third option, applicant 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 applicant avails himself of the third option, he waives his 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

*Rule 197 (first paragraph).* (a) *Action following decision.* After decision by the Board of Appeals, the case shall be returned to the primary examiner, subject to the applicant's right of appeal or other review, for such further action by the applicant 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 Administrative Officer to 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 Supervisory Examiner.

### 1214.03 Rehearing and Reconsideration

Under Rule 197, any request or petition for rehearing or reconsideration, or modification of the decision, must be 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.

Any soft copies in the file wrapper should not be removed until the period of reconsideration expires.

### 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 re-



jected the claims. The second Examiner should give full faith and credit to his predecessor's search. Of course, if the Examiner has specific knowledge of the existence of a particular reference which obviously meets the terms of any of the appealed claims as to which the Examiner was reversed, he should submit the matter to the Supervisory Examiner to determine whether the Commissioner should be requested to authorize the reopening of prosecution under Rule 198 for the purpose of entering the new rejection.

### 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 applicant of the cancellation of the withdrawn claims.

### 1214.06 Examiner Sustained in Whole or in Part

*Rule 197 (third paragraph).* (c) *Action following decision.* When an appeal is or stands dismissed, or when the time for appeal to the court or review by civil action (rule 304) has expired and no such appeal or civil action has been filed, proceedings in the application are considered terminated as of the dismissal or expiration date except in those applications in which claims stand allowed or in which the nature of the decision requires further action by the examiner. If an appeal to the court or a civil action has been filed, proceedings in the application 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 applicant of the status of the case unless asked to do so. See *Ex parte Buchenberg* 1924 C.D. 55; 327 O.G. 216. (Notice of Nov. 12, 1923, revised.)

In view of the fact that the time for seeking review of a decision of the Board of Appeals by the C.C.P.A. or the District Court is the same for both tribunals, that is, sixty days, or sixty days with the extension provided by Rule 304 in the event a petition for reconsideration or rehearing is seasonably filed before the Board, it is no longer necessary to wait six months after the Board's decision before taking up the application for further action.

The third paragraph of Rule 197 provides the basis for this reduction in time in those cases, where proceedings as to the rejected

claims are terminated by virtue of applicant's failure to seek court review. Therefore, when the time for seeking court review has passed (plus two weeks to allow for information as to the filing of an appeal or civil action, if any, to reach the Examiner) the Examiner must take up the case for consideration. There are four possible situations:

A. *No claims stand allowed in the application.* 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 the Abandoned Files without notifying applicant.

B. *Claims stand allowed in the application.* The applicant 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 notation "Board Decision" written in the margin in red ink.

If matters of form needing attention remain in the case, the Examiner should take appropriate action but prosecution is otherwise closed. A letter such as the following is suggested:

"In view of the fact that the period for seeking court review of the decision by the Board of Appeals rendered (*date of decision*) has expired and no further action has been taken by applicant, the proceedings as to the rejected claims are considered terminated; see Rule 197, third paragraph."

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

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

(Set 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 allowing 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 considered open to further prosecution except as to such matters.

D. *196(b) rejection.* Where the Board makes a new rejection under Rule 196(b) and no action is taken with reference thereto by the applicant 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.

**E. 196(c) recommendation.** Where the Board makes a recommendation under Rule 196(c) and no action is taken with reference thereto by the applicant 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.

The practice under situations A, B, and C is similar to the practice after a decision of the Court outlined in Section 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" on "Contents" of file wrapper immediately below endorsement "Decision by Board".

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

### 1214.07 Reopening of Prosecution

**Rule 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 rule 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 applicant 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 Supervisor and approval by the appropriate Director, the amendment will be entered.

Where the amendment cannot be entered, the

Examiner should write to the applicant notifying him that the amendment cannot be entered and stating the reason why. The refusal should never be made to appear arbitrary or capricious. A letter such as the following might be used:

"The amendment filed \_\_\_\_\_ after the Board's decision is refused entry because the prosecution is closed and the new claims (or claims as amended) raise new issues which require further consideration or search."

## 1215 Withdrawal or Dismissal of Appeal

### 1215.01 Withdrawal of Appeal

Where, after appeal has been filed and before decision by the Board of Appeals, an appellant withdraws the appeal more than six months after the date of the final rejection, 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 Rule 138, the effective date of abandonment is the date of filing of such letter. (Basis: Notice, Sept. 3, 1948.)

If a brief has been filed within the time permitted by Rule 192 (or any extension thereof) and appellant withdraws the appeal, the case is returned to the Examiner. If there are no allowed claims in the case, the Examiner writes a letter of abandonment.

### 1215.02 Claims Standing Allowed

If the application contains allowed claims, as well as claims appealed, the withdrawal of the appeal does not operate as an abandonment of the application, but is considered a withdrawal of the appealed claims and authority to the Examiner to cancel the same. An amendment canceling the appealed claims is equivalent to a withdrawal of the appeal. (Basis: Notice, Sept. 3, 1948.)

### 1215.03 Partial Withdrawal

A withdrawal of the appeal as to some only of the claims on appeal operates to withdraw those claims from the case and the appeal continues as to the remaining claims. The withdrawn claims will be canceled by the Examiner when necessary without further action by the applicant. (Basis: Notice, Sept. 3, 1948.)

**1215.04 Dismissal of Appeal**

If no brief is filed within the time prescribed by Rule 192, the appeal stands dismissed by operation of the rule. The letter from the Board of Appeals 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 of 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 when the file is received from the Board of Appeals. 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 Rule 192, the appeal stands dismissed and the proceedings as to the rejected claims are considered terminated; see Rule 197, third paragraph.

"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 Shortened Statutory Period for response.)

The time for filing the brief can be extended as set forth in Rule 192. Any petition for such extension must be received before the date the brief is due or the expiration of a previously granted extension and must show good cause for the extension. If the time for filing the 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 application is not abandoned the petition would be to reinstate the claims and the appeal, but a showing equivalent to that in the petition to revive would be required. Such petitions will ordinarily be handled by the Solicitor and Law Examiners on behalf of the Commissioner. (Basis: Notice of January 3, 1950.)

**1215.05 Case Before the Court**

When the case is before the court either on appeal 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. (Basis: Notice, Sept. 3, 1948.)

**1216 Appeals to Courts**

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

During the pendency of a suit, while the file is retained in the examining group until the case comes up for trial, 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 Rule 198.

**1216.01 To Court of Customs and Patent Appeals**

If, from an adverse decision by the Board, appeal is taken to the U.S. Court of Customs and Patent Appeals, the Chief of the Docket Branch, to whom the appeal is sent, obtains the file from the Primary Examiner and suggests to appellant those papers which in his opinion should form the transcript of record. The appellant then orders a transcript, including certified copies of such papers as he desires, to be prepared and transmitted to the court.

After the court has heard and decided the appeal, a copy of the decision is sent to the Patent 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 Docket Branch enters the certified copy in the application file. The Solicitor uses the uncertified copy as a basis for publication of the decision in the Official Gazette.

The file is then returned to the Primary Examiner. Further action, if any, on the part of the Examiner is determined by the court's decision.

In the case of an appeal to the Court of Customs and Patent Appeals, a transcript of the record must be filed with the court within a specified time after filing the reasons for appeal. The decision of the court is published; but unless the application becomes a patent, the public is not given access to the application file itself. Since a transcript of the application becomes a part of the court record, it may of course be inspected there by anyone.

#### ACTION FOLLOWING APPEAL

1. Certificate of the Court. After hearing the case the Court returns to the Office "a certificate of its proceedings and the decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case." (35 U.S.C. 144.) The receipt of this certificate by the Office marks the conclusion of the appeal.

2. 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. The application is no longer considered pending.

3. Some claims allowed. If some claims in the case stand allowed, either by reversal of the Office decision by the Court or by having been allowed by the Examiner or the Board of Appeals, 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 cancelled 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 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.

4. 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.

5. Dismissal of Appeal. If the appeal is dismissed by the Court, the status of the application will be the same as in paragraph 2 if no claim stands allowed. If claims stand allowed action will be taken by the Examiner as in paragraph 3.

6. Special status of application. After termination of the appeal to the Court the application, in those cases in which action by the Examiner is in order (paragraphs 3 and 4), will be taken up for such action immediately, and the application will be special for any subsequent action by the Examiner. (Basis: Notice of January 4, 1950.)

#### 1216.02 Civil Suits

When a suit under 35 U.S.C. 145 is filed a notice thereof signed by the Solicitor of the Patent Office is placed in the application 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 his action following appeal, described in 1216.01, supra. If the exact date when proceedings were terminated is material, it may be ascertained by inquiring at the Solicitor's office.

The applicant ordinarily furnishes to the court a certified copy of the file wrapper and contents at the time of the trial. 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 Customs and Patent Appeals, 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 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.