




UNITED STATES PATENT AND TRADEMARK OFFICE

ASSOCIATE COMMISSIONER FOR PATENT EXAMINATION POLICY

DATE: August 17, 2010

TO: Technology Center Directors and
Director of Central Reexamination Unit (CRU)

FROM: 
Robert W. Bahr
Acting Associate Commissioner
for Patent Examination Policy

SUBJECT: Streamlined Procedure for Appeal Brief Review and Examiner's Answers
in *Inter Partes* Reexamination Proceedings

Effective August 17, 2010, the Board of Patent Appeals and Interferences (BPAI) will have the sole responsibility for determining whether appeal briefs (*i.e.*, appellant's brief, respondent's brief, and rebuttal briefs) filed in *inter partes* reexamination proceedings comply with 37 CFR 1.943(c) and 37 CFR 41.67, 41.68, or 41.71, and will complete the determination before the appeal briefs are forwarded to the examiner for consideration. The determination should be completed within approximately one month from the filing of the appeal brief. If the appeal brief is determined to be compliant with the rules or it contains only minor informalities that do not affect the BPAI panel's ability to render a decision, the BPAI will accept the appeal brief and forward it to the examiner for consideration. If the BPAI determines that the appeal brief is non-compliant with the rules and sends the party a notice of non-compliant brief requiring a corrected brief, the party will be required to file a corrected brief within the time period set forth in the notice to avoid the dismissal of the appeal. The BPAI will also have the sole responsibility for determining whether corrected briefs comply with 37 CFR 1.943(c) and 37 CFR 41.67, 41.68, or 41.71, and will address any inquiries and petitions regarding page limits for briefs, entry of briefs or notices of non-compliant briefs.

Once an appeal brief is accepted by the BPAI, the appeal brief will not later be held as defective by the CRU or the examiner. The BPAI will not return or remand the proceeding to the examiner for issues related to a non-compliant appeal brief. Furthermore, examiners are not required to review appeal briefs for the purposes of determining whether the appeal briefs comply with 37 CFR 1.943(c) and 37 CFR 41.67, 41.68, or 41.71. Accordingly, the *Inter Partes* Reexamination Notification re Brief (PTOL-2073) and form paragraphs for holding an appeal brief defective will no longer be available in OACS for the Examining Corps to use.

The revised procedure for appeal brief review will take effect on August 17, 2010, regardless of the date on which the appeal brief is filed or forwarded to the examiner for consideration. Examiners should no longer hold any appeal briefs defective including those appeal briefs that are already on the examiner's dockets, because they have already been reviewed and accepted by the paralegals of the CRU. Furthermore, the BPAI will correspond directly with the parties on non-compliant brief issues. Examiners may use the revised form paragraphs listed in the appendix of this memorandum for drafting examiner's answers to respond to appeal briefs. In a rare situation where an appeal brief contains serious defects that will prevent the examiner from drafting an examiner's answer, the examiner should report the issue to the Director of CRU who will communicate with the BPAI regarding the issue.

In addition, examiners are not required to make any determination whether fewer than all of the rejected claims are identified by the party as being appealed. If the notice of appeal or appeal brief identifies fewer than all of the rejected claims as being appealed, the issue will be addressed by the BPAI panel. Therefore, the examiner will treat all pending claims in the proceeding as being on appeal.

The responsibility of the BPAI for determining whether appeal briefs comply with the appropriate rules is not considered a transfer of jurisdiction when an appeal brief is filed, but rather is only a transfer of the specific responsibility of notifying parties of the reasons for non-compliance. The CRU retains the jurisdiction over the reexamination proceeding to consider the appeal briefs, conduct an appeal conference, draft an examiner's answer, and decide the entry of amendments, evidence, and information disclosure statements filed after Right of Appeal Notice (RAN) or after the filing of a notice of appeal. Furthermore, petitions concerning the refusal to enter amendments and/or evidence remain delegated according to MPEP §§ 1002.02(b) and (c). The jurisdiction of the *inter partes* reexamination proceeding is transferred to the BPAI when a docketing notice is entered after the time period for filing the last rebuttal brief (if appropriate) expires or the examiner acknowledges the receipt and entry of the last rebuttal brief.

In a situation where at least two adverse parties filed an appeal brief in the *inter partes* reexamination proceeding (*e.g.*, the patent owner filed an appellant's brief and the third-party requester filed a respondent's brief), most of the time, the issues have been completely developed by the examiner in the RAN and by both parties in their briefs, and additional briefing from the examiner is not necessary for the BPAI panel to decide the issues. Therefore, examiners must use the new PTOL-2291 form ("*Inter Partes* Reexamination Examiner's Answer") to incorporate by reference the RAN including the grounds of rejection and determinations not to make a proposed rejection set forth in RAN, in a proceeding where at least two adverse parties filed an appeal brief. With the approval of the CRU Director, examiners may provide additional explanation as an attachment to the form PTOL-2291. For situations other than where at least two adverse parties have filed an appeal brief, examiners should use the revised form paragraphs OACS and are encouraged to incorporate in the examiner's answer their statements of the grounds of rejection and determinations not to make a proposed rejection set forth in the

RAN (even when the RAN refers back to a prior action). By not repeating the examiner's statements previously made on the record, the appeal procedure will be more efficient for the examiner, the parties involved in the appeal, and BPAI panel. Furthermore, the record will be clear as to which statements by the examiner are new. Examiners are reminded that no new ground of rejection and no new determination not to make a proposed rejection are permitted in an examiner's answer.

Previously, the Office implemented a streamlined procedure for reviewing appeal briefs filed in patent applications and *ex parte* reexamination proceedings. See *Streamlined Procedure for Appeal Brief Review*, 75 FR 15689 (March 30, 2010), *Streamlined Procedure for Appeal Brief Review in Ex Parte Reexamination Proceedings*, 75 FR 29321 (May 25, 2010), Memorandum – *Revised Procedure for Appeal Brief Review* (March 29, 2010), Memorandum – *Revised Procedure for Appeal Brief Review of Ex Parte Reexamination Proceedings* (May 25, 2010) (available at <http://www.uspto.gov/patents/law/exam/memoranda.jsp>). Appropriate sections of the MPEP (e.g., MPEP §§ 1205.03, 1207.02, 2274, 2675, 2675.01, 2675.02, and 2677) will be revised accordingly in due course.

Inquiries regarding this notice may be directed to Joni Y. Chang, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Associate Commissioner for Patent Examination Policy, directly by telephone to (571) 272-7720, or the Office of Patent Legal Administration, by telephone at (571) 272-7701 or by electronic mail at PatentPractice@uspto.gov.

APPENDIX:

Form paragraphs not listed in this appendix are not affected by the revised procedure for appeal brief review. The following revised form paragraphs are available in OACS:

REVISED ¶ 26.50.01 Real Party in Interest

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief(s).

REVISED ¶ 26.51 Status of Claims

(3) Status of Claims

The examiner has no comment on the statement of the status of claims in the brief(s).

REVISED ¶ 26.52 Status of Amendments

(4) Status of Amendments After Action Closing Prosecution

The examiner has no comment on the statement of the status of amendments after action closing prosecution contained in the brief(s).

Examiner Note:

Identify status of all amendments submitted after Action Closing Prosecution. Use one or more of form paragraphs 26.52.03-26.52.05, if appropriate.

REVISED ¶ 26.53 Summary of Claimed Subject Matter

(5) Summary of Claimed Subject Matter

Examiner Note:

Follow this form paragraph with form paragraph 26.53.01.

REVISED ¶ 26.53.01 No Comment on the Statement of the Summary of Claimed Subject Matter in Brief(s)

The examiner has no comment on the summary of claimed subject matter contained in the brief(s).

**REVISED ¶ 26.54 Grounds of Rejection to be Reviewed on Appeal
(6) Grounds of Rejection to be Reviewed on Appeal**

Examiner Note:

Follow this form paragraph with form paragraph 26.54.01.

REVISED ¶ 26.54.01 Examiner's Statement of Grounds of Rejection

The examiner has no comment on the statement of the grounds of rejection in the brief(s). Every ground of rejection set forth in the Right of Appeal Notice (RAN) is being maintained by the examiner.

Examiner Note:

1. Follow this form paragraph with form paragraph 26.54.011 if there are grounds of rejection that have not been withdrawn and that have not been presented by an appellant for review.
2. Follow this form paragraph with form paragraph 26.54.012 to list any non-appealable issue in the brief(s).

**REVISED ¶ 26.55 Findings of Patentability to be Reviewed on Appeal
(7) Findings of Patentability to be Reviewed on Appeal**

Examiner Note:

Follow this form paragraph with form paragraph 26.55.01.

REVISED ¶ 26.55.01 No Comment on the Statement of Findings of Patentability to be Reviewed on Appeal

The examiner has no comment on the statement of findings of patentability in the brief(s). Every finding of patentability set forth in the Right of Appeal Notice (RAN) is being maintained by the examiner.

**REVISED ¶ 26.56 Claims Appendix
(8) Claims Appendix**

Examiner Note:

Follow this form paragraph with form paragraph 26.56.01.

REVISED ¶ 26.56.01 No Comment on Claims Appendix in Brief

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

The following form paragraphs and *Inter Partes* Reexamination Notification re Brief (PTOL-2073) will no longer be available in OACS for the CRU to use:

¶ 26.09 Brief is Defective and/or is Not Complete

¶ 26.10 Informal Appellant Brief-Period for Response Under 37 CFR 41.67(d)

¶ 26.11 Informal Respondent Brief-Period for Response Under 37 CFR 41.68(c)

¶ 26.50.02 Acknowledgment of Identification of a Real Party in Interest in a Brief

¶ 26.50.03 No Identification of Real Party in Interest in the Briefs

¶ 26.51.01 Agreement With Statement of Status of Claims

¶ 26.51.02 Disagreement With Statement of Status of Claims Stated in Briefs

¶ 26.52.01 Agreement With Statement of the Status of Amendments After Action Closing Prosecution

¶ 26.52.02 Disagreement With Statement of the Status of Amendments After Action Closing Prosecution Stated in Briefs

¶ 26.53.02 Disagreement With the Summary of Claimed Subject Matter in Brief(s)

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- ¶ 26.54.02 *Disagreement With Statement of the Grounds of Rejection on Review*
 - ¶ 26.55.011 *Findings of Patentability Not on Review*
 - ¶ 26.55.02 *Disagreement With Statement of the Findings of Patentability on Appeal*
 - ¶ 26.56.02 *Copy of the Appealed Claims in the Appendix of Appellant Brief is Substantially Correct*
 - ¶ 26.56.03 *Copy of the Appealed Claims in the Appendix Contains Substantially Errors*