

BPAI *Ex Parte* Appeals Rules Roundtable
Wednesday, January 20
Madison Auditorium
9:30 a.m. – 12:30 p.m.

AGENDA

- 9:30 – 9:45** **Opening Remarks**
- 9:45 – 10:00** **Presentation of Challenges Facing the BPAI**
- 10:00 – 11:15** **Discussion of Published Potential Modifications to Final Rule and Other Ways to address BPAI Challenges**
- Opening Statements**
- Topic 1:** **Should jurisdiction pass to the Board upon filing a notice of appeal (41.35(a))?**
- Topic 2:** **Arguments to explain Examiner error (41.37(o))**
- Topic 3:** **No longer dictating appeal strategy of Appellants:**
- (a) Acceptance of arguments and evidence of record presented;**
- (b) Rule changes include defaults, thereby reducing returns (41.37(f), 41.37(g), 41.37(o)(1), 41.37(r), 41.37(s), 41.37(t), and 41.37(u));and**
- (c) Elimination of summary of invention section and clarifying requirements for claim support and drawing analysis section, thereby reducing returns (41.37(r)).**
- Topic 4:** **Should the Board have briefing requirements similar to other appellate tribunals (e.g., page limits, jurisdictional statement, table of contents, and table of authorities)?**
- 11:15 – 11:30** **Break**
- 11:30 – 12:30** **Discussion of Published Potential Modifications to Final Rule and Other Ways to address BPAI Challenges (continued)**
- Topic 5:** **Should the Board allow examiners and/or appellants to present arguments not presented during prosecution?**
- Topic 6:** **Should examiners be allowed to make new grounds of rejection in an answer (41.39(a)(2))?**
- Topic 7:** **Should the Board be allowed to enter new grounds of rejection (41.50(d))?**
- Topic 8:** **Should the rules be more specific as to the Examiner’s requirements for appeal?**
- Topic 9:** **Should the rule regarding the Director’s sanction powers for appellate matters be more specific (41.56)?**

Open floor for discussion of other topics