

# Rules of Practice Before the BPAI in Ex Parte Appeals

**BPAI *Ex Parte* Appeals Rules  
Effective January 23, 2012**



# Rules of Practice Before the BPAI in Ex Parte Appeals

## The Effective Date: January 23, 2012

- Applies to any appeal that includes a notice of appeal filed on/after January 23, 2012.
- A certificate of mailing or transmission in compliance with § 1.8 will be applicable to determine whether the appeal brief was filed prior to the effective date in order to determine whether the revised rules apply.
- *See Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Final Rule, 76 FR 72270 (Nov. 22, 2011).*



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Objectives of the Rules Changes:

- Ensure that the Board has adequate information to decide the *ex parte* appeal on the merits without unduly burdening applicants and examiners with unnecessary briefing requirements.
- Reduce the number of non-compliant appeal briefs and examiner answers.
- Eliminate any gap in time from the end of briefing to the commencement of the Board's jurisdiction;
- Clarify and simplify petition practice on appeal.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Objectives of the rule changes (cont'd):

- Reduce confusion as to which claims are on appeal.
- Avoid the unintended cancellation of claims by the Office due to appellant's mistake in listing of the claims in either the notice of appeal or the appeal brief.
- Provide procedures under which appellant may seek review of the Office's failure to designate a new ground of rejection in either the examiner answer under § 41.39 or Board decision under § 41.50.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Improvements to *Ex Parte* Appeal Practice:

- Rules eliminate five requirements of an appeal brief: (a) statement of status of claims, (b) statement of status of amendments, (c) statement of the grounds of rejection to be reviewed on appeal, (d) evidence appendix, and (e) related proceedings appendix. See § 41.37(c).
- Board will presume that an appeal is taken from the rejection of all claims under rejection unless canceled by an amendment filed by appellant and entered by the Office. See § 41.31(c).
- Board assumes jurisdiction upon the earlier of the filing of a reply brief or expiration of time to file a reply brief. See § 41.35(a).



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Improvements to *Ex Parte* Appeal Practice (cont'd):

- Board reduces instances of non-compliant briefs by applying default assumptions if a brief omits a statement of real party-in-interest or a statement of related cases. See § 41.37(c)(1) (i) and (ii).
- Office tolls appellant's time to file a reply brief until the issuance of a petition decision determining whether the examiner failed to designate a rejection in the answer as a new ground of rejection. See § 41.40(b) and (c).
- Rules reduce the amount of time that the application is under appeal by eliminating the examiner's response to reply brief. See former § 41.43.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Definition of “Record” – 37 CFR 41.30

- “Record” means the items listed in the content listing of the Image File Wrapper excluding amendments, Evidence, and other documents that were not entered.

## Definition of “Evidence” – 37 CFR 41.30

- Evidence means something that tends to prove or disprove the existence of an alleged fact. For purposes of this subpart, Evidence does not include dictionaries. An examiner may refer to a dictionary without such citation automatically being considered a new ground of rejection. An appellant may refer to a dictionary without such citation being considered an impermissible reference to new or non-admitted evidence.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Appeal to Board 37 CFR 41.31

- The signature requirements of §§ 1.33 and 11.18(a) do not apply to the notice of appeal. See § 41.31(b).  
Signature not required on notice of appeal.
- An appeal is presumed to be taken from the rejection of all claims under rejection unless cancelled by an amendment filed by applicant and entered by the Office. See § 41.31(c).



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Evidence After a Notice of Appeal and Prior to an Appeal Brief – 37 CFR 41.33(d)

- 37 CFR 41.33(d) has been amended to indicate that the definition of “Evidence” as it relates to this rule is the definition as found in § 41.30. Accordingly, the use of a dictionary will not be precluded by this rule.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Jurisdiction over Appeal – 37 CFR 41.35

- Jurisdiction over the proceedings passes to the Board upon the earlier of the filing of a reply brief under § 41.41 or upon the expiration of such time to file a reply brief. See § 41.35(a).
- Consideration of any Information Disclosure Statement or petition (except for petitions authorized under this part) filed while the Board possesses jurisdiction will be held in abeyance until the Board's jurisdiction ends. See § 41.35(d).



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Jurisdiction Over Appeal – 37 CFR 41.35 (cont'd)

- The jurisdiction of the Board ends when:
  - ◆ The Board or Director enters a remand order;
  - ◆ The Board enters a final decision and judicial review is sought or time to seek judicial review has expired;
  - ◆ An express abandonment which complies with 37 CFR 1.138 is recognized by the Office;
  - ◆ A request for continued examination is filed which complies with 37 CFR 1.114;
  - ◆ Appellant reopens prosecution pursuant to § 41.40(b) or in response to new ground of rejection in a decision by the Board; or
  - ◆ Appellant fails to take required action under § 41.39 or § 41.50, and the Board enters a dismissal.



# Rules of Practice before the BPAI in Ex Parte Appeals

## Appeal Brief – 37 CFR 41.37(c)(1)

- Content of Appeal Brief
  - ◆ Real party in interest. See § 41.37(c)(1)(i).
  - ◆ Related appeals and interferences. See § 41.37(c)(1)(ii).
  - ◆ Summary of claimed subject matter. See § 41.37(c)(1)(iii).
  - ◆ Argument. See § 41.37(c)(1)(iv).
  - ◆ Claims appendix. See § 41.37(c)(1)(v).



# Rules of Practice before the BPAI in Ex Parte Appeals

## Appeal Brief – 37 CFR 41.37(c) (cont'd)

- Content of Appeal Brief no longer requires:
  - ◆ Status of claims
  - ◆ Status of amendments
  - ◆ Grounds of rejections to be reviewed on appeal
  - ◆ Evidence appendix
  - ◆ Related proceedings appendix



# Rules of Practice before the BPAI in Ex Parte Appeals

## Appeal Brief – 37 CFR 41.37(c) (cont'd)

- Evidence Upon Which Appellants Rely
  - ◆ While an evidence appendix is no longer required, it is recommended that appellants clearly identify in the appeal brief the evidence relied upon (e.g., providing a list of the evidence that includes a clear description of the evidence along with the date of entry of the evidence into the Record) to ensure that the Board can easily locate the evidence that appellants wish the Board to consider. Appellants may also include copies of the evidence in the appeal brief.



# Rules of Practice before the BPAI in Ex Parte Appeals

## Appeal Brief – 37 CFR 41.37(c) (cont'd)

- Assumptions Regarding an Appeal Brief

In order to minimize the number of appeal briefs deemed non-compliant, the Office may assume:

- a) That no statement as to real party in interest means that the inventors are real party in interest; and
- b) That no statement of related appeals and interferences means no such related appeals or interferences exist.

- Pro Se Appellants

The Office will not hold a brief defective if an appellant not represented by registered practitioner fails to include in the brief a summary of the claimed subject matter. An appellant not represented by a registered practitioner need only substantially comply with the remaining appeal brief requirements.



# Rules of Practice before the BPAI in Ex Parte Appeals

## Appeal Brief – 37 CFR 41.37(c) (cont'd)

- 37 CFR 41.37(c)(1)(vii)
  - ◆ The argument section of the appeal brief “shall explain why the examiner erred as to each ground of rejection contested by appellant.”
  - ◆ Headings/Subheadings
    - Separate headings are required for each ground of rejection contested by appellant
    - Separate subheadings are required for any claims argued separately or as a subgroup



# Rules of Practice before the BPAI in Ex Parte Appeals

## Appeal Brief – 37 CFR 41.37(c) (cont'd)

- 37 CFR 41.37(c)(2)
  - ◆ The rule has been expressly amended to clarify that the procedure for review of an examiner's refusal to admit an amendment or Evidence is by a petition to the Director under 37 CFR 1.181.
  - ◆ Petitions under 37 CFR 1.181 for refusal to enter an amendment or evidence are decided in the Patent Technology Center.



# Rules of Practice before the BPAI in Ex Parte Appeals

## Appeal Brief – 37 CFR 41.37(d)

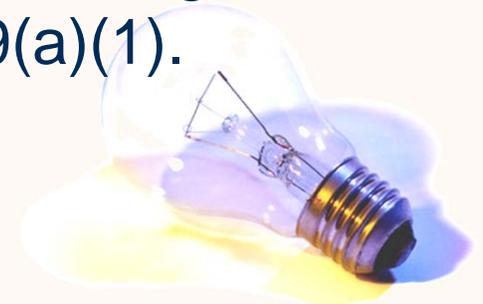
- Notice of Non-Compliance
  - ◆ If appellant does not file an amended brief within the set time period correcting all of the reasons for non-compliance, the appeal will be dismissed.
  - ◆ An appellant who disagrees with the determination of non-compliance may petition the Chief Administrative Patent Judge under 37 CFR 41.3.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Examiner's answer – 37 CFR 41.39

- The primary examiner may furnish a written answer to the appeal within such time as directed by the Director. See § 41.39(a).
- The examiner's answer is deemed to incorporate all of the grounds of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory action and pre-appeal brief conference decision) unless the examiner expressly indicates in the examiner's answer that a ground of rejection has been withdrawn. See § 41.39(a)(1).



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Examiner's answer – 37 CFR 41.39 (cont'd)

- The examiner continues to have the ability to include a new ground of rejection in the examiner's answer. See § 41.39(a)(2)
- The Director or Director's designee must approve of the filing of the new ground of rejection in the examiner's answer. See § 41.39(a)(2)



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Examiner's answer – 37 CFR 41.39 (cont'd)

- Appellant must respond to a designated new ground of rejection to avoid *sua sponte* dismissal as to the claims subject to the new ground. See § 41.39(b).
- Appellant's response to new ground of rejection is either a request to reopen prosecution before the primary examiner by filing a reply under 37 CFR 1.111 or a request to maintain the appeal by filing a reply brief. See §§ 41.39(b)(1) and (b)(2).
- If appellant's reply brief in response to a new ground of rejection is accompanied by an amendment, affidavit, or other Evidence, it will be treated as a request to reopen prosecution. Appellant cannot continue the appeal by filing a reply brief along with an amendment, affidavit, or other Evidence in response to the examiner's new ground of rejection. See § 41.39(b)(2).



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Examiner's answer – Additional Guidance

- The Office has established guidelines to examiners and appellants as to the Office's view of what constitutes a new ground of rejection. See 76 Fed. Reg. 72276-72278 (November 22, 2011).
- It is not a new ground of rejection if the basic thrust of the rejection is the same. See *In re Kronig*, 539 F.2d 1300 (CCPA 1976). What constitutes a new ground of rejection is a highly case-specific question.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Examiner's answer – 37 CFR 41.39 (cont'd)

- Examples of factual situations that constitute a new ground of rejection:
  - ◆ Changing the statutory basis of rejection from §102 to § 103.
  - ◆ Changing the statutory basis of rejection from §103 to § 102, based upon a different teaching.
  - ◆ Citing new calculations in support of overlapping ranges.
  - ◆ Citing new structure in support of structural obviousness.
  - ◆ Pointing to a different portion of the claim to maintain a “new matter” rejection.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Examiner's answer – 37 CFR 41.39 (cont'd)

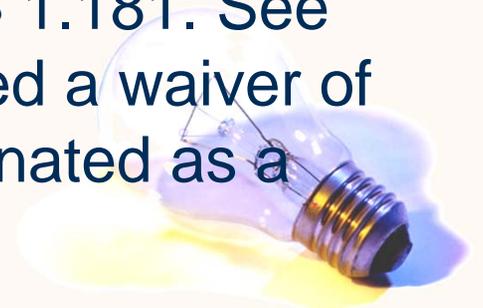
- ◆ Examples of factual situations that do not constitute a new ground of rejection:
  - Citing a different portion of a reference to elaborate upon that which has been cited previously.
  - Changing the statutory basis of a rejection from § 103 to § 102, but relying on the same teachings.
  - Relying on fewer than all references in support of a § 103 rejection, but relying on the same teachings.
  - Changing the order of references in the statement of a § 103 rejection, but relying on the same teachings of those references.
  - Considering, in order to respond to applicant's arguments, other portions of a reference submitted by applicant.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Tolling of Time Period To File a Reply Brief– 37 CFR 41.40

- The rule sets forth the exclusive procedure to seek review of a primary examiner's failure to designate a rejection as a new ground in the examiner's answer. See § 41.40(a).
- An appellant within two months from the entry of the examiner's answer and prior to the filing of a reply brief may seek review of a primary examiner's failure to designate a rejection as a new ground in the examiner's answer by petitioning to the Director under § 1.181. See § 41.40 (a). Failure to petition will be deemed a waiver of any argument that a rejection must be designated as a new ground of rejection.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Tolling of Time Period To File a Reply Brief – 37 CFR 41.40 (cont'd)

- An appellant who receives a decision granting the petition under § 1.181 will have two months from the decision to file a reply under § 1.111(a). See § 41.40(b). Failure to file the reply within two months will result in dismissal of the appeal.
- An appellant who receives a decision refusing to grant the petition under § 1.181 will have two months from the decision to file a reply brief under § 41.41. See § 41.40(c). An appellant may file only a single reply brief. Failure to file a reply brief does not result in dismissal of the appeal.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Tolling of Time Period To File a Reply Brief – 37 CFR 41.40 (cont'd)

- If appellant files a reply brief under § 41.41 prior to decision on the § 1.181 petition seeking to designate a new ground of rejection in the examiner's answer, the reply brief will be deemed a request to withdraw the petition and to maintain the appeal. See § 41.40(d).
- An extension of time to file the petition or reply brief must be filed under 37 CFR 1.136(b) for patent applications or 37 CFR 1.550(c) for *ex parte* reexamination proceedings. Extensions of time under 37 CFR 1.136(a) are not available. See § 41.40(e) and § 41.41.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Reply Brief – 37 CFR 41.41

- An appellant may file only a single reply brief within the later of two months from the date of either the examiner's answer or a decision refusing to grant a petition under § 1.181 to designate a new ground of rejection in an examiner's answer. See § 41.41(a).
- A reply brief shall not contain any new or non-admitted amendment, affidavit, or other Evidence. See § 41.41(b)(1).
- Arguments raised in a reply brief that were not raised in the appeal brief or are not responsive to arguments raised in the examiner's answer will not be considered except for good cause. See § 41.41(b)(2).



# Rules of Practice Before the BPAI in Ex Parte Appeals

## **Examiner's response to reply brief has been removed – Former 37 CFR 41.43**

- The examiner will not review the reply brief or acknowledge receipt and entry of the reply brief.
- The examiner will not be furnishing a supplemental examiner's answer.
- The removal of the examiner's response to the reply brief will shorten the appeal period.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Oral hearing – 37 CFR 41.47

- If appellant desires an oral hearing, appellant must file, as a separate paper, a written request. § 41.47(b).
  - ◆ The request must be captioned “REQUEST FOR ORAL HEARING” and must be accompanied by the fee required by § 41.20(b)(3).
  - ◆ Appellant must file the request within the earlier of two months from the date of the examiner’s answer or on the date of filing the reply brief.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Decisions and other actions by the Board - 37 CFR 41.50

- The Board may affirm or reverse an examiner's decision in whole or in part. § 41.50(a)(1).
- The Board may remand an application to examiner. § 41.50(a)(1).
- If a substitute examiner's answer is written in response to a Board remand for further consideration of a rejection, then appellant shall elect one of two options within two months to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:
  - ◆ Request to reopen prosecution, or
  - ◆ Request to maintain the appeal. §§ 41.50(a)(2)(i) and (ii).



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Decisions and other actions by the Board - 37 CFR 41.50 (cont'd)

- New Ground of Rejection – 37 CFR 41.50(b)
  - ◆ Appellant must respond to a new ground of rejection entered by the Board in order to avoid termination of the appeal as to the rejected claims. The two response options are to request to reopen prosecution or to request rehearing.
  - ◆ Request to reopen prosecution – 37 CFR 41.50(b)(1)
    - The request must include an amendment of the claims so rejected or new Evidence relating to the claims so rejected.
    - The new ground of rejection will be binding on the examiner unless an amendment or new Evidence not previously of record overcomes the new ground of rejection.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Decisions and other actions by the Board

### - 37 CFR 41.50 (cont'd)

- New Ground of Rejection – 37 CFR 41.50(b)
  - ◆ Request rehearing – 37 CFR 41.50(b)(2)
    - Appellant may request that the proceeding be reheard under § 41.52 by the Board upon the same Record.
    - The rehearing request must address any new grounds of rejection and assert what has been misapprehended or overlooked in entering new ground of rejection.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Decisions and other actions by the Board - 37 CFR 41.50 (cont'd)

Review of undesignated new ground of rejection –  
37 CFR 41.50(c)

- ◆ Appellant may request review of Board's failure to designate a new ground of rejection in its decision by filing a request for rehearing.
- ◆ Failure to timely file a request for rehearing will constitute a waiver of any argument that a decision contains an undesignated new ground of rejection.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Decisions and other actions by the Board

### - 37 CFR 41.50 (cont'd)

- Request for briefing and information – 37 CFR 41.50(d)
  - ◆ The Board may enter an order requiring an appellant to additionally brief any matter that the Board considers to be of assistance in reaching a reasoned decision in the appeal.
  - ◆ Appellant will be given a time period within which to respond to the order.
  - ◆ Failure to timely comply with the order may result in the *sua sponte* dismissal of the appeal.



# Rules of Practice Before the BPAI in Ex Parte Appeals

## Rehearing – 37 CFR 41.52

- Arguments not raised and Evidence not previously relied upon pursuant to 37 CFR 41.37, 41.41, and 41.47 are not permitted except appellants may present new arguments:
  - ◆ Based upon a recent relevant decision of either the Board or a Federal Court. See § 41.52(a)(2)
  - ◆ Responding to a new ground of rejection designated pursuant to § 41.50(b). See § 41.52(a)(3).
  - ◆ That the Board's decision contains an undesignated new ground of rejection. See § 41.52(a)(4).



# **Rules of Practice Before the BPAI in Ex Parte Appeals**

**Thank You**

