

**United States Patent and Trademark Office
Patent Trial and Appeal Board**

**REASONS APPEAL BRIEFS ARE DETERMINED
TO BE NON-COMPLIANT**

The purpose of this document is to set forth the top reasons for issuance of a notice of non-compliant appeal brief under 37 C.F.R. § 41.37(d). The information in this document is applicable to all *ex parte* appeals (excluding appeals from *inter partes* reexamination proceedings) in which a notice of appeal was filed on or after January 23, 2012.

1. Summary of Claimed Subject Matter (37 C.F.R. § 41.37(c)(iii)).

An appeal brief may be determined to be non-compliant if:

- The Summary of Claimed Subject Matter references the pre-grant patent application publication instead of referencing the specification. 37 C.F.R. § 41.37(c)(iii) specifically indicates that a reference to the pre-grant patent application publication does not satisfy the requirements of the rule.
- The Summary of Claimed Subject Matter does not provide a concise explanation for *each* of the rejected independent claims.
- The Summary of Claimed Subject Matter refers only to drawings and not to the specification.
- The Summary of Claimed Subject Matter does not identify the specific independent claim(s) that are being referenced.
- The Summary of Claimed Subject Matter references the specification using different formatting than that of the specification. It is recommended, for example, if the specification is formatted using paragraph numbers, reference should be made using paragraph numbers and not page and line numbers (unless line numbers are also used in the specification).

2. Claims appendix (37 C.F.R. § 41.37(c)(v)).

An appeal brief may be determined to be non-compliant if:

- The copy of the claims includes a new or non-admitted amendment.
- The copy of the claims includes markings such as brackets or underlining. *See* Manual of Patent Examining Procedure § 1205.02.