

Chapter 1200 Appeal

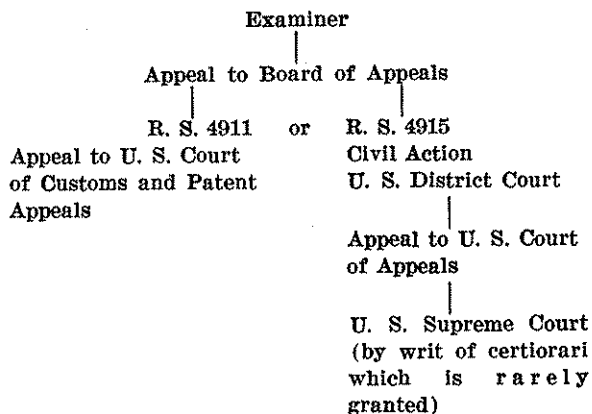
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1201 Introductory

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 or because several divisible inventions are joined in the same case, 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 (except, of course, when he is sitting as one member of a Board of Appeals).

1202 Ex Parte Review of Matters Pertaining to Merits



1203 Constitution of Board

Sec. 482 R. S.; 35 U. S. C. 7, provides for constitution of the Board of Appeals as follows:

The Commissioner of Patents, the first assistant commissioner, the assistant commissioners, and the examiners in chief shall constitute a board of appeals, whose duty it shall be, on written petition of the appellant, to review and determine upon the validity of the adverse decisions of examiners upon applications for patents and for reissues of patents and in interference cases. 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.

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 case 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 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. (Order No. 2893, Revised.)

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.

Subject alone to diligent prosecution by the applicant, an application for patent that has once been made special and advanced out of turn 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. (Extract from Notice of Aug. 9, 1950.) See 708.01 (b).

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), and every applicant who has been twice required to divide his application (rule 143), 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 rules 144 and 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.

It is to be observed that such appeal to the Board lies only from a rejection of claims, a requirement to divide being considered as a rejection of the claims for misjoinder of invention.

In addition, such appeal must include all the finally rejected claims or claims twice rejected in the case at the time appeal is taken and 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.

Exceptions:

A. Rule 144 permits an appeal from a final requirement for division in advance of any fur-

ther action on the claims. The prosecution of the elected claims may be continued during such appeal.

B. 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. The appellant shall, within sixty days from the date of the appeal, or within six months from the date of 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 and a copy of the claims involved, at the same time indicating if he desires an oral hearing.

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 1215.01 and 1215.02.

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

An amendment filed with or after appeal but before the Examiner's answer is prepared, should be given immediate consideration. Since an applicant has the right to petition from an adverse holding as to the entry of any amendment, irrespective of the status of the case at the time of filing the amendment, he is entitled to be advised as to its entry or non-entry. Such notification may be given in the Examiner's answer if the amendment is entered; but where entry is denied, the appellant should ordinarily be advised to this effect promptly and the preparation of the Examiner's answer delayed for twenty days to enable the appellant to petition, if he so desires, from the Examiner's refusal to admit the amendment.

However, where the amendment is presented before the filing of the brief and it can be readily determined on inspection that the amendment materially simplifies or clarifies the issues on appeal, the Examiner need not wait until he prepares the answer, but may enter the same forthwith and notify the appellant as soon as practicable in order that the appellant may be so advised before preparing the brief.

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 preparing 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 as may be raised in the examiner's answer, within twenty days* from the date of such answer.

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 any allegations or arguments in the brief not sufficiently treated in the final action, and should call attention to any errors in appellant's copy of the claims. The Examiner should treat affi-

*Sixty days are allowed when the Examiner's Answer indicates that a new ground of rejection is raised.

davits or exhibits in accordance with Rule 195, reporting his conclusions only on those admitted. If the Examiner finds that the applicability of the references to the appealed claims or the grounds of rejection have not been sufficiently explained in the final rejection, he should further explain the same. To the extent that is specified in Rule 106, he shall designate the particular part of each reference relied on

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 the 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.

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.

No soft copies of references not cited in the Examiner's answer should be left in the file.

A form suitable for such answer is as follows:
POL-84 (Date Stamp)

Entitled in Application | "APPEAL NO. BEFORE THE BOARD OF APPEALS"

(Name of Attorney)

"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 applicant's brief." (If any claims are incorrect, take appropriate action.)

"The references of record relied on are:

Smith ----- 1, 736, 481 June 21, 1920
Jones ----- 1, 894, 324 July 31, 1923"

(Omit references not involved in the appeal. If they are correctly listed in applicant's brief they need not be reproduced, but page of brief on which they occur should be stated.)

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. (This may be by reference to the Office action containing the final rejection, if this action is adequate and appropriate.)

Response to any allegations or arguments in the brief not sufficiently treated in the final action.

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

1208.01 Discovery of New Ground of Rejection After Appeal

When it is found necessary to rely on a newly cited reference or ground of rejection in the Examiner's Answer, the Supervisory Examiner's approval must be obtained.

Where a new ground of rejection is raised in the Examiner's Answer to the brief filed in an application on appeal, the appellant will be allowed sixty days within which he may file a reply, instead of the twenty days now permitted by Rule 193 (b). The appellant's reply, insofar as the new ground of rejection is concerned, may include any amendment or 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. (Notice of Mar. 13, 1952.)

In view of this Notice, 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 upon 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 (with the approval of the Supervisory Examiner) 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." (Notice of March 18, 1952, Revised.)

See also 1207.

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 that 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 remain-

ing 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.

[Old Rule 137]

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.

Divided jurisdiction is also present in those cases where appeal is taken from a final requirement for division only. The prosecution of the claims to the elected claims may simultaneously proceed before the Examiner as if no appeal had been taken.

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 and 1210).

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 stricken 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.

[Old Rule 138]

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 under Rule 131 is not accompanied by the showing required by 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.

[Old Rule 139]

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 in 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.

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 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 reconsidered 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 of course be filed while the case is still within the Board's jurisdiction. The time during which the request may be filed is fixed by Rule 197. 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 applicant elects to proceed before the Examiner, the statement of the Board stands as a rejection and the application is placed in the files awaiting action by applicant which action must be taken within six months from the date of the Board's decision. *Ex parte King*, 1928 C. D. 1; 366 O. G. 3. *Ex parte Buchenberg*, 1924 C. D. 55; 327 O. G. 216.

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 suit under R. S. 4915, 35 U. S. C. 63. 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

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.

Any request or petition for rehearing or reconsideration must be filed before the limit of appeal to the U. S. Court of Customs and Patent Appeals expires. (See Rule 302 for statement of time for appeal to the court.)

1214.03 Rehearing and Reconsideration

Where there is an affirmance of the Examiner on any claim, the soft copies of the patents used in the original appeal should be left in the file for at least sixty calendar days following an adverse decision by the Board for the convenience of the Board in the event that the appellant requests reconsideration.

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 rejected 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. But see 1215.04.

1214.06 Examiner Sustained in Whole or in Part

If the Examiner was sustained either in whole or in part, the next action must be taken by the applicant, either by way of further appeal or civil action or by cancellation of the rejected claims if there be an allowed claim in the case. It is improper to notify applicant of the status of the cases unless asked to do so. See *Ex parte Buchenberg*, 1924 C. D. 55; 327 O. G. 216. (Notice of Nov. 12, 1923, revised.)

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.

[Old Rule 140]

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 on approval by the Supervisory Examiner 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. (Extract from Notice, Sept. 3, 1948.)

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.

(Extract from 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 cancelled by the Examiner when necessary without further action by the applicant. (Extract from Notice, Sept. 3, 1948.)

1215.04 Failure To Prosecute Appeal

If a brief is filed within the time allowed, failure to appear at the hearing will result only in the case being considered on brief. If no brief is filed in the case of an application that was finally rejected before Mar. 1, 1949 (old rule case) the appeal stands dismissed and the application is considered as abandoned on the date set for the filing of the brief regardless of whether there are allowed claims. (Extract from Notice, Sept. 3, 1948.)

The last sentence of the foregoing notice relates to appeals governed by the old rules. With respect to appeals governed by the new rules, the following practice is to be followed:

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, the applicant being advised of the cancellation of the claims that do not stand allowed. 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.

The time for filing the brief set forth in Rule 192 can be extended only by the Commissioner. Any petition for such extension must be received before the date the brief is due 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. (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 R. S. 4915, 35 U. S. C. 63, 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.

(Extract from 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 division 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 selects those papers which in his opinion should form the transcript of record, notifies appellant of the papers selected, and forwards a list of the references to the Manuscript and Lithographic Branch.

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 other copy in the application file. The Solicitor makes a copy for publication 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 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." (R. S. 4914; 35 U. S. C. 62.) 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 cancelling 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 reversing a requirement for division or 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. (Notice of January 4, 1950.)

1216.02 Suits Under R. S. 4915

When a suit under R. S. 4915, 35 U. S. C. 63, is filed a notice thereof signed by the Solicitor of the Patent Office is placed in the application file. The file, however, is returned to the examining division and remains in the custody of the Examiner until the case comes up for trial, after which the file is kept in the Solicitor's office pending termination of the suit.

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 suit in equity 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.