

## Overview of Revised Rules of Practice Before the Board of Patent Appeals and Interferences

By Paul Rivard \*

On August 12, 2004, the United States Patent and Trademark Office (USPTO) published revised Rules of Practice Before the Board of Patent Appeals and Interferences (“Board”). Effective September 13, 2004, Part 41 is added to Title 37 of the Code of Federal Regulations to replace the former regulations covering *ex parte* appeals (37 C.F.R. §§ 1.192-196), interferences (37 C.F.R. §§ 1.601-690), and *inter partes* reexamination appeals (37 C.F.R. §§ 1.961-977). New Part 41 is divided into five subparts:

Subpart A (General Provisions, §§ 41.1-20);  
Subpart B (*Ex Parte* Appeals, §§ 41.30-54);  
Subpart C (*Inter Partes* Appeals, §§ 41.60-81);  
Subpart D (Contested Cases, §§ 41.100-158); and  
Subpart E (Patent Interferences, §§ 41.200-208).

This paper provides an overview of some key aspects of the new Board rules.

### *Ex Parte* Appeals

#### Amendments After Notice of Appeal

Under § 41.33(a), amendments submitted after the filing of a notice of appeal but prior to the filing of an appeal brief are governed by 37 C.F.R. § 1.116 (the usual after-final practice). Any amendment canceling claims or rewriting dependent claims in independent form will be entered pursuant to § 41.33(b). All other amendments usually will not be entered (§ 41.33(c)). An affidavit or other evidence filed after the date of filing an appeal and prior to filing an appeal brief may be admitted if the Examiner determines that the affidavit or other evidence overcomes all rejections under appeal and there is a showing of good and sufficient reasons why the affidavit or other evidence was not earlier presented (§ 41.33(d)).

#### *Ex Parte* Appeal Brief

Section 41.37 introduces several changes to the formal requirements for an appeal brief.

- Only one copy of an appeal brief needs to be filed, instead of three copies as previously required (§ 41.37(a)).
- The requirement to identify related appeals and interferences is expanded to include related judicial proceedings, and now specifically includes both prior and pending appeals, interferences, and judicial proceedings (§ 41.37(c)(1)(ii)). Copies of any decisions rendered in related proceedings need to be included in an appendix (§ 41.37(c)(1)(x)).

---

\* Paul Rivard is an attorney with Banner & Witcoff, Ltd. in Washington, DC. The views expressed herein are solely those of the author and should not be attributed to the firm or its clients. For further information please contact Paul Rivard at (202) 824-3000 or by e-mail at [privard@bannerwitcoff.com](mailto:privard@bannerwitcoff.com). (8/21/2004)

- The requirement to identify the status of all claims is expanded to include additional claim statuses (rejected, allowed or confirmed, withdrawn, objected to, canceled). As in former practice, the statement also needs to identify which claims are involved in the appeal.
- The concise explanation of the invention must refer to the specification by page and line number and to the drawings for each independent claim involved in the appeal. For each independent claim and each dependent claim argued separately, every means-plus-function and step-plus-function limitation must be identified and the corresponding structure or act needs to be identified in the specification by page and line number and in the drawings.
- Instead of presenting a statement of issues for review, § 41.37(c)(1)(vi) requires a concise statement listing each ground of rejection, e.g., “Claims 1-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by X.”
- The former requirement for grouping claims has been abolished. Under new § 41.37(c)(1)(vii), when an appellant argues as a group multiple claims subject to the same ground of rejection, the Board may select a single claim from that group of claims and treat its disposition on that claim as applying to all claims in the group. An appellant’s failure to argue separately claims that the appellant has grouped together constitutes a waiver of any argument that the Board must consider the patentability of any grouped claim separately.
- New § 41.37(c)(1)(ix) requires an appendix listing any evidence relied on by the appellant in the appeal, together with a statement setting forth where the evidence was entered in the record by the Examiner.

#### Examiner’s Answer

Unlike former practice, the Examiner may raise a new ground of rejection in an Examiner’s Answer (§ 41.39(a)(2)). This is intended to enable the Examiner to address arguments first made in an appeal brief. When a new ground of rejection is made in an Examiner’s Answer, the appellant must within two months either (1) request that prosecution be reopened by filing a reply under Rule 111, or (2) file a reply brief, which acts as a request that the appeal be maintained. If, however, the appellant files an amendment or evidence, it is treated as a request to reopen prosecution. The two-month period is extendible only under the limited provisions of Rule 136(b). The Examiner may submit a supplemental Examiner’s Answer to address any new issue raised in a reply brief, which may include a new ground of rejection.

#### Inter Partes Appeals

Sections 41.63(a) and (b) prohibit amendments after the date the *inter partes* proceeding has been appealed except for (1) amendments canceling claims where the cancellation does not affect the scope of other pending claims in the proceeding or (2) amendments made after prosecution has been reopened under § 41.77(b)(1).

As with *ex parte* appeal briefs, only one copy of an *inter partes* appeal brief need be filed. Changes along the lines of those discussed above for *ex parte* appeal briefs also are made with respect to (1) identifying related appeals, interferences and proceedings; (2) providing a concise explanation of the invention; (3) identifying issues for appeal; (4) grouping of claims, and (5) providing an appendix containing any evidence relied on by the appellant.

#### Patent Interferences

Subpart D provides rules for contested cases before the Board. Contested cases are predominately interferences but also include United States Government ownership contests under 42 U.S.C. §§ 2182(3) and 2457(d). Subpart E provides additional rules for patent interferences. Many of the provisions of Subparts D and E codify existing practice under Standing Orders issued by the Board during the course of individual interferences.

Section 41.121(a)(1) consolidates motions practice under former Rules 633(a), (b), (c)(2), (c)(3), (c)(4), (f), and (g). Section 41.121(a)(1)(iii) permits a motion for judgment in the contest, which can include an attack on standing or a motion for relief on the central issue. Section 41.121(a)(3) replaces former Rule 635 covering miscellaneous motions.

Section 41.128(a) restates Rule 616 on sanctions but adds the examples of misleading arguments and dilatory tactics to the list of reasons for sanctions. Section 41.128(b) restates the list of sanctions provided in Rule 616 but adds a terminal disclaimer requirement as a sanction.

Section 41.150(b) provides for automatic discovery of materials cited in the specification of an involved or benefit disclosure.

Section 41.154(c) codifies current Board requirements for exhibits. An exhibit list is required under § 41.154(d).

Section 41.155 sets forth rules for objecting to evidence and responding to objections. The default time for serving an objection to evidence is five business days. A party that submitted evidence is given ten business days after service of an objection to cure any defect in the evidence.

Section 41.157 codifies Board practice with respect to taking testimony, including the time period for taking testimony and the requirement for a conference before a deposition taken with an interpreter. Section 157(f) codifies the existing practice of requiring the proponent of testimony to pay the reasonable costs associated with making the witness available for cross examination.

Section 41.203(a) sets forth the standard for declaring a patent interference, in particular a two-way patentability test to determine whether claimed inventions interfere. Section 203(c) authorizes the judge to re-declare an interference *sua sponte* or in response to a decision on motions.

Section 41.204(a) simplifies the formal requirements for the principal notice on priority, the preliminary statement (now called a “priority statement”). Section 41.204(b) codifies current Board practice of requiring a list of motions.

Section 41.206 enables a judge to refuse to declare or terminate an interference between an application and another application or patent that are commonly owned.

Section 41.207(b) clarifies claim correspondence practice. In particular, patentability must be determined for claims, not counts. Under 207(b)(2), a claim corresponds to a count if the subject matter of the claim would have been anticipated by or obvious in view of the subject matter of the count.

Section 41.208(c)(1) requires a movant seeking to add or amend a claim to show that the added or amended claim is patentable. Section 208(c)(2) similarly requires a movant seeking to add a count to show that the count does not include unpatentable subject matter.