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USPTO's Request for Comments on Appeals Rules

MIPLA Roundtable

January 15, 2010

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Request for Comments on Appeals Rules

- FR The Office is considering modifications to the final rule (37 CFR 32938) in order to:
 - Better frame the issues so cases can be considered more effectively by conferees, board
 - Reduce the number of returns based on defective briefs
 - Reduce burden on appellants



Request for Comments on Appeals Rules

The changes being considered:

- (1) Remove requirement for petition seeking extensions of time to file certain papers after an appeal brief or seeking to exceed a page limit;
- (2) Remove requirement for a jurisdictional statement, table of contents, table of authorities, and statement of facts in appeal briefs, a table of contents, table of authorities, and statement of additional facts in reply briefs, and a table of contents and table of authorities in requests for rehearing filed in ex parte appeals;
- (3) Remove requirement for an appellant to specifically identify which arguments were previously presented to the Examiner and which arguments are new;



Request for Comments on Appeals Rules

The changes being considered (cont):

- (4) Remove specific formatting requirements and page limits for appeal briefs, reply briefs, and requests for rehearing; and
- (5) Remove requirement for list of technical terms and other unusual words for an oral hearing.
- (6) Remove prohibition on examiner entering a new ground of rejection in an examiner's answer
- (7) Remove provision allowing an examiner to file a supplemental examiner's answer in response to a reply brief.
- (8) Insert rule permitting the Chief Administrative Patent Judge, rather than the Board, may remand an application to the examiner.



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- FR Roundtable on January 20th
 - Pedersen/Gardella have rec'd approval to attend & present MIPLA comments
- FR Written comments on proposed mods to final rule due by February 12th
- FR Written comments any matters discussed at the roundtable due by February 25th



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- FR Note reversion to old appeals rules
- FR After January 21, may no longer file briefs in format specified in final rule published last summer at 73 FR 32938
- FR Appeal briefs filed on or after January 21, 2010 must comply with the “current rules” published at 37 CFR 41.1 et seq. (2007)



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Potential comments/ideas:

- (1) Require short statement identifying limitation(s) not taught by prior art or reason that a POSITA would not combine the references
- (2) Require Examiner to propose claim amendments and/or declaration evidence that would distinguish art of record
- (3) Permit (require?) interview with examiner and conferees immediately after filing of appeal brief (during which such amendments and declaration evidence would be discussed)
- (4) Provide accelerated handling where appellant takes action agreed upon during interview