

DEPARTMENT OF COMMERCE**Patent and Trademark Office****37 CFR Parts 1, 5, and 41****RIN 0651-AB32****Rules of Practice Before the Board of Patent Appeals and Interferences****AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Proposed rule.

SUMMARY: The Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office proposes changes to the rules governing practice before the Board of Patent Appeals and Interferences to consolidate and simplify such rules and to reflect developments in case law, legislation, and administrative practice.

DATES: Submit comments on or before January 26, 2004.

ADDRESSES: Submit comments:

1. By electronic mail to BPAL.Rules@uspto.gov.
 2. By mail to Mail Stop Interference, Director of the United States Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450.
 3. By facsimile to 703-308-7953.
- See the **SUPPLEMENTARY INFORMATION** for further information about submitting comments.

FOR FURTHER INFORMATION CONTACT:

Appeals: Jeffrey V. Nase or William F. Smith, 703-308-9797.

Otherwise: Richard Torczon, 703-308-9797.

SUPPLEMENTARY INFORMATION:**Relationship to Announced Rule Makings**

This notice combines two rule makings previously announced in the Unified Agenda as 0651-AB27 (Appeals) and 0651-AB32 (Interferences).

Filing Comments on This Proposed Rule

To the extent reasonably possible, the Office will make the comments available at <http://www.uspto.gov/web/offices/dcom/bpai/>. To facilitate this goal, the Office strongly encourages the submission of comments electronically, in either ASCII format or ADOBE® portable document format (pdf). Regardless of which submission mode you select, write only "Consolidated Board Rules" in the subject line to ensure prompt consideration of your comments.

Since the comments will be made available to the public, the comments

should not include information that the submitter does not wish to have published. Comments that include confidentiality notices will not be entered into the record.

The Board of Patent Appeals and Interferences (Board) has significantly overhauled its operations to address concerns about the duration of proceedings before the Board. Improvements include an increase in the number of administrative patent judges, outreach programs to educate parties and examiners about Board operations, and restructuring of Board procedures. This rule making proposes to revise the rules governing Board proceedings to better reflect these new procedures. Consistent with these improvements, the rules are also consolidated and simplified to ease use. Finally, the rules address case law and legislative changes that have occurred since the last significant revision of the Board's rules.

Explanation of Proposed Changes

In keeping with long-standing patent practice, existing rules are denominated "Rule x" in this supplementary information. The proposed rules are denominated "proposed § 41.x" to help readers distinguish between existing and proposed rules.

Rules 1(a)(1)(iii), 5(e), 6(d)(9), 8(a)(2)(i)(B) and (a)(2)(i)(C), and 11(e), and subpart E of part 1, would be removed to consolidate interference information in proposed part 41, subparts D and E.

Rules 4(a)(2); 9(g); 36; 59(a)(1); 103(g); 112; 113(a); 114(d); 131(a)(1); 136(a)(1) and (a)(2); 181(a)(3); 248(c); 292(a) and (c); 295(b); 302(b); 303(c); 304(a)(1) and (a)(2); 322(a)(3); 323; 324; 565(e); 701(c)(2)(ii); 703(a)(4), (b)(3)(ii), (b)(4), (d)(2), and (e); 704(c)(9); and 993 would be revised to change cross-references to Board proceedings.

Rule 14(e) would be revised to eliminate references to Board actions. An analogous rule for Board actions is proposed in § 41.6(a). The Office previously proposed a similar change to Rule 14(e). See "Changes to Implement Electronic Maintenance of Official Patent Application Records", 68 FR 14365 (25 March 2003), in which the paragraph in question was numbered Rule 14(f). The Office received two comments that were specific to then-proposed Rule 14(f). See <http://www.uspto.gov/web/offices/pac/dapp/opla/comments/efw/aippla.pdf> and <http://www.uspto.gov/web/offices/pac/dapp/opla/comments/efw/neifeld.pdf>. To avoid confusion with this proposed rule making, no change was adopted to the language of the rule beyond

renumbering it as Rule 14(e). 68 FR 38611, 38612, 38620 (30 June 2003). In the present proposal, the language of the rule has been simplified to avoid some of the criticisms in one comment, but the suggestion in the comments to relax the standards for publishing decisions is not being proposed. Proposed Rule 14(e)(1) would continue to state that publicly available materials are publicly available. Such materials may be published without notification to or permission from the applicant or patent owner.

Rules 17(b)-(d) and (h) would be revised to remove the Board fees, which will be relocated to proposed § 41.20.

Rule 48(a)-(c) and (i) would be revised, and Rule 48(j) added, to consolidate the cross-reference correction of inventorship for applications in contested cases before the Board.

Rules 55(a)(3) and (a)(4), and 136(b) would be revised to eliminate the cross-references to Board rules.

Rule 116 would be amended to limit amendments after a final rejection or other final action (Rule 113) in an application or in an ex parte reexamination filed under Rule 510, or after an action closing prosecution (Rule 949) in an inter partes reexamination filed under Rule 913, to such amendments filed before or with any appeal to the Board under proposed § 41.31 or § 41.61. Amendments after appeal currently treated under Rule 116 would be moved to proposed §§ 41.33 and 41.63. Rule 116(d) would be amended to permit only an amendment canceling claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, to be made in an inter partes reexamination proceeding after the right of appeal notice has issued under Rule 953, except as provided in Rule 981 or as permitted by proposed § 41.77(b)(1). Rule 116(e) would be added to set forth a standard for treatment of an affidavit or other evidence submitted after a final rejection or other final action (Rule 113) in an application or in an ex parte reexamination filed under Rule 510, or in an action closing prosecution (Rule 949) in an inter partes reexamination filed under Rule 913, but before or with any appeal (proposed § 41.31 or proposed § 41.61). The proposed standard would be that such an affidavit or other evidence could be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. This standard is currently in effect under Rule 195 for an affidavit or other evidence submitted