

Rule 191(e). In addition, the section is proposed to be amended to make clear that jurisdiction over an application may be relinquished by the Board and the application returned to the examining operation to permit processing to be completed by the examining operation before the Board takes up the appeal for decision. This is consistent with the present practice of returning an appealed application to the examining operation where some matter requiring attention has been identified prior to assignment of the appeal number and docketing of the appeal. In addition, it is proposed to permit the Board to take other appropriate action to complete the proceeding. For example, if the proceeding was not complete because one copy of the brief was missing, the Board may contact the appellant to obtain the missing copy.

Proposed § 41.37 would generally incorporate the requirements of Rule 192. In addition, it is proposed to:

(1) Change the title of the section from "Appellant's brief" to "Appeal brief".

(2) In paragraph (a), require one copy of the brief rather than three copies consistent with the Office's move to an electronic file wrapper.

(3) In paragraph (a), require the brief to be filed within two months from the date of the notice of appeal under proposed § 41.31 even if the time allowed for reply to the action from which the appeal was taken is later, which overall simplifies docketing of the due date.

(4) In paragraph (c)(1)(i), require a statement in the brief identifying by name the real party in interest even if the party named in the caption of the brief is the real party in interest. This amendment would provide appellant the necessary mechanism for complying with proposed § 41.8(a) in an appeal to the Board.

(5) In paragraph (c)(1)(ii), require identification of all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal, as well as to set forth a mechanism for complying with proposed § 41.8(b) in an appeal to the Board.

(6) In paragraph (c)(1)(iii), require both a statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(7) In paragraph (c)(1)(v), require a concise explanation of the invention defined in each of the independent claims involved in the appeal, which explanation shall refer to the specification by page and line number, and to the drawings, if any, by reference characters. For each claim involved in the appeal, it is proposed that every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, be identified and that the structure, material, or acts described in the specification as corresponding to each claimed function be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The current requirement of Rule 192(c)(5) to set forth a concise explanation of the invention defined in the claims involved in the appeal by reference to the specification by page and line number, and to the drawings, if any, by reference characters is not being followed in a great number of briefs before the Board. It is expected that the proposed requirements will be enforced by the examiner. Accordingly, any brief filed by an appellant who is represented by a registered practitioner that fails to set forth a summary which references the specification by page and line number, and to the drawing, if any, by reference characters or which fails to identify every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, would be in non-compliance with this section and would be handled as set forth in proposed paragraph (d) of this section.

(8) In paragraph (c)(1)(vi), require a concise statement listing each ground of rejection presented for review rather than issues for review. An example of a concise statement is "Claims 1 to 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. X."

(9) Delete the current grouping of claims requirement set forth in Rule 192(c)(7). The general purpose served by Rule 192(c)(7) is addressed in proposed § 41.37(c)(1)(viii). The existing grouping of claims requirement has led to many problems such as (i) Grouping of claims across multiple rejections (e.g., claims 1–9 rejected under 35 U.S.C. 102 over A while claims 10–15 are rejected under 35 U.S.C. 103 over A and the appellant states that claims 1–15 are grouped together); (ii) Claims being grouped together but argued separately (e.g., claims 1–9 rejected under § 102 over A, the appellant groups claims 1–9 together but then argues the patentability of claims 1 and 5 separately); and (iii) examiners disagreeing with the appellant's grouping of claims.

(10) In paragraph (c)(1)(vii), require that any arguments or authorities not included in the brief or a reply brief filed pursuant to proposed § 41.41 will be refused consideration by the Board, unless good cause is shown (requirement currently found in Rule 192(a)), and to require a separate heading for each ground of rejection in place of the previous Grouping of claims section of the brief. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. It is proposed that, 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 of a ground of rejection of that claim as applying to the disposition of that ground of rejection of all claims in the group of claims. Notwithstanding any other provision of this paragraph, it is proposed to make explicit by rule that 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. See *In re McDaniel*, 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1465–66 (Fed. Cir. 2002) (interpreting Rule 192(c)(7) to require separate treatment of separately rejected claims). It is further proposed that any claim argued separately should be placed under a subheading identifying the claim by number and that claims argued as a group should be placed under a subheading identifying the claims by number. For example, if Claims 1 to 5 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Y and appellant is only going to argue the limitations of independent claim 1, and thereby group dependent claims 2 to 5 to stand or fall with independent claim 1, then one possible heading as required by this subsection could be *Rejection under 35 U.S.C. 102(b) over U.S. Patent No. Y* and the optional subheading would be *Claims 1 to 5*. As another example, where claims 1 to 3 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Z and the appellant wishes to argue separately the patentability of each claim, a possible heading as required by this subsection could be *Rejection under 35 U.S.C. 102(b) over U.S. Patent No. Z*, and the optional subheadings would be *Claim 1*, *Claim 2* and *Claim 3*. Under each subheading the appellant would present the argument for patentability of that claim.

(11) In paragraph (c)(1)(vii), state that "Merely pointing out differences in