

what the claims cover is not an argument as to why the claims are separately patentable", a statement that in slightly different form appears in Rule 192(c)(7).

(12) In paragraph (c)(1)(vii), eliminate subparagraphs (i) through (v) of Rule 192(c)(8) which relate to the manner in which arguments are to be made. Although they provide useful advice as to what an effective argument ought to include, these provisions have often been ignored by appellants and, for the most part, have not been enforced as set forth in paragraph (d) of that rule.

(13) Add paragraph (c)(1)(ix) to require appellant to include an evidence appendix of any evidence relied upon by appellant in the appeal with a statement setting forth where that evidence was entered in the record by the examiner so that the Board will be able to easily reference such evidence during consideration of the appeal.

(14) Add paragraph (c)(1)(x) to require appellant to include a related proceedings appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section so that the Board can take into consideration such decisions.

(15) Add paragraph (c)(2) to exclude any new or non-admitted amendment, affidavit or other evidence from being included in the brief.

(16) Add paragraph (e) to provide notice that the periods set forth in this section are extendable under the provisions of Rule 136 for patent applications and Rule 550(c) for ex parte reexamination proceedings. This provision currently appears in Rule 191(d), but would be more useful if provided in this section.

Proposed § 41.39 would generally incorporate requirements found in Rule 193(a).

Proposed § 41.39(a)(2) would permit a new ground of rejection to be included in an examiner's answer eliminating the current prohibition of new grounds of rejection in examiner's answers. Many appellants are making new arguments for the first time in their appeal brief (apparently stimulated by a former change to the appeal process that inserted the prohibition on new grounds of rejection in the examiner's answer). Because the current appeal rules only allow the examiner to make a new ground by reopening prosecution, some examiners have allowed cases to go forward to the Board without addressing the new arguments. Thus, the proposed revision would improve the quality of examiner's answers and reduce pendency by providing for the inclusion of the new ground of rejection in an

examiner's answer without having to reopen prosecution. By permitting examiners to include a new ground of rejection in an examiner's answer, newly presented arguments can now be addressed by a new ground of rejection in the examiner's answer when appropriate. Furthermore, if new arguments can now be addressed by the examiner by incorporating a new ground of rejection in the examiner's answer, the new arguments may be able to be addressed without reopening prosecution and thereby decreasing pendency. Proposed paragraph (b) of this rule would specify the options available to an appellant who has received a new ground of rejection, including the option to request and have prosecution reopened before the examiner.

The proposed change to permit new grounds of rejection in examiner's answers would not be open-ended but is envisioned to be rare, rather than a routine occurrence. The Office plans to issue instructions that will be incorporated into the MPEP requiring that any new ground of rejection made by an examiner in an answer must be approved by a management official such as a Technology Center Director and that any new ground of rejection made in an answer be prominently identified as such. It is the further intent of the Office to provide guidance to examiners that will also be incorporated into the MPEP as to what circumstances, e.g., responding to a new argument or new evidence submitted prior to appeal, would be appropriate for entry of a new ground of rejection in an examiner's answer rather than the reopening of prosecution. Where, for example, a new argument(s) or new evidence cannot be addressed by the examiner based on the information then of record, the examiner may need to reopen prosecution rather than apply a new ground of rejection in an examiner's answer to address the new argument(s) or new evidence. Paragraph (b) of § 41.39 would provide the appellant two options when a new ground of rejection in an examiner's answer is made, including the option of having prosecution reopened.

The following examples are set forth to provide guidance as to when the Office may or may not consider a factual scenario suitable for introducing new grounds of rejection in the examiner's answer. These examples are not considered an exhaustive list of situations that meet or do not meet the criteria for making a new ground of rejection in an examiner's answer:

*Example 1:* A new ground of rejection based upon prior art may be allowed if the examiner obviously failed to include a dependent claim in a rejection. For example, in the final rejection, claims 1, 13 and 27 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Y. Claim 27 depended from claim 22 which depended from claim 13 which depended from independent claim 1. No rejection of claim 22 was set forth in the final rejection; however, the summary sheet of the final rejection indicated that claims 1, 13 and 27 were rejected. In this situation, the examiner would reject claim 22 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Y as a new ground of rejection in the answer.

*Example 2:* A new ground of rejection would not be allowed to reject a previously allowed or objected to claim even if the new ground of rejection would rely upon prior art already of record. In this instance, rather than making a new ground of rejection in an examiner's answer, if the basis for the new ground of rejection was approved by a supervisory patent examiner as currently set forth in MPEP 1208.02, the examiner would reopen prosecution.

*Example 3:* The proposed amendment is intended to continue to permit the examiner to include new grounds of rejection where appellant was advised that an amendment under Rule 116 would be entered for appeal purposes. The proposed rule would eliminate Rule 193(a)(2), which states that the filing of an amendment under Rule 116 represents applicant's consent when so advised that any appeal on that claim will proceed subject to any rejections set forth in an action from which appeal was taken. Proposed § 41.39(a)(2) broadens the situations in which an examiner can make a new ground of rejection to include circumstances currently covered by Rule 193(a)(2).

Paragraph (b) of § 41.39 would set forth the responses an appellant may make when an examiner's answer sets forth a new ground of rejection. Appellant would be required within two months from the date of the examiner's answer containing a new ground of rejection either:

(1) To request that prosecution be reopened by filing a reply under Rule 111 with or without amendment or submission of affidavits (Rules 130, 131 or 132) or other evidence, which would result in prosecution being reopened before the examiner, or

(2) To file a reply brief under § 41.41, which would act as a request that the appeal be maintained. Such a reply brief could not be accompanied by any amendment, affidavit (Rules 130, 131, or 132) or other evidence. If such a reply brief were accompanied by any amendment or evidence, it would be treated as a request that prosecution be reopened before the examiner under paragraph (b)(1) of this section. Any reply brief would have to specify the error in each new ground of rejection as set forth in § 41.37(c)(1)(viii) and should