

generally follow the other requirements of a brief set forth in § 41.37(c).

If in response to the examiner's answer containing a new ground of rejection, appellant decides to reopen prosecution of the application before the examiner, the Office will treat the decision to reopen prosecution also as a request to withdraw the appeal. If appellant fails to exercise one of the two options within two months from the date of the examiner's answer, the appeal will be dismissed (*i.e.*, terminated) *sua sponte*.

Paragraph (c) of § 41.39 is proposed to be added to provide notice that the period set forth in proposed paragraph (b) of this section is extendable under the provisions of Rule 136(b) for patent applications and Rule 550(c) for *ex parte* reexamination proceedings. This provision currently appears in Rule 191(d), but it would be more useful if provided in this section.

Proposed § 41.41 would generally incorporate requirements found in Rule 193(b). In addition:

(1) Paragraph (a) would make explicit that a reply brief could not include any new or non-admitted amendment, affidavit or other evidence.

(2) Paragraph (b) would be added to make clear that a reply brief not in compliance with paragraph (a) would not be considered. The examiner would notify the appellant in this event.

(3) Paragraph (c) would be added to provide notice that the period set forth in this section would be extendable under the provisions of Rule 136(b) 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 § 41.43 is proposed to be added to permit the examiner to furnish a supplemental examiner's answer to respond to any new issue raised in the reply brief. This would dispense with the need for the Board to remand the proceeding to the examiner to treat any new issue raised in the reply brief. It is proposed that a supplemental examiner's answer may not include a new ground of rejection. If a supplemental examiner's answer is furnished by the examiner, it is proposed to permit the appellant to file another reply brief under proposed § 41.41 within two months from the date of the supplemental examiner's answer.

The current prohibition against a supplemental examiner's answer in other than a remand situation would be removed to permit use of supplemental examiner's answers where the examiner is responding only to new issues raised in the reply brief. As a consequence, the

requirements pertaining to appellants when prosecution is reopened under Rule 193(b)(2) would be removed.

Section 41.43(a)(1) as proposed would permit the examiner to furnish a supplemental examiner's answer to respond to any new issue raised in a reply brief. It should be noted that an indication of a change in status of claims (*e.g.*, that certain rejections have been withdrawn as a result of a reply brief) is not a supplemental examiner's answer and therefore would not give appellant the right to file a reply brief. Such an indication of a change in status may be made on form PTOL-90. The Office will develop examples to help the examiner determine what would or would not be considered a new issue warranting a supplemental examiner's answer. An appellant who disagrees with an examiner's decision that a supplemental examiner's answer is permitted under this proposed rule may petition for review of the decision under Rule 181. Possible examples of new issues raised in a reply brief include the following:

*Example 1:* The rejection is under 35 U.S.C. 103 over A in view of B. The brief argues that element 4 of reference B cannot be combined with reference A as it would destroy the function performed by reference A. The reply brief argues that B is nonanalogous art and therefore the two references cannot be combined.

*Example 2:* Same rejection as in Example 1. The brief argues only that the pump means of claim 1 is not taught in the applied prior art. The reply brief argues that the particular retaining means of claim 1 is not taught in the applied prior art.

Paragraph (a)(1) of proposed § 41.43 would also set forth the ability of the examiner to withdraw the final rejection and reopen prosecution as an alternative to the use of a supplemental examiner's answer. The primary examiner's decision to withdraw the final rejection and reopen prosecution to enter a new ground of rejection will require approval from the supervisory patent examiner as currently set forth in MPEP 1208.02.

Paragraph (b) of proposed § 41.43 would permit appellant to file a supplemental reply brief in response to a supplemental examiner's answer within two months from the date of the supplemental examiner's answer. That two-month time period may be extended under the provisions of Rule 136(b) for patent applications and Rule 550(c) for *ex parte* reexamination proceedings as set forth in proposed § 41.43(c).

Proposed § 41.47 would generally incorporate the requirements of Rule 194. In addition:

(1) Paragraph (b) is proposed to be amended to require the separate paper requesting the oral hearing to be captioned "REQUEST FOR ORAL HEARING" and that such a request can be filed within two months from the date of the examiner's answer or supplemental examiner's answer.

(2) Paragraph (d) is proposed to be added to set forth the procedure for handling the request for oral hearing when an appellant has complied with all the requirements of paragraph (b) of this section. Since notice to the primary examiner is a matter internal to the Office, it is proposed that the requirement for notice to the primary examiner be removed from the rule. It is anticipated that the primary examiner will be sent notice of the hearing time and date by e-mail.

(3) Paragraph (e) is proposed to be added to specifically provide that at the oral hearing (i) appellant may only rely on evidence that has been previously considered by the primary examiner and present argument that has been relied upon in the brief or reply brief; (ii) the primary examiner may only rely on argument and evidence raised in the answer or a supplemental answer; and (iii) that appellant opens and concludes the argument (*i.e.*, the order of the argument at the hearing is: Appellant opens, then the primary examiner argues, then the appellant concludes presuming that appellant has reserved some time for a concluding argument).

(4) The substance of proposed paragraph (f) is found in Rule 194. Exemplary situations where the Board may decide no hearing is necessary include those where the Board has become convinced, prior to hearing, that an application must be remanded for further consideration prior to evaluating the merits of the appeal or that the examiner's position cannot be sustained in any event.

(5) Paragraph (g) is proposed to be added to provide notice that the periods set forth in this section are extendable under the provisions of Rule 136(b) 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 § 41.50 would generally incorporate the requirements of Rule 196. In addition:

(1) Paragraph (a)(1) would explicitly provide that the Board, in its principal role under 35 U.S.C. 6(b) of reviewing adverse decisions of examiners, may in its decision affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. The Board