

may also remand an application to the examiner.

(2) Paragraph (a)(2) would be added to require appellant to respond to any supplemental examiner's answer issued in response to a remand from the Board to the examiner for further consideration of a rejection to avoid *sua sponte* dismissal of the appeal as to all claims under appeal. It is proposed that appellant must exercise one of the following two options to avoid such *sua sponte* dismissal of the appeal as to all claims under appeal: (i) Request that prosecution be reopened before the examiner by filing a reply under Rule 111 with or without amendment or submission of affidavits (Rules 130, 131 or 132) or other evidence, and (ii) request that the appeal be maintained by filing a reply brief as provided in proposed § 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the examiner under proposed § 41.50(a)(2)(i). Any request that prosecution be reopened under this paragraph would be treated as a request to withdraw the appeal.

A first example of a remand from the Board to the examiner for further consideration of a rejection is a remand for the examiner to provide additional explanation as to how a reference anticipates a claim (*i.e.*, asking the examiner to set forth a *prima facie* case of anticipation). A second example of a remand from the Board to the examiner for further consideration of a rejection is a remand for the examiner to ascertain (*i.e.*, set forth) the differences between the claimed subject matter of the primary reference in an obviousness rejection and then to state why the claimed subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art (*i.e.*, asking the examiner to set forth a *prima facie* case of obviousness).

A first example of a remand from the Board to the examiner that is not for further consideration of a rejection is a remand for the examiner to consider an Information Disclosure Statement. A second example of a remand from the Board to the examiner that is not for further consideration of a rejection is a remand for the examiner to consider a reply brief.

(3) Paragraph (b)(2) would eliminate the provision relating to requests that the application or patent under *ex parte* reexamination be reheard, since that provision would be included in proposed § 41.52(a).

(4) Paragraph (c) would provide that the opinion of the Board may include an

explicit statement how a claim on appeal could be amended to overcome a specific rejection and that when the opinion of the Board included such a statement, appellant would have the right to amend in conformity therewith. Such an amendment in conformity with such statement would overcome the specific rejection, but an examiner could still reject a claim so-amended, provided that the rejection constituted a new ground of rejection.

(5) Paragraph (d) would provide that appellant's failure to timely respond to an order of the Board of Patent Appeals and Interferences could result in the dismissal of the appeal.

(6) Paragraph (f) would 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 it would appear to be more useful if provided in this section.

Proposed § 41.52 would generally incorporate the requirements of Rule 197(b). In addition, paragraph (a) is proposed to be amended to incorporate the matter being deleted from Rule 196(b)(2) relating to the request that the application or patent under *ex parte* reexamination be reheard. In addition, the rule as proposed would permit the Board to simply deny a request for rehearing in appropriate cases rather than rendering a new opinion and decision on the request for rehearing. Paragraph (b) is proposed to be added to provide notice that the period set forth in 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 would be more useful if provided in this section.

Proposed § 41.54 would generally incorporate the requirements of Rule 197(a).

Proposed § 41.56 provides that an appeal under this proposed subpart is terminated by the dismissal of the appeal or when, after a final Board action a notice of appeal under 35 U.S.C. 141 is filed, a civil action under 35 U.S.C. 146 is commenced, or the time for seeking judicial review (Rule 304) has expired. Termination of an appeal under this proposed subpart is the cessation of the appeal proceeding before the Board and is distinct and separate from the termination of proceedings on an application (proposed Rule 197(b)) or the termination of proceedings on an *ex parte* reexamination proceeding which is concluded by the issuance of a

certificate pursuant to Rule 570. A dismissal of an appeal results in a termination of the appeal proceeding before the Board. After dismissal of an appeal, an application is returned to the examiner to determine the proper course of action (*e.g.*, possible allowance and issuance if there are allowed claims; possible abandonment if there are no allowed claims) as set forth in sections 1214 to 1215.04 of the MPEP. After dismissal of an appeal, an *ex parte* reexamination proceeding is returned to the examiner to issue the appropriate certificate pursuant to Rule 570.

Proposed subpart C provides rules for the inter partes appeal under 35 U.S.C. 315 of a rejection in an inter partes reexamination proceeding to the Board. This proposed subpart does not apply to any other Board proceeding and is strictly limited to appeals in inter partes reexamination proceedings filed under 35 U.S.C. 311.

The preamble to proposed § 41.60 is based on a similar provision in the preamble of Rule 601. The term "proceeding" provides a shorthand reference to an inter partes reexamination proceeding. The term "owner" provides a shorthand reference to the owner of the patent undergoing inter partes reexamination under Rule 915. The term "requester" provides a generic term to describe each party other than the owner who requested that the patent undergo inter partes reexamination under Rule 915. The term "appellant" provides a generic term for any party, whether the owner or a requester, filing a notice of appeal or cross appeal under proposed § 41.61. If more than one party appeals or cross appeals, each appealing or cross appealing party is an appellant with respect to the claims to which his or her appeal or cross appeal is directed. The term "respondent" provides a generic term for any requester responding under proposed § 41.68 to the appellant's brief of the owner, or the owner responding under proposed § 41.68 to the appellant's brief of any requester. No requester may be a respondent to the appellant brief of any other requester. The terms "appellant" and "respondent" are currently defined in Rule 962. The proposed definition of the term "filing" provides a generic requirement that any document filed in the proceeding by any party must include a certificate indicating service of the document to all other parties to the proceeding as required by Rule 903.

Proposed § 41.61 would generally incorporate the requirements of current Rule 959 and the changes thereto proposed in "Changes To Implement the