

2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute”, 68 FR 22343 (28 April 2003) (RIN 0651-AB57).

Proposed § 41.63(a) and (b) would replace the requirements of current Rule 116 with a prohibition of amendments submitted after the date the proceeding has been appealed pursuant to proposed § 41.61, except for amendments permitted by proposed § 41.77(b)(1) and amendments canceling claims where such cancellation does not affect the scope of any other pending claim in the proceeding. Proposed § 41.63(c) would replace the requirements of Rule 975 with a prohibition on the admission of affidavits and other evidence submitted after the case has been appealed pursuant to proposed § 41.61 except as permitted by proposed § 41.77(b)(1). This would replace the current practice of permitting such evidence based on a showing of good and sufficient reasons why such evidence was not earlier presented. The Office believes that prosecution of an application should occur before the examiner prior to an appeal being filed, not after the case has been appealed pursuant to proposed § 41.61.

Proposed § 41.64 would generally incorporate the requirements of Rule 961, but would make clear that jurisdiction over a proceeding may be relinquished and the proceeding returned to the examining operation to permit processing to be completed before the Board takes up the appeal for decision.

Proposed § 41.66 would generally incorporate the requirements of Rule 963.

Proposed § 41.67 would generally incorporate the requirements of Rule 965 and the changes thereto proposed in “Changes To Implement the 2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute”, 68 FR 22343 (28 April 2003) (RIN 0651-AB57). In addition, it is proposed:

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

(2) In paragraph (c)(1)(i), to 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 provides appellant the necessary mechanism of complying with proposed § 41.8(a) in an appeal to the Board;

(3) In paragraph (c)(1)(ii), to require clear 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 provide a mechanism of complying with proposed § 41.8(b) in an appeal to the Board.

(4) In paragraph (c)(1)(iii), to 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.

(5) In paragraph (c)(1)(v), to require a concise explanation of the subject matter defined in each of the independent claims involved in the appeal and which concise 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. Any brief filed by an appellant who is represented by a registered practitioner that fails to provide a summary of the claimed subject matter 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 provided in proposed paragraph (d) of this section.

(6) In paragraph (c)(1)(vi), to require a concise statement listing each issue presented 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.

(7) To delete the current grouping of claims requirement set forth in Rule 965(c)(7). The general purpose served by Rule 965(c)(7) is addressed in proposed § 41.67(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.

(8) In paragraph (c)(1)(vii), to set forth that any arguments or authorities not included in a brief permitted in this section or filed pursuant to proposed §§ 41.68 and 41.71 will be refused consideration by the Board, unless good cause is shown, 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. 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 appellant has grouped together would constitute 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 analogous 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.

(9) In paragraph (c)(1)(vii), to state that “Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.” This statement in slightly different form is in Rule 965(c)(7).

(10) In paragraph (c)(1)(vii), to eliminate subparagraphs (i) through (v) of Rule 965(c)(8), which relate to the manner in which arguments are to be made. Although providing 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 provided in Rule 965(d).

(11) To 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 would be