

able to reference such evidence easily during their consideration of the appeal.

(12) To 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 proposed § 41.67(c)(1)(ii) so that the Board can take into consideration such decisions.

(13) Add paragraph (c)(2) to exclude any new or non-admitted amendment, affidavit or other evidence from being included in an appellant's brief.

Proposed § 41.68 would generally incorporate requirements found in Rule 967 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), and changes similar to those proposed in § 41.67. In addition, it is proposed to add paragraph (b)(2) to exclude any new or non-admitted amendment, affidavit or other evidence from being included in a respondent's brief.

Proposed § 41.69 would generally incorporate requirements found in Rule 969.

Proposed § 41.71 would generally incorporate requirements found in Rule 971 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 (April 28, 2003) (RIN 0651-AB57).

Proposed § 41.73 would generally incorporate the requirements of Rule 973. In addition:

(1) Paragraph (b) would 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.

(2) Paragraph (d) would be added to provide the procedure for handling the request for oral hearing in which a party 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) would be added to specifically provide that at the oral hearing (i) parties may only rely on evidence that has been previously considered by the primary examiner and present argument that has been relied upon in the briefs; (ii) the primary examiner may only rely on argument and evidence relied upon in the answer;

and (iii) that the Board will determine the order of the arguments presented at the oral hearing.

(4) The substance of proposed paragraph (f) is found in Rule 194. Exemplary situations where the Board might decide no hearing is necessary include those where the Board has become convinced, prior to hearing, that the proceeding must be remanded for further consideration prior to evaluating the merits of the appeal.

Proposed § 41.77 would generally incorporate the requirements of Rule 977 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 (April 28, 2003) (RIN 0651-AB57).

Proposed § 41.79 would generally incorporate the requirements of current Rule 979 concerning rehearing before the Board. Paragraph (b) is proposed to be amended to generally incorporate the requirements of current Rule 979(d). Paragraph (c) is proposed to be amended to generally incorporate the requirements of current Rule 979(b). Paragraph (d) is proposed to be amended to generally incorporate the requirements of current Rule 979(c). Paragraph (e) is proposed to be amended to generally incorporate the requirements of current Rule 979(g).

Proposed § 41.81 would generally incorporate the requirements of current Rule 979(e) 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 (April 28 2003) (RIN 0651-AB57).

Proposed § 41.83 would incorporate some of the requirements found in current Rule 979(f) and would provide that an appeal by a party under this proposed subpart is terminated by the dismissal of that party's appeal, or when, after a final Board action, a notice of appeal under 35 U.S.C. 141 is filed or the time for seeking judicial review (Rule 983) has expired. Termination of an appeal by a party under this proposed subpart is the cessation of that appeal proceeding before the Board and is distinct and separate from the termination of proceedings on an inter partes reexamination proceeding which is concluded by the issuance of a certificate pursuant to Rule 997.

Proposed subpart D would provide rules for contested cases. Contested cases are predominantly patent interferences under 35 U.S.C. 135(a), but also include United States Government ownership contests under 42 U.S.C. 2182[3] and 2457(d). The proposed rules in this proposed subpart would be more

general than the existing rules for three reasons. First, while three different statutory proceedings are currently conducted under "interference rules", the rules are only tailored to patent interferences. Second, the considerable detail of the current rules has fostered a tendency toward technical compliance with the rules rather than actually proving a case (*e.g.*, *Hillman v. Shyamala*, 55 USPQ2d 1220, 1221 (BPAI 2000)). Third, experience with the current rules suggests that attempts to codify the procedures for contested cases too precisely frustrates the policy of administering interferences in a fast, inexpensive, and fair manner. Consequently, the rules would be simplified to give parties adequate guidance about the procedures while permitting the Board to design an approach appropriate to each case. The proposed rules would also better describe the practice for most interferences declared since October 1998. A more complete understanding of existing practice as it relates to the current rules can be obtained from reading the Interference Trial Section's Standing Order, which can be found at http://www.uspto.gov/web/offices/dcom/bpai/standing_2003May.pdf.

Proposed § 41.100 would define two terms. The term "business day" would be defined in a manner consistent with 35 U.S.C. 21(b) to exclude Saturday, Sunday, and Federal holidays, when the closure of the Board may affect the Board's, or a party's, ability to perform an action.

The term "involved" appears in 35 U.S.C. 135(a) with respect to claims and is implicitly defined in Rule 601(f) (for claims) and in Rule 601(l) (for applications), but is not explicitly defined in the current rules. The proposed rule would expressly define "involved" as designating any patent application, patent, or claim that is the subject of the contested case.

Proposed § 41.101 would follow the practice in Rule 611(a) and (b) for notifying parties of a contested case. As a courtesy, the Board would make reasonable efforts to provide notice to all parties. Note that failure to maintain a current correspondence address may result in adverse consequences. Cf. *Ray v. Lehman*, 55 F.3d 606, 610, 34 USPQ2d 1786, 1788-89 (Fed. Cir. 1995) (finding notice of maintenance fee provided to obsolete, but not updated, address of record to have been adequate).

Proposed § 41.102 would require completion of examination for most applications (and of reexamination for most patents) before the Board will institute a contested case. Contested