In re Lister, Docket No. 2009-1060 (Fed. Cir. 9/23/2009) and the Doctrine of Waiver of New Arguments On Appeal

By Rick Neifeld, Neifeld IP Law, PC[1]

Several commentators noted that In re Lister, Docket No. 2009-1060 (Fed. Cir. 9/22/2009) is significant for clarifying the conditions for a document to be accessible as prior art (specifically "evidence that it was in fact included in either Westlaw or Dialog prior to the critical date.") I think Lister is also notable for clarifying the issue of waiver respecting an argument on appeal. Specifically, that timely disagreement with an examiner's underlying factual finding supporting a rationale for a ground of rejection is sufficient to avoid waiver of a new argument on appeal contesting that rationale. See footnote 3, which states:

> 3 The government argues that Dr. Lister waived this argument by failing to raise it before the Board. Although it may not have been the primary focus of the brief he submitted to the Board, we nevertheless find that the brief sufficiently expressed Dr. Lister's disagreement with the examiner's finding that the manuscript was listed in a keyword searchable database prior to the critical date. See J.A. 296-98. [In re Lister, Docket No. 2009-1060 (Fed. Cir. 9/22/2009).]

Footnote 3 indicates that Dr. Lister had not waived his right to an argument. Under the doctrine of waiver, an argument not made on appeal to the Board need not be considered in Court review of the Board decision. Similarly, an argument not raised before the examiner will usually not be considered by the Board in its decision on appeal.[2]

Waiver is an important issue respecting appeals in patent applications. One reason for the significance of waiver is that the reasoning of decisions of the Board of Patent Appeals and Interferences affirming rejections often differs from the reasons originally provided by the examiners. Moreover, the reasoning of an examiner contained in an examiner's answer often differs from the reasoning of the examiner in the office action from which an applicant appealed. Responding to such changes in reasoning is like shooting at a moving target; requiring a new argument. And any such new argument might be excluded under the doctrine of waiver.

However, the facts embodied in the evidence of record do not change. And the facts relied upon by the examiner do not change. Lister therefore suggests some relief from the vagaries in examiner and Board reasoning. Specifically, Lister supports the proposition that an appellant is entitled to consideration of a new argument on appeal, so long as the appellant timely challenged the factual assertions of the examiner underlying the ground of rejection related to the new argument. The reasoning of Lister is that the argument is not new, and therefore cannot be excluded on the basis of waiver. This reasoning why Lister's argument was considered is not therefore that it was an exception to the waiver rule, but that it was tantamount to an argument originally presented.

Finally, note that exceptions to application of waiver are enumerated in Forshey v. Principi, 284 F.3d 1335 (Fed. Cir. 2002) .[3] Forshey does not recognize the fact pattern relating to footnote 3 in Lister.

The obvious practice point from footnote 3 in Lister is that one should clearly and unequivocally challenge factual assertions of the examiner on the record in the appeal before the examiner and before the Board, to reduce the chance that arguments relating there are subject to

the doctrine of waiver.

1. I can be reached via the firm's web site http://www.neifeld.com or via telephone at 703-415-0012.

2. See In re Watts, 354 F.3d 1362 2004 U.S. App. LEXIS 572, **; 69 U.S.P.Q.2D (BNA) 1453 (Fed. Cir. January 15, 2004) ("Here we decline to consider the appellant's new argument regarding the scope of the Gephardt patent raised for the first time on appeal. Because the appellant failed to argue his current interpretation of the prior art below, we do not have the benefit of the Board's informed judgment on this issue for our review. Moreover, Watts has shown no reason why we should excuse his failure to raise this argument before the Board. See Forshey, 284 F.3d at 1355 (listing circumstances in which failure to raise an argument below may be excused). Consequently, we hold that the appellant has waived his argument that Gephardt fails to disclose the critical I/O limitation because it teaches to process all activities at full clock speed.")

As to application of waiver by the Board, it appears to have discretion to apply the doctrine in view of Watts. Board decision often state that only arguments made on appeal were considered and all other arguments are considered to have been waived.

3. The Court enumerated factors relating to waiver in Forshey v. Principi, 284 F.3d 1335 (Fed. Cir. 2002). However, there, it held only that "in future cases, we may consider such issues where it is appropriate to do so under all the circumstances."