

New Rules of Practice Before the  
Board of Patent Appeals and  
Interferences - The Proposed New  
Rules for Ex Parte Appeals, Appeals  
Data, and Practice Advice  
FOR: AIPLA  
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- Richard A. Neifeld, Ph.D. Patent Attorney
- Neifeld IP Law, PC - [www.Neifeld.com](http://www.Neifeld.com)
- [Rneifeld@Neifeld.com](mailto:Rneifeld@Neifeld.com)

# OUTLINE

1. INTRODUCTION
2. DELAYS IN APPEALS
3. PROCEDURAL CHANGES - PROPOSED  
CHANGES TO RULES
4. CHANGES TO BRIEFS – NEW  
REQUIREMENTS
5. SUMMARY AND CONCLUSION

# 1. INTRODUCTION

- PROPOSED RULES FOR EX PARTE APPEALS PUBLISHED FOR COMMENT 7/2007
- CAPJ FLEMING INDICATES THAT MODIFIED VERSIONS OF THE RULES ARE MOVING FORWARD
- DISCUSS APPEALS STATISTICS AND ANALYSIS
- MODIFIED VERSION OF PROPOSED RULES

# 1. INTRODUCTION

**THIS IS A *REALLY* BORING TOPIC!**

**WHY SHOULD YOU CARE?**

- SUBSTANTIALLY DELAY ISSUANCE
- LOST PATENT TERM ADJUSTMENT (PTA)
- LOSS OF APPEAL, DISMISSAL OF APPEAL, SANCTIONS, ABANDONMENT OF APPLICATION!

# INTRODUCTION

- Ex Parte Letts, BPAI Precedential Decision
- Failure to properly list claims/separately argue
- Adverse panel decision, based upon procedural failure to properly list claims argued separately!

# INTRODUCTION

- **Letts**: "this opinion ... put[s] appellants on notice ... appellants should not expect the Board in the future to exercise discretion to permit them from avoiding the consequence ... [a]dherence to the requirements of the rules is essential."

## 2. DELAYS IN APPEALS

- APPEALS MAY LAST SEVERAL YEARS
- LONGER IN SOME AREAS (AKA BUSINESS METHODS)
- IMPACT ON PATENT TERM

# DELAYS IN APPEALS

- SUCCESSFUL APPEAL – PTA
- PTA FROM DATE OF NOTICE OF APPEAL UNTIL FINAL DECISION OR NOTICE OF ALLOWANCE. 37 CFR 1.703(b)(4); 35 USC 154(b)(1)(C)(iii)

# DELAYS IN APPEALS

- FAILURE OF REASONABLE EFFORTS TO PROSECUTE RESULTS IN A REDUCTION IN PTA
- 37 CFR 1.704(c)(7) REDUCES PTA BY PERIOD FROM FILING A “REPLY” HAVING AN OMISSION TO DATE OF FILING OF PAPER CORRECTING THE OMISSION

# DELAYS IN APPEALS

DOES 37 CFR 1.704(c)(7) APPLY TO  
TIME PERIOD FROM FILING A  
DEFECTIVE APPEAL BRIEF UNTIL  
FILING A CORRECTED APPEAL  
BRIEF?

- RULE CONSTRUCTION – YES
- CURRENT PTO  
PROCEDURE/POLICY – NO

# DELAYS IN APPEALS

## CONCLUSIONS

- 37 CFR 1.704(c)(7) MAY REDUCE PTA DUE TO DEFECTIVE APPEAL BRIEFS
- YOUR PATENT TERM MAY BE LESS THAN YOU THINK
- YOU MAY FIND THAT OUT ONLY IN LITIGATION

# DELAYS IN APPEALS

## BRIEF COMPLIANCE STATISTICS

- *MAJORITY* OF BRIEFS REJECTED
- EXAMINER, UPON REVIEW OF BRIEF
- BPAI, UPON RECEIPT OF THE FILE
- EXAMINER REQMT - MONTHS LATER
- BPAI REQMT – YEARS LATER
- SEE THE PAPER FOR MORE STATISTICS

# DELAYS IN APPEALS

- PROPOSED RULES ELIMINATE THE REQUIREMENT THAT THE EXAMINER REVIEW BRIEFS FOR REGULATORY COMPLIANCE
- UNDER PROPOSED RULES, REQMT TO CORRECT DEFECTIVE BRIEF IS DELAYED OR REMOVED
- IMPACT – DELAY, PTA
- IMPACT - SUBSTANTIVE DECISION ON APPEAL (NOTE CAPJ'S INPUT.)

# DELAYS IN APPEALS

## BRIEF NON COMPLIANCE EXAMPLES (FROM APPEALS ADMINISTRATOR)

- 1. Incomplete evidence section; missing cited evidence
- 2. Failure to show support for claims wherein a MPF dependent claim was argued separately
- 3. Claims appendix listing claim as amended by an amendment after final that was not entered
- 4. Partial documents, missing pages, only 1 side of 2 sided documents
- 5. Unsigned briefs

# DELAYS IN APPEALS

## EXAMINER NON COMPLIANCE EXAMPLES (FROM APPEALS ADMINISTRATOR)

- BPAI Order to the examiner to correct the record
- 1. Papers not acted on: IDS; petition.
- 2. Defects in Examiner Answer: failing to properly list the applied prior art; new ground of rejection without authorizing signature from TC director or delegee (as required by MPEP 1207.03); supplemental examiner's answer without authorizing signature from TC director or delegee (as required by MPEP 1207.03)

# DELAYS IN APPEALS

## TO AVOID PROBLEMS

- ENSURE *YOU* HAVE COMPLIED
- ENSURE *THE EXAMINER* HAS COMPLIED
- PETITION AGAINST IMPROPER ALLEGATIONS OF APPELLANT NON COMPLIANCE

# 3. PROCEDURAL CHANGES

SEE TABLE V IN THE PAPER FOR  
SIDE BY SIDE COMPARISON  
OF EXISTING AND PROPOSED  
RULES.

# 3. PROCEDURAL CHANGES

- 3.A – CAPJ FLEMING’S RECENT UNPUBLISHED CHANGES TO THE PUBLISHED PROPOSED RULES
- 3.B – PUBLISHED RULES

# 3.A CAPJ'S RECENT CHANGES TO PROPOSED RULES

- PROPOSED RULES WERE TOO COMPLICATE; SIMPLIFY!
- STREAMLINE THE PROCESS BY ELIMINATING OPTIONS

# 3.A CAPJ'S RECENT CHANGES TO PROPOSED RULES

- **NO SUPPLEMENTAL ANSWER**
- **NO NEW GROUNDS OF REJECTION IN ANSWER**
- **JURISDICTION PASSES TO BPAI UPON FILING OF THE REPLY BRIEF (REPLY BRIEF **NOT** REVD. BY EX.)**

## 3.A PROCEDURAL CHANGES

RED TEXT HERE AFTER MEANS  
THE PUBLISHED PROPOSED  
RULE INCONSISTENT WITH THE  
CAPJ'S *RECENT CHANGES* TO  
THE PUBLISHED PROPOSED  
RULES

# 3.B PROCEDURAL CHANGES

EXAMINER'S WILL NOT REVIEW  
BRIEFS FOR COMPLIANCE WITH  
APPLICABLE RULES

## 3.B PROCEDURAL CHANGES

1.136(a) APPLIES TO APPELLANT TIME FOR *REOPENING PROSECUTION* IN RESPONSE TO AN EXAMINER'S ANSWER (EA) CONTAINING A *NEW REJECTION (NR)*, BUT NOT FOR FILING A REPLY BRIEF (RB) IN RESPONSE TO AN EA CONTAINING A *NR*

## 3.B PROCEDURAL CHANGES

- APPLICATION ***ABANDONED***, IF NO RESPONSE TO EA CONTAINING NR (NO PROVISION FOR ALLOWING ALLOWED CLAIMS)

## 3.B PROCEDURAL CHANGES

- EXAMINER MAY ENTER A ***NR*** IN A SUPPLEMENT EA (*SEA*) TO A RB
- *SUPPLEMENTAL RB* – 10 PAGE LIMIT.

# 3.B PROCEDURAL CHANGES

## RESPONSE TO DECISIONS

- IN RESPONSE TO A SEA BASED UPON A BPAI PANEL REMAND, TO MAINTAIN THE APPEAL, APPELLANT MUST FILE
- 1. A ***REQUEST FOR REDOCKETING***
- A RB
- ***APPLICATION ABANDONED*** IF NO RESPONSE TO SEA (NO PROVISION FOR ALLOWING ALLOWED CLAIMS)

# 3.B PROCEDURAL CHANGES

## RESPONSE TO DECISIONS

- REQUEST FOR REHEARING - 10 PAGE LIMIT
- FAILURE TO RESPOND TO A BPAI PANEL'S NR RESULTS IN APPEAL DISMISSED "AS TO ANY CLAIM SUBJECT TO THE NR."

# 3.B PROCEDURAL CHANGES

## RESPONSE TO DECISIONS

- MECHANISM TO ALLOW FOR COURT APPEAL ON FINALLY REJECTED CLAIMS WHEN APPLICATION ON REMAND TO EXAMINER FOR OTHER CLAIMS
- AKA – SPLITTING JURISDICTION IN APPLICATION BETWEEN COURT AND EXAMINER

## 3.B PROCEDURAL CHANGES

- “Following proceedings on remand, and with respect to affirmed rejections and claims not involved in the remand, an appellant could request the Board to enter a final decision so that the appellant could then seek judicial review as to those rejections and claims.” 72 FR41481

# 4. CHANGES TO BRIEFS (ALL THE *NEW* WAYS TO DRAFT DEFECTIVE BRIEFS)

- INCREASED REQUIREMENTS
- SUBSTANTIALLY THE SAME REQUIREMENTS FOR AB, RB, SRB, AND REQUEST FOR REHEARING
- LIKE MOTIONS IN INTERFERENCES

# SANCTIONS FOR LACK OF COMPLIANCE

- PROPOSED 41.56 “SANCTIONS”
- SANCTIONS “MAY BE IMPOSED” FOR FAILURE TO COMPLY WITH “ORDER, ... *RULE,*” ETC.
- LISTED SANCTIONS RANGE UP TO ABANDONED OF APPLICATION
- RULES PUBLICATION PROVIDES NO GUIDANCE ON SANCTIONS

# SANCTIONS FOR LACK OF COMPLIANCE

- BUT CAPJ'S PROPOSED CHANGES REQUIRE CAPJ PRE APPROVAL OF ANY SANCTION (SAFEGUARD)

# CHANGES TO BRIEFS

- Proposed 41.37(e) specifies the requirements for the content of the brief. They include, under appropriate headings and in the order indicated:
  - (1) Statement of the real party in interest.
  - (2) Statement of related cases.
  - (3) Jurisdictional statement.
  - (4) Table of contents.
  - (5) Table of authorities.
  - **(6) Status of claims.**
  - (7) Status of amendments.
  - (8) Rejections to be reviewed.
  - (9) Statement of facts.
  - (10) Argument.
  - (11) An appendix containing a claims section, a claim support section, a drawing analysis section, a means or step plus function analysis section, an evidence section and a related cases section.

# CHANGES TO BRIEF CONTENTS

- (2) *Statement of related cases* – Must include court docket number.
- (6) Status of claims – “Rejected, Allowed, Canceled, Withdrawn from consideration, Objected to.”
- (9) Statement of facts. – Requires material facts, with point cites to Record

# CHANGES TO BRIEF CONTENTS

- (10) Argument. – Point cite to Record where argument was made, *or state argument not of record*
- (10) Argument. – Requires **explicit election** that claims do not stand or fall together
- (10) Argument. – Subheading for claims argued separately, *with claim numbers in the subheading*

# CHANGES TO BRIEF CONTENTS

(11) Appendix containing a claim section –

- **All** claims pending in application
- **Parenthetical status identifiers**  
“e.g. (1) (Rejected), (2) (Withdrawn), 3 (objected to), 4 (allowed)”

# CHANGES TO BRIEF CONTENTS

- (11) Appendix containing **three claim support sections**, each with claims annotated with “{}” identifying support
- Annotated claims for each claim argued separately:
    - (1) page and line number in specification
    - (2) figure and element number or sequence
    - (3) means plus function
  - *Must state no drawing or sequence, or no MPF, if none exist.*

# CHANGES TO BRIEF CONTENTS

- (11) Appendix containing an evidence section - **Table of contents for evidence section**
- (11) Appendix containing an evidence section - **All office actions** setting out the rejections on appeal
- (11) Appendix containing an evidence section - **All evidence relied on by the examiner** other than published US patent documents, and the disclosure
- (11) Appendix containing an evidence section - Portion of any **prior filing containing any argument** being made on appeal
- (11) Appendix containing an evidence section - Declaratory evidence; any other evidence relied upon while before the examiner (**even if not relied upon in the appeal**)

# CHANGES TO BRIEF FORMAT

PAGE LIMITS: 25/15/10!

# CHANGES TO BRIEF FORMAT

- COMPLY WITH RULE 1.52 (A4 OR 8.5 BY 11; PORTRAIT)
- DOUBLE SPACED LINES
- MINIMUM 1 INCH MARGINS
- 14 POINT TIMES NEW ROMAN FONT
- BRIEF AND ALL SECTIONS OF THE APPENDIX MUST
  - (1) BE *CONSECUTIVELY NUMBERED*
  - (2) *HAVE PAGE NUMBER AT THE TOP*

# CHANGES TO BRIEF FORMAT

## SIGNATURE BLOCK MUST INCLUDE

- APPELLANT OR REPRESENTATIVE
- REGISTRATION NUMBER
- CORRESPONDENCE ADDRESS
- TELEPHONE NUMBER
- FAX NUMBER
- EMAIL ADDRESS

## 5. SUMMARY AND CONCLUSION FOR EX PARTE APPEALS

- PROPOSED RULES STREAMLINE APPEALS PROCEDURE AND INCREASE BRIEF COMPLEXITY
- BRIEF NON COMPLIANCE DELAYS PROCEEDINGS AND AFFECTS DECISION ON THE MERITS
- BE VERY CAREFUL IN EX PARTE APPEALS



# THANK YOU!

# THE END

- Rick Neifeld, Neifeld IP Law, PC
- Email: [rneifeld@Neifeld.com](mailto:rneifeld@Neifeld.com)