

Effective Appellate Advocacy in *Ex Parte* Appeals Before the Board of Patent Appeals and Interferences¹

Chief Administrative Patent Judge Michael Fleming and
Administrative Patent Judges Sally Lane, Linda Horner, and John Jeffery
Board of Patent Appeals and Interferences

The purpose of this paper is two-fold. First, this paper addresses the top eight reasons that appeal briefs are returned for failure to comply with the Board's rules. We developed the list of the top eight reasons based on a survey of defects raised in notices of non-compliant appeal briefs issued by examiners and administrative returns by the Board during Fiscal Year 2009.

Second, the paper addresses ten common mistakes that appellants make in *ex parte* appeals to the Board. We generated this list based on the authors' personal experiences when reviewing and deciding *ex parte* appeals. The list is presented in no particular order and the opinions are those of the authors and not of other members of the Board or the Agency.

I. Top Eight Reasons Briefs Are Returned For Failure To Comply With The Board's Rules

In the past, appellants' briefs have been reviewed for compliance with briefing requirements as set forth in the rules governing *ex parte* appeals by three separate parties at three separate stages during the appeal process: (1) a first review of the briefs by administrators in the patent appeals center as the briefs are filed; (2) a second review of the briefs by examiners when they prepare the examiner's answer; and (3) a third review of the briefs by administrators at the Board once it takes jurisdiction. Members of the bar have observed that this three-level review of briefs has led to inconsistent interpretation and application of the rules among appellants and a delay in processing of appeals. Further, rule 41.37(d) requires the Office to notify appellants of non-compliant briefs and provide them with an opportunity to file an amended brief. This can result in a notice of non-compliant brief for even the smallest deviation from the briefing requirements.

The United States Patent and Trademark Office (USPTO) is streamlining the procedure for the review of appeal briefs to increase the efficiency of the appeal process and reduce pendency of appeals. The Chief Judge of the Board of Patent Appeals and Interferences (BPAI) or his designee (collectively, "Chief Judge"), will have the sole responsibility for determining whether appeal briefs comply with the applicable regulations, and will complete the determination before the appeal brief is forwarded to the examiner for consideration. The Patent Appeal Center and the examiner will no longer review appeal briefs for compliance with the applicable regulations. Furthermore, the USPTO expects to achieve a reduction in appeal pendency as measured from the filing of a notice of

¹ This paper was prepared to accompany a presentation by the authors at the First Annual Board of Patent Appeals and Interferences ("Board") Conference (April 2010).

appeal to docketing of the appeal by eliminating duplicate reviews by the examiner, Patent Appeal Center, and the BPAI. The USPTO is expecting further reduction in pendency because the streamlined procedure will increase consistency in the determination, and thereby reduce the number of notices of noncompliant appeal brief and non-substantive returns from the BPAI that require appellants to file corrected appeal briefs. See 75 FR 15689 (March 30, 2010).

We have compiled a list of the top eight reasons why briefs fail to comply with the applicable regulations. A list of the top eight reasons with citation to the pertinent rules are as follows:

1. Missing or defective statement identifying related appeals and interferences

37 C.F.R. § 41.37(c)(1)(ii) requires appeal briefs to include:

A statement identifying by application, patent, appeal or interference number 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. Copies of any decisions rendered by a court or the board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

2. Missing or defective statement of the status of claims

37 C.F.R. § 41.37(c)(1)(iii) requires appeal briefs to include:

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.

3. Missing or incomplete statement of the status of amendments filed subsequent to final rejection

37 C.F.R. § 41.37(c)(1)(iv) requires appeal briefs to include:

A statement of the status of any amendment filed subsequent to final rejection.

4. Missing or incomplete summary of claimed subject matter

37 C.F.R. § 41.37(c)(1)(v) requires appeal briefs to include:

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

5. Missing or incomplete claims appendix

37 C.F.R. § 41.37(c)(1)(viii) requires appeal briefs to include:

An appendix containing a copy of the claims involved in the appeal.

6. Untimely filed evidence

37 C.F.R. § 41.33(d) provides:

(1) An affidavit or other evidence filed after the date of filing an appeal pursuant to §41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

(2) All other affidavits or other evidence filed after the date of filing an appeal pursuant to §41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

7. Missing evidence appendix

37 C.F.R. § 41.37(c)(1)(ix) requires appeal briefs to include:

An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered

in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

8. Missing related proceedings appendix

37 C.F.R. § 41.37(c)(1)(x) requires appeal briefs to include:

An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

37 C.F.R. § 41.37(d) requires the USPTO to notify appellants if they file a brief which does not comply with all of the requirements of rule 41.37(c) and provide the appellant time to file an amended brief:

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

II. Ten Common Mistakes Appellants Make When Appealing to the Board in *Ex Parte* Appeals

A. Failure to appreciate import of and strategy behind claim grouping

Despite the Board's attempt to clarify the issue of claim grouping in the changes to the rules of practice in *ex parte* appeals that became effective in 2004, confusion as to how to group claims effectively persists. The authors feel that appellants can write more effective briefs by strategically grouping claims to highlight the strongest arguments in the case.

Claim grouping allows appellants to strategically choose one or more arguments for a group of claims subject to the same ground of rejection. Independent claims can be grouped with other independent claims containing similar critical limitations. Dependent claims can also be grouped with the independent claims from which they depend. Thus, claim grouping provides appellants with an opportunity to focus the Board's attention on the strongest arguments in the appeal.

The authors often receive briefs in which appellants have not made clear which claims are being separately argued. For example, the brief might have a single heading for a ground of rejection, i.e., "Rejection of claims 1-5 under 35 U.S.C. § 103," with no subheadings. In the arguments that follow the heading, however, the brief might contain

arguments that pertain to limitations in claims 1, 3 and 5. Appellants run the risk in this situation that the Board will choose to treat claims 1-5 as argued as a group, citing to 41.37(c)(1)(vii), which requires that “[a]ny claim argued separately should be placed under a subheading identifying the claims by number.” By putting the arguments for each separately argued claim under a separate sub-heading, the panel will know exactly which claims are being separately argued and appellants will be assured that the Board will separately review the rejection of each of these separately-argued claims. That said, careful and strategic thought should be given by appellants to which claims they choose to argue separately, so that weaker arguments do not dilute stronger arguments.

On the other hand, if an appellant is making the same argument for patentability of two or more independent claims rejected under the same ground, and the independent claims contain the same limitation in dispute, then even if the arguments are placed under separate sub-headings, the panel may choose one of the independent claims as representative to decide the rejection for all of the independent claims. If the panel affirms the rejection of the representative claim, then for the remaining independent claims, the decision will say simply that the appellant made the same arguments for the patentability of these remaining independent claims, and such arguments are not persuasive for the same reasons as discussed for the representative independent claim. Appellant can save themselves some work in such cases, by simply grouping all of the claims together in the brief instead of repeating the same arguments verbatim two or more times in the brief.

Finally, appellants will sometimes include separate sub-headings for dependent claims, but the appellants’ argument following the subheading merely states that the rejection should be reversed because the prior art does not disclose element x, where element x is merely a quote of the claim language. This argument fails to include any explanation of why the art doesn’t show element x or why the examiner’s finding that the art does show element x is in error. The panel will usually not treat such an argument as an argument for separate patentability of the dependent claim.^{2,3}

B. “Kitchen sink” briefs

As mentioned above, careful and strategic thought should be given to the number of issues presented in an appeal brief so that weaker arguments do not dilute or distract the Board’s attention from stronger arguments. This comment applies equally to decisions concerning: (1) which grounds of rejection to appeal; (2) which claims to separately argue for each appealed ground of rejection; and (3) how many different arguments to raise for each ground of rejection. Even if an appellant groups all of the

² See 37 C.F.R. § 41.37(c)(1)(vii) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim).

³ See, e.g., *Ex parte Pea*, Appeal 2008-005064, slip op. at 10, 11 (BPAI Feb. 2, 2010)(finding that appellants’ mere recitation of claim language found in certain claims is not a separate argument for patentability); see also *Ex parte Rines*, Appeal 2008-005115, slip op. at 11 n.7 (BPAI Feb. 11, 2009)(finding that merely indicating what certain claims recite without particularly pointing out the alleged errors in the examiner’s rejection is not a separate argument for patentability). Except as where otherwise noted, a copy of the Board opinions cited in this article can be found on the USPTO Web site at <http://des.uspto.gov/Foia/BPAIReadingRoom.jsp>.

claims subject to a single ground of rejection together, the brief may still be less effective if it raises all of the possible rebuttal arguments, as outlined in the Manual of Patent Examining Procedure (MPEP), in the arguments section, instead of choosing the strongest of these arguments to pursue. Even worse, if appellants include arguments in their briefs that clearly have no bearing on the issues in their case, this practice could taint the meritorious arguments.

Consider, for example, an appellant rebutting an obviousness rejection. The appellant feels that the strongest argument is that the Examiner erred in finding that the combination of references A and B would have led to the claimed widget having element X. The appellant also feels that reference B is not analogous art and that reference B teaches away from making the modification proposed by the examiner. The appellant, however, feels that the non-analogous art and teaching away arguments are not as strong as the missing element argument. Nonetheless, the appellant includes these two additional arguments in the brief, and provides only a conclusory argument for each. Further, the appellant fails to clearly show, using the applicable legal standards for non-analogous art and teaching away, why the examiner's rejection is improper. The appellant, in this instance, has done himself a disservice. The Board's attention is now focused away from the strongest argument, and because the appellant's arguments on the two weaker points fail to apply even the proper legal standards, all of the appellant's positions have lost strength in the eyes of the panel.

Another common mistake is to rely too heavily on policy guidance provided in the MPEP to show that the examiner erred in making a rejection. When case law exists to support an appellant's position, the appellant should cite to the case law instead of relying heavily on policy guidance found in the MPEP. While the Board often refers to the MPEP for policy guidance on issues of first impression not yet addressed in the case law, if case law exists on an issue, the Board will more often analyze the issue in light of the case law without reference to the MPEP.⁴

C. Ineffective arguments to rebut obviousness rejections

Among the briefs submitted to the Board, the authors sometimes see conclusory arguments⁵ and overuse of certain "catch phrases" in arguments without proper analysis under the existing case law of why a particular argument applies in their case.

For example, rather than arguing that a particular teaching in a reference would not have led one having ordinary skill in the art to the claimed combination, appellants tend to characterize a reference as "teaching away" from a combination without applying the proper legal standards for "teaching away." If appellants argue a reference "teaches away," they should provide arguments or evidence to demonstrate that "a person of

⁴ See, e.g., *Santarsiero v. DeLucas*, 83 USPQ2d 1271, 1276 n.6 (BPAI 2006) (noting that the board is "not bound by the MPEP which, while giving an indication of 'the presumptions under which the PTO operates,' does not have the force of law") (quoting *Critikon, Inc. v. Becton Dickinson Vascular Access, Inc.*, 120 F.3d 1253, 1257 (Fed. Cir. 1997)).

⁵ See, e.g., *Ex parte Belinne*, 2009-004693, slip op. at 7 (BPAI Aug. 10, 2009)(informative opinion)(example where appellants made a conclusory argument without any explanation of why the examiner's explicit fact finding is in error).

ordinary skill, upon reading the reference, . . . would be led in a direction divergent from the path that was taken by the applicant.”⁶ Appellants should avoid using a “teaching away” argument in situations where the reference is simply describing a less preferable alternative, and is not discouraging or discrediting the use of the alternative.⁷

Another example of overuse of “catch phrases” in arguments is in the use of the “analogous-art” argument. When the Board reviews an analogous-art argument, it applies the Federal Circuit’s two-pronged test. “The analogous-art test requires that the board show that a reference is either in the field of the applicant’s endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection.”⁸ It is a common mistake among appellants not to address both prongs and to fail to show how the facts of their case, when viewed in light of these tests, would lead to a finding that a piece of prior art is not analogous to the claimed invention.⁹

One of the most common mistakes made in appellants’ arguments to overcome an obviousness rejection is the failure to address the examiner’s proposed combination. Consider, for example, a claim having elements A, B, and C. The examiner found that reference X discloses elements A and B, but fails to disclose element C. The examiner relied on reference Y to disclose element C, and determined it would have been obvious to one having ordinary skill in the art to have used the teaching of element C in the device of reference X to result in the claimed invention. We often receive arguments in which appellants argue that examiner erred in rejecting the claim because (1) reference X does not disclose element C, and (2) reference Y does not show elements A and B. These arguments are not responsive to the examiner’s rejection because the examiner did not rely upon the references for the particular elements appellant alleges they do not teach.. Such arguments by appellant fail to contest (1) the findings the examiner made about the scope and content of the prior art, and (2) the examiner’s rationale for why one having ordinary skill in the art would have combined the references’ teachings in the manner claimed. As such, these individual attacks on the references fail to address the

⁶ *In re Haruna*, 249 F.3d 1327, 1335 (Fed. Cir. 2001) (quoting *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999)).

⁷ See, e.g., *Ex parte Scholl*, Appeal 2007-003653, slip op. at 8-9 (BPAI Mar. 13, 2008)(informative opinion)(finding that while the prior art may prefer mercury vapor for the buffer, the reference, which lists mercury-free gas fillings as viable alternatives to mercury vapor, does not discount or discredit mercury-free gas fillings tantamount to teaching away from such approaches).

⁸ *In re Kahn*, 441 F.3d 977, 986-87 (Fed. Cir. 2006) (citing *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992)). See also *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374 (Fed. Cir. 2007); *In re Bigio*, 381 F.3d 1320 (Fed. Cir. 2004); and *In re Clay*, 966 F.2d 656 (Fed. Cir. 1992).

⁹ See, e.g., *Ex parte NTP, Inc.*, Appeal 2008-004603, slip op. at 98-99 (BPAI Dec. 22, 2009)(appellant failed to address second test for defining the scope of analogous art) and *Ex parte Knapp*, Appeal 2009-004346, slip op. at 13 (BPAI Jan. 22, 2010)(appellants failed to assert, let alone demonstrate, that the prior art, even if found to be outside of the relevant field of endeavor, would have been considered irrelevant to a problem facing the inventor).

examiner's proposed combination.¹⁰ One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.¹¹

D. Failure to account for shift in burden of proof to rebut finding of inherency

Appellants often fail to recognize that when presented with a rejection based in part on a reasonable finding that a reference inherently discloses an element of a claim, appellants have the burden to show that the prior art structure (if the same as appellants' claimed structure), does not inherently possess the characteristic relied upon by the examiner. Simply arguing that the prior art reference does not explicitly disclose the claimed characteristic does not effectively show why the examiner erred in finding that the characteristic is inherent.¹² If a claim defines something by what it does rather than structurally, then if the examiner has reason to believe that the claimed functional limitation is an inherent characteristic of the prior art, the examiner can require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic.¹³ The burden is on the appellant on appeal to the Board to show that the prior art does not possess that characteristic.¹⁴

E. Failure to define key claim terms

Often when an issue turns on claim interpretation, the examiner's position and the appellant's briefing read as though they are "ships passing in the night." Consider, for example, a case where the dispute turns on whether reference A discloses element "x." The examiner's office action will include a finding that reference A discloses "x" with citation to a column and line number of the reference. Appellant will then argue in the brief that the cited part of reference A is clearly not the claimed "x." The examiner, however, may have taken a broad interpretation of "x" so that it encompasses teachings from the prior art. The appellant may be basing his argument on a narrower meaning of "x" that does not encompass the disclosures from the prior art. However, the appellant fails in the arguments to rebut the examiner's interpretation of "x" to show that it is unreasonably broad by pointing to evidence (e.g., appellant's specification, dictionary definitions, etc.) to show why skilled artisans would not understand the claimed "x" to

¹⁰ See, e.g., *Ex parte Wright*, Appeal 2006-000003, slip op. at 8 (BPAI Apr. 6, 2006) (informative opinion)("Appellant has not addressed the combination of prior art references *as a whole* but simply improperly argues the merits of each reference individually")(citation omitted).

¹¹ See *In re Merck & Co.*, 800 F.2d 1091 (Fed. Cir. 1986); see also *In re Keller*, 642 F.2d 413 (CCPA 1981).

¹² See, e.g., *Ex parte Maeda*, Appeal 2008-006267, slip op. at 3-4 (BPAI July 22, 2009)(appellants conceded that claimed and prior art compositions are the same and failed to satisfy their burden of showing that prior art composition does not inherently possess the claimed characteristics); see also *Ex parte Batteux*, Appeal 2007-000622 (BPAI Mar. 27, 2007).
(available at <http://www.uspto.gov/ip/boards/bpai/decisions/inform/fd070622.pdf>).

¹³ See *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997); see also *In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971).

¹⁴ See *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1254-55 (CCPA 1977).

have the examiner's broad scope.¹⁵ Appellants' briefs will be more effective if they acknowledge when an issue turns on claim scope, and explain to the Board why the examiner's interpretation is unreasonably broad in view of how one skilled in the art would understand the term in light of appellant's specification. Ideally, Appellants should be able to point to a clear and unambiguous definition of the term in the specification. But absent such a definition, Appellants should point to evidence of record to show that the disputed term has a narrower meaning than the examiner's construction.

F. Failure to support arguments with evidence and follow rules on evidence appendix

We often see arguments made by appellants that might have been persuasive if supported by evidence to establish the points made in the arguments. Attorneys' arguments, however, cannot substitute for evidence.¹⁶

One example of a situation where evidence might sometimes be useful is in establishing the level of skill in the art. Examiners will often implicitly rely on the cited prior art as evidence of the level of skill in the art. This practice is not the basis for a finding of error in the examiner's rejection.¹⁷ If an appellant's case turns on a question of the proper level of ordinary skill in the art, it is important to provide the Board with evidence to establish the level of skill in the art.¹⁸ Appellants will typically not prevail by simply arguing that the examiner's rejection fails because the examiner did not make a specific factual finding as to the level of ordinary skill in the art.

Another common mistake by appellants is relying on evidence in the briefs or at oral argument that was not previously before the examiner during prosecution¹⁹ and/or failure to include a copy of evidence relied upon in the evidence appendix to the appeal brief.²⁰ Rule 41.37(c)(1)(ix) requires an evidence appendix containing copies of evidence "relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner." This rule also states that "[r]eference to unentered evidence is not permitted in the brief."²¹ If appellants foresee the need for evidence to support an argument, they would be best served to submit such

¹⁵ *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). See also, e.g., *Ex parte Frenk*, Appeal 2009-005654 (BPAI June 19, 2009)(informative opinion); see also *Ex parte Sami Chemicals and Extracts, Ltd.*, Appeal 2007-003483 (BPAI Feb. 2, 2009)(informative opinion).

¹⁶ See, e.g., *Estee Lauder Inc v. L'Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997); *Ex parte Srinivasan*, Appeal 2007-00512 (BPAI May 1, 2007)(informative opinion) (failure to produce evidence to support position); see also *Ex parte Wright*, Appeal 2006-000003 (BPAI Apr. 6, 2006)(informative opinion).

¹⁷ See *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error 'where the prior art itself reflects an appropriate level and a need for testimony is not shown'" (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

¹⁸ See *Ex parte Jud*, Appeal 2006-001061 (BPAI Jan. 20, 2007)(informative opinion) (describing what evidence is useful for establishing the level of ordinary skill in the art).

¹⁹ See, e.g., *Ex parte Aradi*, 2009-001505 (BPAI Aug. 12, 2009) (board refused to consider evidence in appeal brief when appellant did not identify where evidence was timely introduced in the record).

²⁰ See, e.g., *Ex parte Pangrle*, 2009-003119 (BPAI Sept. 28, 2009) (board refused to consider evidence referred to in the appeal brief that was not included in the evidence appendix).

²¹ See 37 C.F.R. § 41.33(d) for submitting new evidence after notice of appeal and prior to appeal brief.

evidence to the examiner during prosecution of the application before the examiner and include a copy of such evidence accompanied by the required statement in the evidence appendix to the appeal brief.

G. Appeal of issues reviewable by petition

The Board receives many appeal briefs in which appellants request the board to review an examiner's discretionary, procedural or non-substantive decision. Decisions of an examiner that are of a discretionary, procedural, or non-substantive nature and that are not directly connected with the merits of issues involving rejections of claims are typically reviewable by petition under 37 C.F.R. § 1.181 and are not within the jurisdiction of the board.²² Appellants should review the MPEP so that they know which issues are appealable and which issues are petitionable. The board reviews adverse decisions of examiners (i.e., claim rejections). The Board typically does not review matters that should be decided by the Director (or by designation the Technology Center Director) on petition.^{23, 24} Since petitions should be made within two months of the mailing date of the action or notice from which relief is requested,²⁵ petitionable matters should be addressed before an appeal reaches the board.

H. Summary of the claimed subject matter

The Board uses the summary of the claimed subject matter portion of an appeal brief to help it understand the claimed invention and how the claim elements correspond to the drawing elements and description in the specification. This section of the brief is particularly important if the claim uses terminology different from what is used in the specification and/or if the claim invokes section 112, sixth paragraph.²⁶ This section of

²² 37 C.F.R. § 1.127 (2009); *In re Berger*, 279 F.3d 975, 984 (Fed. Cir. 2002) (citing *In re Hengehold*, 440 F.2d 1395, 1403-1404 (CCPA 1971) (stating that there are a host of various kinds of decisions an examiner makes in the examination proceeding – mostly matters of a discretionary, procedural or nonsubstantive nature – which have not been and are not now appealable to the board when they are not directly connected with the merits of issues involving rejections of claims, but traditionally have been settled by petition to the Commissioner and holding that “the kind of adverse decisions of examiners which are reviewable by the board must be those which relate, at least indirectly, to matters involving the rejection of claims”)) and *In re Mindick*, 371 F.2d 892, 894 (CCPA 1967) (holding that the refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion, and any abuse of discretion is remedied by a Rule 181 petition to the Commissioner of Patents, and not by appeal to the Board of Appeals)).

²³ See MPEP § 1000 (matters subject to petition include, e.g., objections for new matter (unless the objection is tied to a written description rejection of claims on appeal), objections to the specification, objections to the drawings, restriction requirements, premature final rejection, and refusal to enter an amendment or an amended drawing). See also MPEP § 706.01 (“[T]he Board will not hear or decide issues pertaining to objections and formal matters which are not properly before the Board.”)

²⁴ See, e.g., *Ex parte Barlow*, Appeal 2009-006774 (BPAI Feb. 3, 2010) (objection is petitionable); see also *Ex parte Bly*, Appeal 2009-006568 (BPAI Nov. 16, 2009) (where appealed rejection and objection are related, board may consider objection).

²⁵ 37 C.F.R. § 1.181(f).

²⁶ See, e.g., *Ex parte Lowrey*, Appeal 2009-002153 (BPAI Oct. 20, 2009) (board used summary of claimed subject matter to help define a claim term where the claim term differed from term used in appellant's specification).

the brief is also the cause of many returns of briefs for failure to comply with the rules. The current rule 41.37(c)(1)(v) requires: “A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, *which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.*” The rule also requires that for *any claim* separately argued that contains means or step plus function language, “the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth *with reference to the specification by page and line number, and to the drawing, if any, by reference characters.*”

I. Ineffective use of reply brief

Too often the board receives reply briefs that simply reiterate the same arguments appellants made in the appeal brief and fails to respond directly to specific arguments raised in examiner’s answers. This type of reply brief frustrates the panel members who then must sift through all of the arguments in the reply brief and compare them to the arguments made in the appeal brief to see if any new points are raised responsive to the examiner’s answer. This type of reply brief is also not as effective as simply resting your case on your appeal brief, if appellant feels that the appeal brief addresses all of the points in contention.

Effective uses of a reply brief include responding to specific findings made or positions taken by the examiner in the answer or addressing intervening case law relevant to appealed issues. It is unnecessary to reiterate arguments previously made in the appeal brief. It is also not advisable to raise new arguments in a reply brief that are not responsive to arguments made in the examiner’s answer or to separately argue claims for the first time in the reply brief.²⁷

Occasionally, appellants fail to file a reply brief in instances in which a reply brief is required by the rules. In some instances, this may be a deliberate failure by an appellant who no longer wishes to pursue an appeal. We raise it here, however, in the event that such failures also include, in some instances, an oversight by the appellant that results in an unintended sua sponte dismissal of an appeal. In particular, if a case is remanded by the board to the examiner for further consideration of a rejection under 37 C.F.R. § 41.50(a)(1), and the examiner then files a supplemental examiner’s answer in response to the remand pursuant to 37 C.F.R. § 41.50(a)(2), the appellant *must* either request that prosecution be reopened by filing a reply under § 1.111 or request that the appeal be maintained by filing a reply brief under § 41.41. If the appellant does neither, the board will sua sponte dismiss the appeal as to the claims subject to the rejection for which the board has remanded the proceeding.²⁸

²⁷ See, e.g., *Ex parte Borden*, Appeal 2008-004312 (BPAI Jan. 7, 2010)(informative opinion)(refusing to consider new arguments in reply brief that were not responsive to examiner’s answer).

²⁸ See 37 C.F.R. § 41.50(a)(2).

J. Ineffective use of request for rehearing

Often we receive requests for rehearing that simply re-argue all of the points raised by appellants in the briefs without pointing out the particular points of error by the Board. The rule on rehearing requests requires appellants to “state with particularity the points believed to have been misapprehended or overlooked by the board.”²⁹ Effective requests for rehearing strategically limit their arguments to only one or two assertions of error, and refer to the specific portion(s) of the Board’s opinion where the errors can be found. Also, effective requests for rehearing select misapprehended or overlooked points that, if decided differently, would change the ultimate outcome of the case.³⁰

We also frequently receive requests making arguments that were not raised in the original briefs. These requests are improper since the Board could not have misapprehended or overlooked an argument that was not raised.

III. Conclusion

The insights provided in this paper are provided from the perspective of judges faced with making decisions in *ex parte* appeals. The authors hope that appellants find our observations useful when they present their cases to the Board.

²⁹ 37 C.F.R. § 41.52(a)(1).

³⁰ See e.g., *Ex parte Daughtrey*, Appeal 2009-000202 (BPAI July 31, 2009).