

## § 41.35

by §§ 41.50(b)(1), 41.50(d)(1), or 41.50(e) of this subpart.

(d) *Evidence after notice of appeal and prior to appeal brief.* Evidence filed after the date a notice of appeal is filed and prior to the date an appeal brief is filed may be admitted if:

(1) The examiner determines that the evidence overcomes at least one rejection under appeal and does not necessitate any new ground of rejection, and

(2) appellant shows good cause why the evidence was not earlier presented.

(e) *Other evidence.* All other evidence filed after the date an appeal brief is filed will not be admitted, except as permitted by §§ 41.50(b)(1) or 41.50(d)(1) of this subpart.

## § 41.35 Jurisdiction over appeal.

(a) Jurisdiction over the proceeding passes to the Board upon transmittal of the file, including all briefs and examiner's answers, to the Board.

(b) If, after receipt and review of the proceeding, the Board determines that the file is not complete or is not in compliance with the requirements of this subpart, the Board may relinquish jurisdiction to the examiner or take other appropriate action to permit completion of the file.

(c) Prior to the entry of a decision on the appeal by the Board, the Director may sua sponte order the proceeding remanded to the examiner.

EFFECTIVE DATE NOTE: At 73 FR 32973, June 10, 2008, § 41.35 was revised, effective December 10, 2008. For the convenience of the user, the revised text is set forth as follows:

## § 41.35 Jurisdiction over appeal.

(a) *Beginning of jurisdiction.* The jurisdiction of the Board begins when a docket notice is mailed by the Board.

(b) *End of jurisdiction.* The jurisdiction of the Board ends when:

(1) The Board mails a remand order (*see* § 41.50(b) or § 41.50(d)(1) of this subpart),

(2) The Board mails a final decision (*see* § 41.2 of this part) and judicial review is sought or the time for seeking judicial review has expired,

(3) An express abandonment is filed which complies with § 1.138 of this title, or

(4) A request for continued examination is filed which complies with § 1.114 of this title.

(c) *Remand ordered by the Director.* Prior to entry of a decision on the appeal by the Board (*see* § 41.50), the Director may sua sponte order an application or reexamination proceeding on appeal to be remanded to the examiner.

## 37 CFR Ch. I (7-1-08 Edition)

## § 41.37 Appeal brief.

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(2) The brief must be accompanied by the fee set forth in § 41.20(b)(2).

(b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(i) *Real party in interest.* A statement identifying by name the real party in interest.

(ii) *Related appeals and interferences.* 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.

(iii) *Status of claims.* 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.

(iv) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.

(v) *Summary of claimed subject matter.* 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.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to §41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be consid-

ered an argument for separate patentability of the claim.

(viii) *Claims appendix.* An appendix containing a copy of the claims involved in the appeal.

(ix) *Evidence appendix.* 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.

(x) *Related proceedings appendix.* 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.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See §1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and §41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(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.

(e) The time periods set forth in this section are extendable under the provisions of §1.136 of this title for patent applications and §1.550(c) of this title for *ex parte* reexamination proceedings.

EFFECTIVE DATE NOTE: At 73 FR 32974, June 10, 2008, §41.37 was revised, effective December 10, 2008. For the convenience of the user, the revised text is set forth as follows:

**§ 41.37 Appeal brief.**

(a) *Requirement for appeal brief.* An appeal brief shall be timely filed to perfect an appeal. Upon failure to file an appeal brief, the proceedings on the appeal are terminated without further action on the part of the Office.

(b) *Fee.* The appeal brief shall be accompanied by the fee required by § 41.20(b)(2) of this subpart.

(c) *Time for filing appeal brief.* Appellant must file an appeal brief within two months from the date of the filing of the notice of appeal (*see* § 41.31(a)).

(d) *Extension of time to file appeal brief.* The time for filing an appeal brief is extendable under the provisions of § 1.136(a) of this title for applications and § 1.550(c) of this title for *ex parte* reexamination proceedings.

(e) *Content of appeal brief.* The appeal brief must contain, under appropriate headings and in the order indicated, the following items:

(1) Statement of the real party in interest (*see* paragraph (f) of this section).

(2) Statement of related cases (*see* paragraph (g) of this section).

(3) Jurisdictional statement (*see* paragraph (h) of this section).

(4) Table of contents (*see* paragraph (i) of this section).

(5) Table of authorities (*see* paragraph (j) of this section).

(6) [Reserved]

(7) Status of amendments (*see* paragraph (l) of this section).

(8) Grounds of rejection to be reviewed (*see* paragraph (m) of this section).

(9) Statement of facts (*see* paragraph (n) of this section).

(10) Argument (*see* paragraph (o) of this section).

(11) An appendix containing a claims section (*see* paragraph (p) of this section), a claim support and drawing analysis section (*see* paragraph (r) of this section), a means or step plus function analysis section (*see* paragraph (s) of this section), an evidence section (*see* paragraph (t) of this section), and a related cases section (*see* paragraph (u) of this section).

(f) *Statement of real party in interest.* The “statement of the real party in interest” shall identify the name of the real party in interest. The real party in interest must be identified in such a manner as to readily permit a member of the Board to determine whether recusal would be appropriate. Appellant is under a continuing obligation to update this item during the pendency of the appeal. If an appeal brief does not contain a statement of real party in interest, the Office will assume that the named inventors are the real party in interest.

(g) *Statement of related cases.* The “statement of related cases” shall identify, by application, patent, appeal, interference, or

court docket number, all prior or pending appeals, interferences or judicial proceedings, known to any inventors, any attorneys or agents who prepared or prosecuted the application on appeal and any other person who was substantively involved in the preparation or prosecution of the application on appeal, and that are related to, directly affect, or would be directly affected by, or have a bearing on the Board’s decision in the appeal. A related case includes any continuing application of the application on appeal. A copy of any final or significant interlocutory decision rendered by the Board or a court in any proceeding identified under this paragraph shall be included in the related cases section (*see* paragraph (u) of this section) in the appendix. Appellant is under a continuing obligation to update this item during the pendency of the appeal. If an appeal brief does not contain a statement of related cases, the Office will assume that there are no related cases.

(h) *Jurisdictional statement.* The “jurisdictional statement” shall establish the jurisdiction of the Board to consider the appeal. The jurisdictional statement shall include a statement of the statute under which the appeal is taken, the date of the Office action setting out the rejection on appeal from which the appeal is taken, the date the notice of appeal was filed, and the date the appeal brief is being filed. If a notice of appeal or an appeal brief is filed after the time specified in this subpart, appellant must also indicate the date an extension of time was requested and, if known, the date the request was granted.

(i) *Table of contents.* A “table of contents” shall list, along with a reference to the page where each item begins, the items required to be listed in the appeal brief (*see* paragraph (e) of this section) or reply brief (*see* § 41.41(d) of this subpart), as appropriate.

(j) *Table of authorities.* A “table of authorities” shall list cases (alphabetically arranged), statutes and other authorities along with a reference to the pages where each authority is cited in the appeal brief or reply brief, as appropriate.

(k) [Reserved]

(l) *Status of amendments.* The “status of amendments” shall indicate the status of all amendments filed after final rejection (*e.g.*, whether entered or not entered).

(m) *Grounds of rejection to be reviewed.* The “grounds of rejection to be reviewed” shall set out the grounds of rejection to be reviewed, including the statute applied, the claims subject to each rejection and references relied upon by the examiner.

(n) *Statement of facts.* The “statement of facts” shall set out in an objective and non-argumentative manner the material facts relevant to the rejections on appeal. A fact shall be supported by a reference to a specific page number of a document in the

Record and, where applicable, a specific line or paragraph, and drawing numerals. A general reference to a document as a whole or to large portions of a document does not comply with the requirements of this paragraph.

(o) *Argument.* The “argument” shall explain why the examiner erred as to each ground of rejection to be reviewed. Any explanation must address all points made by the examiner with which the appellant disagrees. Any finding made or conclusion reached by the examiner that is not challenged will be presumed to be correct. For each argument an explanation must identify where the argument was made in the first instance to the examiner or state that the argument has not previously been made to the examiner. Each ground of rejection shall be separately argued under a separate heading.

(1) *Claims standing or falling together.* For each ground of rejection applicable to two or more claims, the claims may be argued separately (claims are considered by appellants as separately patentable) or as a group (claims stand or fall together). When two or more claims subject to the same ground of rejection are argued as a group, the Board may select a single claim from the group of claims that are argued together to decide the appeal on the basis of the selected claim alone with respect to the group of claims as to the ground of rejection. Any doubt as to whether claims have been argued separately or as a group as to a ground of rejection will be resolved against appellant and the claims will be deemed to have been argued as a group. Any claim argued separately as to a ground of rejection shall be placed under a subheading identifying the claim by number. A statement that merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(2) *Arguments considered.* Only those arguments which are presented in the argument section of the appeal brief and that address claims set out in the claim support and drawing analysis section in the appendix will be considered. Appellant waives all other arguments in the appeal.

(3) *Format of argument.* Unless a response is purely legal in nature, when responding to a point made in the examiner’s rejection, the appeal brief shall specifically identify the point made by the examiner and indicate where appellant previously responded to the point or state that appellant has not previously responded to the point. In identifying any point made by the examiner, the appellant shall refer to a page and, where appropriate, a line or paragraph, of a document in the Record.

(p) *Claims section.* The “claims section” in the appendix shall consist of an accurate clean copy in numerical order of all claims pending in the application or reexamination proceeding on appeal. The status of every claim shall be set out after the claim number

and in parentheses (e.g., 1 (rejected), 2 (withdrawn), 3 (objected to), 4 (cancelled), and 5 (allowed)). A cancelled claim need not be reproduced.

(q) [Reserved]

(r) *Claim support and drawing analysis section.* For each independent claim involved in the appeal and each dependent claim argued separately (see paragraph (o)(1) of this section), the claim support and drawing analysis section in the appendix shall consist of an annotated copy of the claim (and, if necessary, any claim from which the claim argued separately depends) indicating in boldface between braces ( { } ) the page and line or paragraph after each limitation where the limitation is described in the specification as filed. If there is a drawing or amino acid or nucleotide material sequence, and at least one limitation is illustrated in a drawing or amino acid or nucleotide material sequence, the “claims support and drawing analysis section” in the appendix shall also contain in boldface between the same braces ( { } ) where each limitation is shown in the drawings or sequence.

(s) *Means or step plus function analysis section.* For each independent claim involved in the appeal and each dependent claim argued separately (see paragraph (o)(1) of this section) having a limitation that appellant regards as a means or step plus function limitation in the form permitted by the sixth paragraph of 35 U.S.C. 112, for each such limitation, the “means or step plus function analysis section” in the appendix shall consist of an annotated copy of the claim (and, if necessary, any claim from which the claim argued separately depends) indicating in boldface between braces ( { } ) the page and line of the specification and the drawing figure and element numeral that describes the structure, material or acts corresponding to each claimed function.

(t) *Evidence section.* The “evidence section” shall contain only papers which have been entered by the examiner. The evidence section shall include:

(1) *Contents.* A table of contents.

(2) [Reserved]

(3) [Reserved]

(4) [Reserved]

(5) *Affidavits and declarations.* Affidavits and declarations, if any, and attachments to declarations, before the examiner and which are relied upon by appellant in the appeal. An affidavit or declaration otherwise mentioned in the appeal brief which does not appear in the evidence section will not be considered.

(6) *Other evidence filed prior to the notice of appeal.* Other evidence, if any, before the examiner and filed prior to the date of the notice of appeal and relied upon by appellant in the appeal. Other evidence filed before the notice of appeal that is otherwise mentioned in the appeal brief and which does not appear

## §41.39

## 37 CFR Ch. I (7-1-08 Edition)

in the evidence section will not be considered.

(7) *Other evidence filed after the notice of appeal.* Other evidence relied upon by the appellant in the appeal and admitted into the file pursuant to §41.33(d) of this subpart. Other evidence filed after the notice of appeal that is otherwise mentioned in the appeal brief and which does not appear in the evidence section will not be considered.

(u) *Related cases section.* The “related cases section” shall consist of copies of orders and opinions required to be cited pursuant to paragraph (g) of this section.

(v) *Appeal brief format requirements.* An appeal brief shall comply with §1.52 of this title and the following additional requirements:

(1) *Page and line numbering.* The pages of the appeal brief, including all sections in the appendix, shall be consecutively numbered using Arabic numerals beginning with the first page of the appeal brief, which shall be numbered page 1. If the appellant chooses to number the lines, line numbering may be within the left margin.

(2) *Double spacing.* Double spacing shall be used except in headings, tables of contents, tables of authorities, signature blocks, and certificates of service. Block quotations must be indented and can be one and one half or double spaced.

(3) [Reserved]

(4) *Font.* The font size shall be 14 point, including the font for block quotations and footnotes.

(5) *Length of appeal brief.* An appeal brief may not exceed 30 pages, excluding any statement of the real party in interest, statement of related cases, jurisdictional statement, table of contents, table of authorities, status of amendments, signature block, and appendix. An appeal brief may not incorporate another paper by reference. A request to exceed the page limit shall be made by petition under §41.3 filed at least ten calendar days prior to the date the appeal brief is due.

(6) *Signature block.* The signature block must identify the appellant or appellant’s representative, as appropriate, and a registration number, a correspondence address, a telephone number, a fax number and an e-mail address.

### §41.39 Examiner’s answer.

(a)(1) The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief including such explanation of the invention claimed and of the references relied upon and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner determines that the appeal does not comply with

the provisions of §§41.31 and 41.37 or does not relate to an appealable action, the primary examiner shall make such determination of record.

(2) An examiner’s answer may include a new ground of rejection.

(b) If an examiner’s answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner’s answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) *Reopen prosecution.* Request that prosecution be reopened before the primary examiner by filing a reply under §1.111 of this title with or without amendment or submission of affidavits (§§1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of §1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as set forth in §41.41. Such a reply brief must address each new ground of rejection as set forth in §41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in §41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) Extensions of time under §1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See §1.136(b) of this title for extensions of time to reply for patent applications and §1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.