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January 13, 2011

The Honorable David Kappos
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office (USPTO)
Mail Stop Comments
P.O. Box 1450
Alexandria, VA 22313-1450
Attention: APJ Linda Horner, BPAI Rules

Via email: BPAIRules@USPTO.gov

Re: Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals, 75 Fed. Reg. 69828 (Nov. 15, 2010)

Dear Under Secretary Kappos:

The Intellectual Property Owners Association (IPO) submits the following comments on the "Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals," published in the Federal Register on November 15, 2010. We thank you for the opportunity to provide these comments.

IPO is a trade association representing companies and individuals in all industries and fields of technology who own or are interested in intellectual property rights. IPO's membership includes more than 200 companies and over 11,000 individuals who are involved in the association either through their companies, law firms, or as individuals.

IPO thanks the USPTO for reaching out to the patent community as a whole in its efforts to improve practice before the Board of Patent Appeals and Interferences (Board). IPO views the new proposed rules to be a positive change from the previous efforts to modify the rules of practice before the Board and, in general, as setting forth an appellate process that will be easier and less expensive for appellants in presenting an appeal. However, there are aspects of the proposed rules that remain problematic in the view of IPO. Accordingly, the USPTO is asked to consider the comments in the attached appendix.

Sincerely,

Douglas K. Norman
President

APPENDIX

General Comments

Before turning to the proposed rules, IPO takes note of the statistics provided in the announcement regarding outcomes of Pre-Appeal Brief Conferences and Appeal Conferences held after an Appeal Brief has been filed. 75 Fed. Reg. 69831. The FY 2010 statistics for each proceeding show that 56% of the Pre-Appeal Brief Conference requests resulted in appellant being notified to proceed to the Board and 56% of the Appeal Conferences resulted in an Examiner's Answer. This means that in FY 2010, approximately 44% of the cases in which a Notice of Appeal was filed with a request for a pre-appeal conference or followed by an appeal brief were reopened or allowed. IPO believes that this is an unacceptably high percentage in each category.

Further, for FY 2010, the Board affirmed 48.8% of the cases reached for decision, affirmed-in-part 14.3% and reversed 29.5%. This means that the Board overturned the examiners' rejections, at least in part, in 43.8% of the cases reached for decision.¹ Even allowing for close cases that reasonably should have been forwarded to the Board for decision, the conferencing and appeal outcome statistics paint a bleak picture as to effectiveness. The statistics show that appellants and the USPTO are spending significant resources in *ex parte* appeals which would not have been needed if the examiner had determined the presence of patentable subject matter earlier. Those resources can be put to better use.

IPO requests that the USPTO, in considering the comments submitted in response to this notice, take a step back and evaluate the entire appeal process, including the steps that lead to an appeal, i.e., final office actions and after final practice. Board decisions are a lagging indicator of the effectiveness of patent examiner's patentability determinations due to the length of time it takes the Board to reach a decision after the briefing is finished. The appeal statistics show that for a significant time period, examiners have not been functioning at a high level in determining the presence of patentable claims. In theory, all of the cases that were reopened or allowed at the examiner level during conferencing and those reversed by the Board should have been caught at the final office action stage. Instead those cases needlessly went through the appeal process with its attendant costs. The cases in which the examiner's decision was affirmed-in-part by the Board could have had allowable subject matter indicated at the point in time the claims were separately argued, certainly no later than at the time of the appeal conference. While no system is perfect, the statistics show that there is great room for improvement.

¹ Affirmed-in-part outcomes at the Board arise because appellant separately argued certain of the claims. Since these arguments were before the examiner no later than the appeal brief, the examiner could have recognized the merits of the argument without input from the Board.

IPO understands that the Board is facing an unprecedented inventory of *ex parte* appeals. According to the statistics available at the Board's web page on www.uspto.gov, over 17,000 *ex parte* appeals were pending before the Board at the end of FY 2010, September 30, 2010. Applying the recent statistics discussed above to the 17,000 appeals pending before the Board, it can reasonably be concluded that at least 8,000 of the pending appeals were in fact not needed. IPO urges the USPTO to develop procedures to provide stricter oversight of final rejections and after final practice in order to minimize the need for an appeal. In addition, given the relatively low percentage of cases that proceed to the Board in which the decision of the examiner is ultimately affirmed, there is a demonstrated need for the USPTO to strengthen the appeal conferencing process.

Specific Comments

1. Proposed Bd.R. 41.35(a)—Jurisdiction over appeal

The rule proposes that the Board assume jurisdiction over an appeal upon the filing of a reply brief or the expiration of the time period in which to file a reply brief. IPO appreciates the efforts to streamline the appeal process in order for the Board to reach the merits of the appeal as soon as practicable. However, it is not clear from the proposal whether the examiner would still review a reply brief. Or is the effect of this proposed rule to foreclose consideration of the reply brief by the examiner? IPO requests clarification of this point since IPO believes that consideration of a reply brief by the examiner is needed as the reply brief is directed to the examiner's answer and consideration of the reply brief by the examiner may result in reopening of prosecution or allowance of the case, hence reducing backlog at the Board.

2. Proposed Bd.R. 41.37(C)(1)(v)—Summary of claimed subject matter

IPO appreciates the clarification by the USPTO as to the intent and effect of this rule, especially the reassurance that the Board will construe claims based upon the entire disclosure. 75 Fed. Reg. 69834, second column. However, IPO believes that the proposed rule needs yet further clarification. It is proposed in the new rule that appellant need only map the claim elements that are in "dispute." It is not clear from the commentary what is meant by a claim element being in "dispute." Is the contemplated "dispute" in regard to support of the claim element in the supporting disclosure, or in regard to the proper construction of a claim element? If the former, and there is no pending rejection against the claims for lack of written description under 35 U.S.C. § 112, first paragraph, it seems that there would be no claim elements in "dispute" and there would be no need for appellant to map any of the claim elements to the underlying disclosure. If the latter, it appears that issues of claim construction are better addressed in the Argument section of the appeal brief as a position in regard to claim construction is more amenable to a narrative statement that includes not only citation to appropriate support in the underlying disclosure but a discussion as to why it is believed a particular claim element should be construed in a particular manner.

Further, if appellant believes that no claim element is in “dispute,” is this section needed? If so, is appellant precluded from construing the claims in setting forth an argument in the appeal brief?

Another issue that needs clarification is the reference point for being in “dispute.” Is it from the examiner’s perspective or the appellant’s? Again, issues that are in “dispute” are better addressed through a narrative statement instead of a bare bones mapping of a claim element to the underlying disclosure.

The proposed rule imposes a single format for compliance. The commentary indicates that the USPTO has had difficulty with some summaries. 75 Fed. Reg. paragraph bridging 69834-35. Claims are drafted in a variety of forms and formats and some formats are more amenable to the proposed format than others and some claim formats do not readily lend themselves to be annotated as proposed. Instead of a “one size fits all” approach taken by the rule, IPO requests that the rule be modified to permit the drafter of the appeal brief to use whatever format she deems most informative. If the Board has had difficulty with specific formats, it should provide guidance and clarification as to what formats the Board has found to be confusing or not informative.

3. Proposed Bd.R. 41.37(c)(1)(vii)—Argument

IPO notes the withdrawal of the previously proposed requirement of this rule that established a presumption of examiner correctness as follows:

Any explanation [of examiner error] 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, and the express strict waiver of arguments not made by an appellant.

However, even though these portions of the rule have been withdrawn, the remaining provisions and the commentary create issues that need clarification. The commentary states that even though the proposed rule omits the waiver language, the “Board will still treat as waived, for purposes of the present appeal, any arguments not raised by appellant.” 75 Fed. Reg. 69835, third column. The commentary also acknowledges that comments were received reflecting concern that the waiver of argument on behalf of appellant could “limit the Board’s ability to independently review the examiner’s rejections and base the decision on the entire record on appeal” and that, if the Board “adopted this waiver language, the Board should limit its review of the examiner’s answer to the facts and reasons set forth therein.” *Id.*

IPO respectfully suggests that the USPTO has not adequately responded to the concerns expressed in the noted comments or the comments made in response to these previously proposed rule requirements. *See, e.g.*, “Comments on Proposed Rules: ‘Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals: Request for Comments on Potential Modifications to Final Rule and Notice of Roundtable During Comment Period,’” 74 Fed. Reg. 67987 (December 22, 2009)

submitted by IPO on February 26, 2010.² IPO respectfully requests that the USPTO clarify on what basis the Board will review the examiner's adverse determination of patentability and explain why any proposed standard of review complies with the applicable statutory requirements and judicial precedent.

IPO continues to urge that imposing a strict waiver of argument on the part of appellant, either explicitly as in the previous proposed rule or through the present commentary, without imposing a similar waiver of argument on the part of the examiner turns the *ex parte* appeal process in the USPTO into a one-sided proceeding. Section 102 states that "A person shall be entitled to patent unless--." The USPTO's reviewing court has explained:

[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.

After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.

If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.

In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (citations omitted); *see also Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) ("In the prosecution of a patent, the initial burden falls on the PTO to set forth the basis for any rejection, *i.e.*, a prima facie case.") (citing *Oetiker*, 977 F.2d at 1445); *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002) ("If the PTO fails to meet [the *prima facie*] burden, then the applicant is entitled to the patent."). It is clear that the burden of establishing that the pending claims of a patent application are unpatentable begins and continues with the patent examiner. In other words, per the preamble of Section 102, a patent applicant, after filing his or her patent application, can expect a Notice of Allowance, unless the examiner properly establishes a *prima facie* case of unpatentability. It is only upon the establishment of a *prima facie* case of unpatentability that applicant is under any obligation to provide a response.

The net effect of the previously proposed rules of presumption of examiner correctness and strict waiver of argument on behalf of appellant but not the examiner was to shift the burden to appellant on appeal to establish entitlement to a patent. While the presumption of examiner correctness has been expressly removed from the current proposal, the stated intent to continue to apply a strict waiver of argument to appellant but not the examiner continues to effectuate the improper shift in the burden.

The previously proposed rules as well as those currently proposed, in effect, treat any statement of a rejection in an examiner's answer as presumptively being a factually and

² A copy of the IPO comments can be found at http://www.USPTO.gov/ip/boards/bpai/procedures/rules/rule_comments2010_ipo.pdf.

legally proper statement of a *prima facie* case of unpatentability. This is seen since the rules set forth a procedure in which the Board immediately shifts the burden to appellant to respond without independently reviewing the rejection to determine if a response is needed. It appears that the Board will only review the examiner's rejection to the limited extent that appellant presents assertions of error in the appeal brief as the Board has stated that this piecemeal style review is the standard. *See, e.g., Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) ("Specifically, the Board reviews the particular finding(s) contested by an appellant anew in light of all the evidence and argument on that issue."). Such a limited, piecemeal review does not comply with preamble of Section 102 and the principles set forth in *In re Oetiker, supra*.

For example, in reviewing an obviousness rejection on this limited basis, it is not clear how the Board would consider the subject matter of a claim as a whole as required by the statute without considering the examiner's position in regard to any portion of the claim not argued by appellant to be presumptively correct. As a fact finder, the Board should independently judge the credibility and correctness of all of the examiner's findings and not assume that any findings not directly argued by appellant are correct. An independent review of the entire case put forth by the examiner is more in line with the guidance found in *Oetiker, supra* that "patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument." To comply with this directive, the Board must independently consider the entire position of the examiner and that of the appellant without presuming any part of the examiner's position to be correct.

There are currently over 17,000 *ex parte* appeals pending before the Board. The above analysis of appeal conference and Board outcomes indicates that a substantial portion of those appeals were not needed. IPO has previously suggested that the USPTO adopt the review process in *ex parte* appeals that the Board currently uses in reviewing motions in patent interferences. Letter of February, 26, 2010, at 6. To recap, the proponent of a motion in a patent interference bears the burden of persuasion. While an opposition and a reply can be filed in response to a motion, the Board will review a motion keeping in mind the burden of persuasion rests on the movant. If the initial analysis of the motion shows that the movant has not carried its burden of persuasion, the Board will deny the motion, at times, not even considering an opposition and reply.

Since the burden to establish unpatentability is on the patent examiner, the Board should adopt a similar review process for *ex parte* appeals. Thus, the Board would initially review the statement of rejection as it appears in the action from which the appeal is taken and independently determine whether the facts and reasons relied upon by the patent examiner are supported by the record and establish a *prima facie* case of unpatentability. Only if the Board concludes from this initial independent review of the examiner's statement of rejection that the patent examiner has properly established a *prima facie* case of unpatentability would the Board proceed to review the appeal brief and the examiner's response to appellant's arguments as appear in the examiner's answer.

As previously noted by IPO, adoption of this review process will result in new rigor being imposed on the examination process and fewer appeals. A natural consequence of having the Board focus on the key question in the appeal—did the examiner properly establish a *prima facie* case of unpatentability—is that, in time more effective final office actions and appeal conferences will occur as the Examining Corps takes into account the feedback provided by the Board.

Another expected outcome of such a review process is that the Board will be able to more efficiently, effectively and fairly decide the 17,000-plus appeals pending as the Board's initial review will focus on the proper issue—did the examiner establish a proper *prima facie* case of unpatentability. This is especially so if the initial independent review by the Board is based solely on the facts and reasons set forth by the examiner in the statement of the rejection. Lest there be concern that such a review process will result in rejections being reversed that should not be because of incomplete or inartful articulation by the examiner, it should be kept in mind that the decision of the Board only reflects whether the rejection under review was proper, not that the claim(s) under review is patentable. In other words, the Board does not allow cases, the patent examiner does. 37 CFR § 1.198 provides for reopening of prosecution by the examiner after a Board decision and includes appropriate safeguards for appellant. Thus, if, upon return of a case to the patent examiner, it is believed that the Board did not have the strongest exposition of the rejection before it for review, the examiner can seek to have the case reopened as set forth in the rule. Any discomfiture encountered while this manner of review is implemented will be brief as the Examining Corps will take into account the feedback provided by the Board and adjust its patentability determinations accordingly.

IPO respectfully requests that this section of the rule be revisited and the USPTO take into account the comments made in IPO's letter of February 26, 2010 and above. If the USPTO believes that consideration of these issues would benefit by a Roundtable discussion as was held by the USPTO in January 2010 in regard to the previous proposed revision of the rules, IPO would be pleased to participate.

4. Proposed Bd.R. 41.39—Examiner's answer

IPO understands that the USPTO historically sets forth the requirements for an examiner's answer in Chapter 1200 of the MPEP. IPO does request clarification of two aspects of this proposed rule: (1) the references in this rule to modification of a rejection by an advisory action and (2) the use of dictionary definitions during an appeal proceeding.

a. Modification of a rejection in an advisory action

Advisory actions typically have two parts. The first is the USPTO form where the examiner indicates whether amendments/evidence are entered or not and the second is a "continuation" page where the examiner can provide an explanation. The modification

to a rejection set forth on the USPTO form is self explanatory and typically is an indication as to whether the response was sufficient to remove a rejection in regard to some or all of the claims. The difficulty seen in this provision of the rule is how the examiners use the “continuation” section of the advisory action to substantively modify a pending rejection. It is not unusual for an applicant to file a Request for Rehearing in response to a final office action without any accompanying amendment or evidence only to have the examiner provide a narrative in the “continuation” section of the advisory action that substantively changes the rejection. For example, the examiner has maintained a rejection through the final office action in which claim 1 is rejected under 35 U.S.C. § 102 as anticipated by Jones where the examiner has consistently relied upon the embodiment set forth in Fig. 1 of Jones. In response to a continued argument by applicant that Fig. 1 of Jones does not anticipate claim 1, the examiner enters an advisory action where in the “continuation” section the examiner also relies upon an unrelated embodiment illustrated in a different figure of Jones. The question becomes whether the examiner has withdrawn the rejection as it is based upon Fig. 1 of Jones or whether the citation of a different embodiment of Jones is in addition to reliance upon Fig. 1. Thus, the provisions in Bd.R. 41.39(a)(1) and (2) that treat any modification of a rejection in an advisory action as part of the rejection as made need to be clarified.

Clarification is especially needed as the commentary indicates that the USPTO proposes to eliminate the requirement that the examiner’s answer restate the rejection. Instead, the commentary states that the Board would rely on the “statement of the grounds of rejection in the Office action from which the appeal was taken (as modified by any subsequent Advisory Action or Pre-Appeal Conference Decision).” 75 Fed. Reg. 69837, third column. Given that examiners can and do substantively modify rejections in an advisory action, appellant may be confronted by an unstated new ground of rejection even before the Notice of Appeal has been filed.

IPO respectfully requests that proposed Bd.R. 41.39(a)(1) and (2) be amended to make clear that the reference to modification of a rejection in an advisory action is only in regard to the status of the pending rejections or which claims are subject to a pending rejection and that any substantive discussion of a rejection that appears in an advisory action is not a modification encompassed by the rule. Rather, if the examiner believes a pending rejection needs to be substantively changed when preparing an advisory action, prosecution should be reopened at that time and an applicant should not be forced to file a needless appeal or RCE.

b. Use of dictionary definitions during an appeal proceeding

IPO also requests that the USPTO clarify what is meant by “new evidence” in the proposed rule. One issue that the USPTO is asked to address is whether an examiner’s reliance on a new dictionary definition in the examiner’s answer constitutes reliance on “new evidence” under Proposed Bd. Rule 41.39(a)(2). If the answer is yes, then the rejection would need to be designated as a new ground of rejection, thus giving the appellant the choice to maintain the appeal or to reopen prosecution where the appellant

would have the opportunity to present new evidence. If the answer is no, then the appellant gets no such choice, and the appeal must be maintained (with no opportunity to present new evidence).

As a second issue, it is commonly understood that dictionaries are plainly “evidence,” as that word is defined in Black’s Law Dictionary (9th ed. 2009) (defining “evidence” as “[s]omething (including testimony, documents and tangible objects) that tends to prove or disprove the existence of an alleged fact”). More specially, dictionaries are a form of “extrinsic evidence” that “can help educate the court regarding the field of the invention and can help the court determine what a person of ordinary skill in the art would understand claim terms to mean.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318-19 (Fed. Cir. 2005) (en banc).

As the Federal Circuit has observed, “words often have multiple dictionary definitions, some having no relation to the claimed invention.” *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1203 (Fed. Cir. 2002). It will often be the case, then, that the dictionary definition cited by the examiner will not be the only dictionary definition that exists for a given claim term. To rebut the examiner’s definition, applicants may wish to cite a different dictionary definition and/or submit an expert declaration explaining why a person of ordinary skill would not have applied the examiner’s definition at the time of invention.

In considering this issue it should be noted that when an appellant has cited a new dictionary definition in an appeal brief or in a request for reconsideration, the USPTO has deemed it to constitute inadmissible new “evidence” under 37 C.F.R. § 41.33(d)(2) and § 41.52(a)(1). See *In re Reexamination Proceeding 90/006,707*, 2008 WL 2938366 at *3 (Comm’r Pat. June 2, 2008) (“entry of a reply brief with any new or non-admitted dictionary definitions is not permitted” under § 41.33(d)(2)); *Ex parte Malcom*, 2008 WL 345058 at *2 (BPAI Feb. 6, 2008) (“Pursuant to 37 C.F.R. § 41.52(a)(1), we decline to consider Appellant’s newly presented dictionary definition for ‘sleep mode’ as extrinsic evidence.”). For consistency, the USPTO should likewise interpret the word “evidence” to include dictionary definitions cited by examiners under Proposed Bd. Rule 41.39(a)(2).

A related question is whether a newly-cited dictionary definition in the Board’s decision should be designated as containing a new ground of rejection. Because appellants are not permitted to cite new dictionary definitions in a request for rehearing, see *Ex parte Malcom*, 2008 WL 345058 at *2 (BPAI Feb. 6, 2008), it follows that the Board, as a matter of fairness and administrative convenience, should designate its opinion as containing a new ground of rejection so that appellants may choose to reopen prosecution in order to introduce a dictionary definition or expert declaration rebutting the Board’s newly-cited evidence. In the case of regular appeals, this procedure is preferred over forcing applicants to file either an RCE or a civil action under 35 U.S.C. § 145, which would be the only two avenues available to an appellant seeking to introduce rebuttal evidence in response to a Board decision. Patent owners, by contrast,

would have no ability to present rebuttal evidence if the Board fails to designate its rejection as new, because RCE's and civil actions are not permitted in reexamination proceedings.

As the CCPA noted, the Board's citation of a new dictionary definition will not always give rise to a new ground of rejection, so long as the dictionary definition plays a "minor role serving only to 'fill in the gaps' that might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection." *In re Boon*, 439 F.2d 724, 728 (CCPA 1971). But even in those circumstances, "an applicant *must* be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion." *Id.* (emphasis added). Unless the Board is willing to reconsider its new dictionary definition based solely on attorney argument unsupported by evidence (a practice that may give rise to abuse), the Board should permit appellants to cite rebuttal evidence, such as an alternative dictionary definition or expert declaration. To do so, the Board would need to permit appellants to reopen prosecution, and it should do so by simply designating its decision as containing a new ground of rejection. Under 37 C.F.R. § 41.50(b)(1), the Board's "new ground of rejection is binding upon the examiner unless an amendment or *new evidence* not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision" (emphasis added). In other words, if the appellant fails to introduce persuasive new evidence on point, the Board's rejection stands, and the entire debate over whether or not the Board's dictionary played a "minor role" under *Boon* is avoided.

In summary, the USPTO should clarify whether (1) the word "evidence" in 37 C.F.R. §§ 41.33(d)(2), 41.39(a)(2), and 41.52(a)(1) includes dictionary definitions, and (2) as a matter of USPTO policy, any Board affirmance that relies on a new dictionary definition shall be designated as containing a "new ground of rejection" under 37 C.F.R. § 41.50(b). Neither of these interpretations requires a change to the language of the proposed rules, and it would provide consistent treatment of dictionaries on appeal, regardless of whether the dictionary definition is cited by the appellant, the examiner, or the Board.

5. Proposed Bd.R. 41.40—Tolling of time period to file a reply brief

IPO appreciates the USPTO offering this new avenue of relief when it is believed that the examiner has made an unstated new ground of rejection in the examiner's answer.

6. Proposed Bd.R. 41.50—Decisions and other actions by the Board

IPO takes the opportunity to raise an issue that the USPTO should address while it is considering changes to the rules of practice before the Board. Board panels will sometimes backfill the factual support for an examiner's rejection and then denominate the decision as an affirmance. At times, the panel will on its own initiative denominate the "affirmance" as new ground of rejection under 37 CFR § 41.50(b) in the original

decision. Other times, upon appellant raising this issue in a Request for Rehearing, the panel will issue a decision on rehearing in which the “affirmance” is then denominated a new ground of rejection. The specific issue IPO desires the USPTO to consider concerns the post-GATT 20 year term from date of filing and the patent term adjustment appellant is entitled to under 35 U.S.C. § 154(b)(1)(C)(iii) if appellate review of an appeal by the Board results in a decision reversing an adverse determination of patentability.

If the Board cannot affirm a rejection based upon the facts and reasons set forth by the examiner in the statement of the rejection, the Board should reverse the rejection, not backfill the factual support for the rejection and “affirm” the rejection while calling the “affirmance” a “new ground of rejection,” as this practice wrongfully denies appellant the patent term adjustment that would otherwise be provided by the statute, assuming at least one claim has all pending rejections reversed by the Board. If the Board believes that a claim before it for review is unpatentable only upon consideration of additional facts not relied upon by an examiner, the Board should reverse the examiner’s rejection and, if otherwise appropriate, enter a new ground of rejection under 37 CFR § 41.50(b) based upon the facts not relied upon by the examiner.

It is understood that the Board has used the practice of denominating an “affirmance” as a new ground of rejection for some time. In the pre-GATT era where the patent term was 17 years from date of grant, the practice had no practical effect on patent term. However, now it clearly does. The USPTO should recognize that the law has changed and the Board’s nomenclature of its decision has a real effect on patent term.

There is another practical effect of the Board relying upon new facts in “affirming” an examiner’s rejection, as it is not clear how many rejections are pending against the claims. History informs that if prosecution is resumed in such cases by way of an RCE, the examiner often maintains the rejection as stated in the examiner’s answer, modifying it, if at all, to take into account any change in the claims or evidentiary record, but not the new reasoning or facts used by the Board in “affirming” the rejection. This presents difficult issues for the applicant in the RCE and needlessly causes the applicant to spend resources trying to get the examiner to clarify the precise factual basis for the continued rejection.

This issue is directly related to the issue raised above, in regard to the rules being interpreted as setting forth a strict waiver of argument on the part of appellant but allowing the Board to backfill for perceived factual or legal errors in the examiner’s rejection. The Board’s practice of doing so has real effects, not only on the fundamental fairness of the appeal process, but on the patent term to which applicant is rightfully entitled.

IPO would also be willing to discuss this issue in a Roundtable discussion if the USPTO would find it helpful.