MATTERS HANDLED CONCURRENTLY WITH APPEAL

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Form paragraphs 12.01-12.04 may be used to indicate defects in a Notice of Appeal.

¶ 12.01 Notice of Appeal Unacceptable - Fee Unpaid

The notice of appeal filed on [1] is not acceptable because the appeal fee required under 37 CFR 1.17(b) was not filed, or was not timely filed.

Applicant may obtain an extension of time under 37 CFR 1.136(a) to file the appropriate appeal fee. The date on which the notice of appeal, the appeal fee, the petition under 37 CFR 1.136(a), and the petition fee are filed will be the date of the reply and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply later than the maximum SIX MONTH statutory period or obtain an extension pursuant to 37 CFR 1.136(a) for more than FIVE MONTHS beyond the date of reply set in an Office action.

¶ 12.02 Notice of Appeal Unacceptable - No 2nd Rejection

The notice of appeal filed on [1] is not acceptable because there has been no second or final rejection in this application, as required under 37 CFR 1.191(a).

¶ 12.03 Notice of Appeal Unacceptable - Not Timely Filed

The notice of appeal filed on [1] is not acceptable because it was filed after the expiration of the period set in the prior Office action. This application will become abandoned unless applicant obtains an extension under 37 CFR 1.136(a). The date on which the notice of appeal, the appeal fee, the petition under 37 CFR 1.136(a), and the petition fee under 37 CFR 1.17(a) are filed will be the date of the reply and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply later than the maximum SIX MONTH statutory period or obtain an extension pursuant to 37 CFR 1.136(a) for more than FIVE MONTHS beyond the date of reply set in an Office action.

¶ 12.04 Notice of Appeal Unacceptable - Claims Allowed

The notice of appeal filed on [1] is not acceptable because a notice of allowability was mailed by the Office on [2].

1206 Appeal Brief [R-1]

37 CFR 1.192. Appellant's brief.

(a) Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. The brief must be accompanied by the fee set forth in § 1.17(c) and must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

(b) On failure to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed.

(c) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner:

(1) *Real party in interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest.

(2) *Related appeals and interferences.* A statement identifying by number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) *Status of claims.* A statement of the status of all the claims, pending or canceled, and identifying the claims appealed.

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

(5) *Summary of invention.* A concise explanation of the invention defined in the 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.

(6) *Issues.* A concise statement of the issues presented for review.

(7) *Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

(8) *Argument.* The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading.

(i) For each rejection under 35 U.S.C. 112, first paragraph, the argument shall specify the errors in the rejection and how the first paragraph of 35 U.S.C. 112 is complied with, including, as appropriate, how the specification and drawings, if any,

(A) describe the subject matter defined by each of the rejected claims,

(B) enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims, and

(C) set forth the best mode contemplated by the inventor of carrying out his or her invention.

(ii) For each rejection under 35 U.S.C. 112, second paragraph, the argument shall specify the errors in the rejection and how the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(iii) For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

(iv) For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

(v) For any rejection other than those referred to in paragraphs (c)(8)(i) to (iv) of this section, the argument shall specify the errors in the rejection and the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error.

(9) *Appendix.* An appendix containing a copy of the claims involved in 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 provided with a period of one month within which to file an amended brief. If appellant does not file an amended brief during the one-month 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.

Where the brief is not filed, but within the period allowed for filing the brief an amendment is presented which places the application in condition for allowance, the amendment may be entered since the application retains its pending status during said period. Amendments should not be included in the appeal brief. Amendments should be filed as separate papers. See MPEP § 1207, § 1215.01, and § 1215.02.

TIME FOR FILING APPEAL BRIEF

37 CFR 1.192(a) provides 2 months from the date of the Notice of Appeal for the appellant to file an appeal brief. In a reexamination proceeding, the time period can be extended only under the provisions of 37 CFR 1.550(c). See also MPEP § 2274.

The usual period of time in which appellant must file his or her brief is 2 months from the date of appeal. The Office date of receipt of the Notice of Appeal (and not the date indicated on any Certificate of Mailing under 37 CFR 1.8) is the date from which this 2 month time period is measured. See MPEP § 512. However, 37 CFR 1.192(a) alternatively permits the brief to be filed "within the time allowed for reply to the action from which the appeal was taken, if such time is later." These time periods may be extended under 37 CFR 1.136(a), and if 37 CFR 1.136(a) is not available, under 37 CFR 1.136(b) for extraordinary circumstances.

In the event that the appellant finds that he or she is unable to file a brief within the time period allotted by the rules, he or she may file a petition, with fee, to the examining group, requesting additional time under 37 CFR 1.136(a). Additional time in excess of 5 months will not be granted unless extraordinary circumstances are involved under 37 CFR 1.136(b). The time extended is added to the calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday, or Federal holiday.

If after an appeal has been filed, but prior to the date for submitting a brief, an interference is declared, appellant's brief need not be filed while the interference is pending, unless the administrative patent judge has consented to prosecution of the application concurrently with the interference. See MPEP § 2315. Absent such concurrent prosecution, the examiner may, after the interference has terminated and the files have been returned to him or her, (A) set a 2-month period for filing the brief, or (B) withdraw the final rejection of the appealed claims in order to enter an additional rejection on a ground arising out of the interference. See, for example, MPEP § 2363.03. Also, if the appellant was the losing party in the interference, claims which were designated as corresponding to the lost count or counts will stand finally disposed of under 37 CFR 1.663.

When an application is revived after abandonment for failure on the part of the appellant to take appropriate action after final rejection, and the petition to revive was accompanied by a Notice of Appeal, appellant has 2 months, from the mailing date of the Commissioner's affirmative decision on the petition, in which to file the appeal brief. The time period for filing the appeal brief may be extended under 37 CFR 1.136.

With the exception of a declaration of an interference or suggestion of claims for an interference and timely copying of claims for an interference, the appeal ordinarily will be dismissed if the brief is not filed within the period provided by 37 CFR 1.192(a) or within such additional time as may be properly extended.

A brief must be filed to preserve appellant's right to the appealed claims, notwithstanding circumstances such as:

(A) the possibility or imminence of an interference involving the subject application, but not resulting in withdrawal of the final rejection prior to the brief's due date;

(B) the filing of a petition for supervisory action under 37 CFR 1.181;

(C) the filing of an amendment, even if it is one which the examiner previously has indicated may place one or more claims in condition for allowance, unless the examiner, in acting on the amendment, disposes of all issues on appeal;

(D) the receipt of a letter from the examiner stating that prosecution is suspended, without the examiner withdrawing the final rejection from which appeal has been taken or suggesting claims for an interference, and without an administrative patent judge declaring an interference with the subject application.

Although failure to file the brief within the permissible time will result in dismissal of the appeal, if any claims stand allowed, the application does not become abandoned by the dismissal, but is returned to the examiner for action on the allowed claims. See MPEP § 1215.04. If there are no allowed claims, the application is abandoned as of the date the brief was due. Claims which have been objected to as dependent from a rejected claim do not stand allowed. In a reexamination proceeding failure to file the brief will result in the issuance of the certificate under 37 CFR 1.570.

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