

USPTO PROPOSES RULEMAKING REGARDING EX PARTE APPEALS

On November 15, 2010, the U.S. Patent and Trademark Office (USPTO) issued a Notice of Proposed Rulemaking regarding ex parte appeals before the Board of Patent Appeals and Interferences (Board). With the proposed changes, the USPTO is aiming to “simplify the appellate process in a way that reduces the burden on appellants and examiners to present an appeal to the Board.”

Some of the notable proposed changes are to:

- eliminate briefing requirements that ask for information already available in the Image File Wrapper (i.e., statements of the status of claims, status of amendments, grounds of rejection to be reviewed on appeal, the claims appendix, evidence appendix, and related proceedings appendix).
- provide the Board an early jurisdiction over the appeal (i.e., as soon as a reply brief is filed).
- eliminate the requirement of an examiner’s response to a reply brief.
- provide that the Board will presume that all pending claims under rejection are appealed unless cancelled by the applicant.
- provide that any new evidence relied upon in a rejection set forth in an examiner’s answer shall be designated as a new ground of rejection.
- eliminate the Board’s authority to remand an application to the examiner without the USPTO Director’s approval.

More details on the proposed changes are available at: <http://www.gpo.gov/fdsys/pkg/FR-2010-11-15/pdf/2010-28493.pdf> (*Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals*).