



INTELLECTUAL PROPERTY LAW
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CLIENT ALERT

New Practice Rules Before the Board of Patent Appeals and Interferences To Go Into Effect January 23, 2012

On November 22, 2011, the USPTO published final rules that make significant changes in the rules of practice before the Board of Patent Appeals and Interferences (Board) in *ex parte* appeals. The changes are in effect for cases in which a Notice of Appeal is filed on or after January 23, 2012. Overall, the new rules are seen to be an improvement over the existing rules governing *ex parte* appeals and are a welcome retreat from the provisions previously proposed.

Among the significant changes are:

- The Board assumes jurisdiction upon the filing of a reply brief or upon expiration of the time for filing the reply brief. Thus, the examiner will no longer review the reply brief.
- The appeal brief format has been changed:
 - Items no longer needed:
 - Status of claims
 - Status of amendments
 - Grounds of rejection to be reviewed
 - Evidence and related proceedings appendices
 - Modified items:
 - Strict waiver of argument on the part of appellant is now explicit.
- Guidance is given as to when the examiner makes a new ground of rejection in the Examiner's Answer.
- The time for filing a reply brief is tolled if a petition is filed under 37 CFR § 1.181 to have a rejection set forth in the Examiner's Answer designated as a new ground of rejection.
- Consideration of whether the Board made an undesignated new ground of rejection is grounds for requesting for rehearing under 37 CFR § 41.52.

MPEP Chapter 1200 (appeals) will be revised to reflect the new rules and provide more guidance on how practitioners and examiners can comply with the new procedures. Given the beneficial changes in the format of the appeal brief, one should consider filing a Notice of Appeal on or after January 23, 2012, keeping in mind patent term issues if extensions of time are needed.

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