§41.69

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the Board in any proceeding identified
under this paragraph must be included
in an appendix as required by para-
graph (b)(1)(ix) of this section.

(iii) Status of claims. A statement ac-
cepting or disputing appellant’s state-
ment of the status of claims. If appel-
ellant’s statement of the status of claims
is disputed, the errors in appellant’s
statement must be specified with par-
ticularity.

(iv) Status of amendments. A state-
ment accepting or disputing appel-
ant’s statement of the status of amend-
ments. If appellant’s statement of the status of amendments is dis-
puted, the errors in appellant’s state-
ment must be specified with particu-
larity.

(v) Summary of claimed subject matter.
A statement accepting or disputing ap-
pellant’s summary of the subject mat-
ter defined in each of the independent
claims involved in the appeal. If appel-
licant’s summary of the subject matter
is disputed, the errors in appellant’s
summary must be specified.

(vi) Issues to be reviewed on appeal. A
statement accepting or disputing ap-
pellant’s statement of the issues pre-
sented for review. If appellant’s state-
ment of the issues presented for review
is disputed, the errors in appellant’s
statement must be specified. A counter
statement of the issues for review may
be made. No new ground of rejection
can be proposed by a requester respond-
ent.

(vii) Argument. A statement accept-
ing or disputing the contentions of ap-
pellant with each of the issues pre-
sented by the appellant for review. If a
contention of the appellant is disputed,
the errors in appellant’s argument
must be specified, stating the basis
therefor, with citations of the statutes,
regulations, authorities, and parts of
the record relied on. Each issue must
be treated under a separate heading.
An argument may be made with each
of the issues stated in the counter
statement of the issues, with each
counter-stated issue being treated
under a separate heading.

(viii) Evidence appendix. An appendix
containing copies of any evidence sub-
mitted pursuant to §§1.130, 1.131, or
1.132 of this title or of any other evi-
dence entered by the examiner and re-
lied upon by respondent 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 respondent’s brief. See
§41.63 for treatment of evidence sub-
mitted after appeal.

(ix) Related proceedings appendix. An
appendix containing copies of decisions
rendered by a court or the Board in any
proceeding identified pursuant to para-
graph (b)(1)(ii) of this section.

(x) Certificate of service. A certifi-
cation that a copy of the respondent
brief has been served in its entirety on
all other parties to the reexamination
proceeding. The names and addresses
of the parties served must be indicated.

(2) A respondent brief shall not in-
clude any new or non-admitted amend-
ment, or any new or non-admitted affi-
davit 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 §41.63 for amendments,
affidavits or other evidence filed after
the date of filing the appeal.

(c) If a respondent brief is filed which
does not comply with all the require-
ments of paragraph (a) and paragraph
(b) of this section, respondent will be
notified of the reasons for non-compli-
ance and given a non-extendable time
period within which to file an amended
brief. If respondent does not file an
amended respondent brief within the
set time period, or files an amended re-
spondent brief which does not over-
come all the reasons for non-compli-
ance stated in the notification, the re-
spondent brief and any amended re-
spondent brief by that respondent will
not be considered.

§41.69 Examiner’s answer.

(a) The primary examiner may, with-
in such time as directed by the Direc-
tor, furnish a written answer to the
owner’s and/or requester’s appellant
brief or respondent brief including, as
may be necessary, such explanation of
the invention claimed and of the ref-
erences relied upon, the grounds of re-
jection, and the reasons for patent-
ability, including grounds for not
adopting any proposed rejection. A
copy of the answer shall be supplied to
the owner and all requesters. If the primary examiner determines that the appeal does not comply with the provisions of §§41.61, 41.66, 41.67 and 41.68 or does not relate to an appealable action, the primary examiner shall make such determination of record.

(b) An examiner’s answer may not include a new ground of rejection.

(c) An examiner’s answer may not include a new determination not to make a proposed rejection of a claim.

(d) Any new ground of rejection, or any new determination not to make a proposed rejection, must be made in an Office action reopening prosecution.

§ 41.71 Rebuttal brief.

(a) Within one month of the examiner’s answer, any appellant may once file a rebuttal brief.

(b)(1) The rebuttal brief of the owner may be directed to the examiner’s answer and/or any respondent brief.

(b)(2) The rebuttal brief of the owner shall not include any new or non-admitted amendment, or an 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 §41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(c)(1) The rebuttal brief of any requester may be directed to the examiner’s answer and/or the respondent brief of the owner.

(c)(2) The rebuttal brief of a requester may not be directed to the respondent brief of any other requester.

(c)(3) No new ground of rejection can be proposed by a requester.

(d) The rebuttal brief of a requester shall not include any new or non-admitted affidavit or other evidence. See §1.116(d) of this title for affidavits or other evidence filed after final action but before or on the same date of filing an appeal and §41.63(c) for affidavits or other evidence filed after the date of filing the appeal.

(d) The rebuttal brief must include a certification that a copy of the rebuttal brief has been served in its entirety on all other parties to the proceeding. The names and addresses of the parties served must be indicated.

(e) If a rebuttal brief is timely filed under paragraph (a) of this section but does not comply with all the requirements of paragraphs (a) through (d) of this section, appellant will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended rebuttal brief. If the appellant does not file an amended rebuttal brief during the one-month period, or files an amended rebuttal brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant’s rebuttal brief and any amended rebuttal brief by that appellant will not be considered.

§ 41.73 Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which an appellant or a respondent considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as an appeal decided after an oral hearing.

(b) If an appellant or a respondent desires an oral hearing, he or she must file, as a separate paper captioned “REQUEST FOR ORAL HEARING,” a written request for such hearing accompanied by the fee set forth in §41.20(b)(3) within two months after the date of the examiner’s answer. The time for requesting an oral hearing may not be extended. The request must include a certification that a copy of the request has been served in its entirety on all other parties to the proceeding. The names and addresses of the parties served must be indicated.

(c)(1) If no request and fee for oral hearing have been timely filed by appellant or respondent as required by paragraph (b) of this section, the appeal will be assigned for consideration and decision on the briefs without an oral hearing.

(d) If appellant or respondent has complied with all the requirements of paragraph (b) of this section, a hearing date will be set, and notice given to the owner and all requesters. If an oral hearing is held, an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or