

Options For Responding To An Examiner's Answer When The
Examiner Has Introduced A New Ground Of Rejection During The
Appeal Process
by Levi Brown

When a patent practitioner and a patent examiner disagree on the interpretation of claim language, it is often beneficial to have an unbiased third party review the claims via the appeal process. Doing so can help maintain the relationship between the practitioner and the examiner and can help advance the prosecution of the patent application. During patent prosecution, appeals are heard by the Patent Trial and Appeal Board (PTAB) of the USPTO. Section 134 of the Patent Code clarifies when an appeal can be made by stating the following: "An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal."

After a claim has been "twice rejected" by the Examiner, a patent practitioner can trigger the appeal process by filing a notice of appeal, which should be filed within three months of the last Office Action rejection to avoid paying an extension of time fee. Once filed, the notice of appeal starts another timer in which the practitioner is required to file an appeal brief. The practitioner designs the appeal brief in a manner so as to best present his/her arguments as to why the examiner's interpretation is flawed. Careful attention should be had when drafting this appeal brief. In return, the examiner is permitted to respond to the appeal brief in what is referred to as an "examiner's answer." In the examiner's answer, examiners are able to present their arguments as to why they believe their interpretations are correct.

Sometimes, the examiner may (either intentionally or unintentionally) introduce a new ground of rejection in the examiner's answer. According to 37 CFR 41.39, for the new ground of rejection to be properly introduced in the examiner's answer, "The examiner must obtain approval of the Director to furnish an answer that includes a new ground of rejection." As indicated above, however, sometimes the examiner may introduce a new ground of rejection without the Director's approval. Listed below are a couple of options for responding to an examiner's answer that includes an improper new ground of rejection.

One option to address an improper new ground of rejection in an examiner's answer is to file a petition as described in MPEP 1207.03(b). Specifically, this MPEP section describes how "37 CFR 41.40 sets forth the exclusive procedure for an appellant to request review of the

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primary examiner's failure to designate a rejection as a new ground of rejection..." "A decision ***granting*** a petition under 37 CFR 41.40 will provide a two-month time period in which appellant must file a reply under 37 CFR 1.111 to avoid the dismissal of the appeal" (emphasis added). As such, the practitioner can petition for a review of the new ground of rejection in an effort to have the rejection precluded from consideration during the appeal process.

Another option to address an improper new ground of rejection was laid out by the *In re Durance*, 2017-1486 (Jun 1, 2018) opinion. With this Federal Circuit opinion, the Federal Circuit indicated that it is now acceptable to directly argue against the examiner's new ground of rejection in the practitioner's reply brief, which is filed after the examiner's answer. Typically, practitioners are limited in what they can say in reply briefs to only the arguments originally presented in their appeal briefs. If, however, the examiner raises a new ground of rejection, then the *In re Durance* opinion clearly indicates that practitioners are permitted to directly address those rejections in the reply brief – even if the original appeal brief did not have any similar arguments.

Therefore, there are a number of options for responding to situations in which the examiner has narrated a new ground of rejection in his/her examiner's answer. Practitioners should be very careful, however, because it may not always be immediately evident when an examiner has introduced a new ground of rejection. Consequently, it is highly important for practitioners to carefully review and consider every part of the examiner's answer when considering how to proceed.