

**Keywords:** appeal; cancellation of claims on appeal (37 C.F.R. § 41.33); waiver of claim arguments on appeal (37 C.F.R. § 41.37)

**General:** The Board does not enter into agreements for claim amendments/cancellations that would restrict future actions the Board could take.

*Ex parte Letts*

No. 2007-1392 (B.P.A.I. Jan. 31, 2008)

Application No. 10/640,895

## I. Facts

This case is an unusual precedential opinion by the Board of Patent Appeals and Interferences. The Board issued this opinion to “put appellants on notice” of the issues raised in this case.

The ‘895 application is directed to methods for forming polyisocyanurate insulation foams. At the time of appeal, the application included three independent claims – 1, 7, and 15. Applicant amended claims 1 and 15 in the course of prosecution to include limitations as to the pressure and temperature at which the foam is produced; however, claim 7 was not similarly amended. In the Appeal Brief, “Appellant offer[ed] to cancel claim 7, as well as the claims dependent thereon, upon favorable consideration of claims 1 and 15.” Appellant did not actually cancel independent claim 7 but rather merely *offered* to do so *if* the Board allowed claims 1 and 15.

Furthermore, Appellant’s arguments in the appeal brief were not separated by headings for different claim groups. That is, the arguments were all grouped together under the heading “Rejections under 35 U.S.C. § 103.” In addition to arguing that the Examiner’s rejection included an improper combination of references, Appellant specifically argued that the combined references did not include the pressure and temperature limitations recited in claims 1 and 15 (and not recited in claim 7).

In the Decision on Appeal, the merits panel of the Board considered all of the claims together because the arguments were not presented under separate headings. Because claim 7 was not actually cancelled prior to consideration of the appeal, the merits panel based its decision on claim 7, the broadest claim on appeal, and affirmed the Examiner’s rejection. The merits panel did not even consider Appellant’s arguments regarding the temperature and pressure limitations found in claims 1 and 15.

Appellant requested a rehearing, arguing that the Examiner and the merits panel should have been aware that Appellant inadvertently failed to cancel claim 7. Appellant also requested that claims 1 and 15 should be reconsidered on the merits in the interest of judicial economy.

## II. Issues

- A. Should the Board dismiss the appeal as to claim 7 and the claims dependent thereon?
- B. Should the Board rehear the appeal and decide patentability on the merits of claims 1 and 15 and the claims dependent thereon?

### **III. Discussion**

- A. Yes. Appellant could have cancelled claim 7 and its dependent claims even during the appeals process. 37 C.F.R. § 41.33(b)(1) allows for Appellant to cancel claims even after the appeal brief has been filed “where such cancellation does not affect the scope of any other pending claim in the proceeding.” In this instance, where Appellant did not want claim 7 considered on the merits, the claim should have been formally cancelled. The Board “does not enter into contingent arrangements in which the withdrawal or dismissal of a claim is conditioned upon commitments to or restrictions on future Board action.”
- B. Yes. 37 C.F.R. § 41.37(c)(1)(vii) states, “Any claim argued separately should be placed under a subheading identifying the claim by number.” In addition, “the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.” Despite these clear statements in the rules that each claim must have a *separate heading* to be considered separately and that failure to argue the claims separately constitutes a *waiver* of separate arguments, the Board took mercy on Appellant and remanded consideration of independent claims 1 and 15 and the claims dependent thereon. In reaching this conclusion, the Board noted that Appellant had *offered* to cancel claim 7 and *actually argued* limitations of claims 1 and 15 not found in claim 7. Thus, the Board found that Appellant made it “abundantly clear” that he no longer sought a patent on claim 7 and therefore essentially cancelled this claim. This decision was reached “out of an abundance of fairness” and a lack of precedent.

### **IV. Conclusion**

The Board will not enter into a contingent deal to allow some claims upon cancellation of others. Allowing such negotiations would slow them down even more. In addition, although the Board allowed this Appellant to get away with a technically incorrect appeal brief, this precedential opinion would probably bar such future action.

### **V. Follow-Up**

Upon remand to the merits panel, the Examiner was affirmed as to the rejection of claims 1 and 15. Appellant subsequently filed a Request for Continued Examination, and the application is still pending. The same attorney is still handling the case.