

Keywords: appeal brief; reply brief; Examiner’s answer; 37 C.F.R. §§ 41.37 and 41.41

General: The Board of Patent Appeals and Interferences held that arguments presented in a Reply Brief that could have been but were not presented in an Appeal Brief would not be considered by the Board absent a showing of good cause.

Ex parte Nakashima

Appeal No. 2009-001280 (B.P.A.I. 2010)

Decided January 7, 2010

I. Facts

On March 24, 2004, the appellant, Nakashima, filed patent application number 10/490,430 (the ‘430 application) as the U.S. national stage filing claiming priority to a corresponding PCT application filed on March 7, 2003. The ‘430 application relates generally to a printing apparatus for ejecting or transferring ink onto a recording medium (e.g., paper). Independent claims 1 and 19 each recite, among other things, “two inner belts circularly wound around the at least two rollers” and “an outer belt layer arranged so as to abut an outer surface of each of the inner belts.” Figure 2 of the ‘430 application is reproduced below.

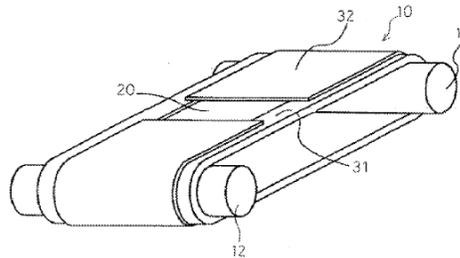
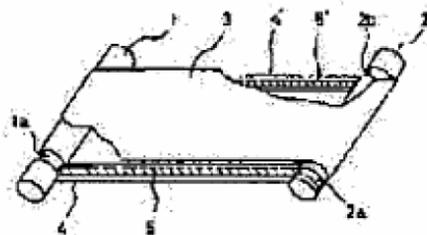


Figure 2 of the ‘430 application

On December 12, 2005, the Examiner issued a Final Office Action rejecting the claims of the ‘430 application. In particular, independent claims 1 and 19 were rejected under 35 U.S.C. § 103 as being obvious based upon the combination of Marinoff, U.S. Patent No. 4,207,578, and Morikoshi, Japanese Patent No. 4,333,457. In the Final Office Action, the Examiner conceded that Marinoff, which discloses an ink jet copier, fails to disclose two inner belts, but used Morikoshi to remedy this deficiency. In particular, the Examiner stated that Morikoshi discloses a belt assembly having two guides which are used to hold a main belt in place. The Examiner took the position that it would have been obvious to incorporate the guides of Morikoshi as inner belts in the ink jet copier of Marinoff. The Abstract figure from Morikoshi (showing the guides 5 and 5’) and Figure 3 of Marinoff are reproduced below.



Abstract Figure of Morikoshi

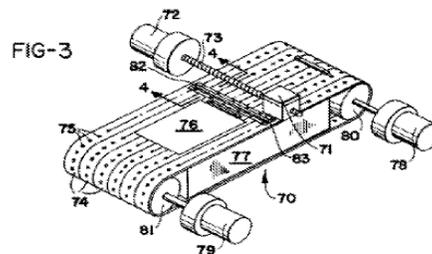


Figure 3 of Marinoff

Nakashima appealed the final rejection to the Board of Patent Appeals and Interferences (the “Board”) and subsequently filed an Appeal Brief. Nakashima’s Appeal Brief generally focused on the “two inner belts” feature recited by independent claims 1 and 19. In particular, Nakashima noted that the copier of Marinoff includes belts having perforations extending along the width and length of each belt to establish a vacuum for positioning a sheet of paper. Nakashima argued that if the guides of Morikoshi were to be incorporated along the edges of the outer belts of Marinoff, this would disrupt and/or destroy the vacuum in those regions and would prevent the outer edges of a sheet of paper from being properly supported against the main belt(s) of Marinoff. In light of these observations, Nakashima argued that the combination of Marinoff and Morikoshi would render Marinoff unsatisfactory for its intended purpose and is, therefore, an improper combination based on hindsight. Nakashima additionally challenged the Examiner’s interpretation of a “guide” as being analogous to an “inner belt.”

The Examiner responded with an Examiner’s Answer and addressed Nakashima’s “improper combination” argument by stating that one skilled in the art would have recognized that “when modifying the apparatus of Marinoff, the belt guides taught by Morikoshi et al. should be positioned outside or between the perforations of Marinoff, such that they do not interfere with the vacuum portion of the apparatus.” Additionally, the Examiner’s reasoning for combining the cited references was further explained as being that the inclusion of the guides of Morikoshi with the belts of Marinoff would provide the advantage of reducing side-to-side movement of the belt during operation.

Thereafter, Nakashima filed a Reply Brief. In the Reply Brief, Nakashima argued that Marinoff is already capable of preventing side-to-side movement using vacuum forces through the perforations in the belts, and thus would not need to be modified using Morikoshi in the manner suggested by the Examiner. Further, Nakashima also introduced a new argument (the “New Argument”) in the Reply Brief against the combination of Marinoff and Morikoshi that does not appear to be directly in response to any statement in the Final Office Action or in the Examiner’s Answer. Specifically, Nakashima argued:

Further, another reason that there is no desirability for the alleged combination is that Morikoshi is directed towards a single seamless belt, whereas Marinoff is directed towards a series of multiple belts 34, 74 (Marinoff, col. 3, lines 58-60). Morikoshi teaches that the guides are located on both sides of the belt. Thus, to combine Marinoff and Morikoshi as suggested by the Examiner would produce a transfer device including a series of multiple belts in Marinoff wherein each belt includes guides on both sides of the belt. Such a combination would not have been obvious nor desirable to one skilled in the art.

Reply Brief, p. 6 (emphasis in original).

The ‘430 application was then forwarded to the Board to render a decision with regard to Nakashima’s appeal.

II. Issue

Whether the New Argument presented in Nakashima’s Reply Brief was presented in a timely manner for consideration by the Board in accordance with 37 C.F.R. §§ 41.37 and 41.41 absent a showing of good cause.

III. Discussion

No. The majority of a seven-judge panel found the New Argument presented in Nakashima's Reply Brief was not presented in a timely matter in accordance with 37 C.F.R. §§ 41.37 and 41.41. In reaching this conclusion, the Majority examined 37 C.F.R. §§ 41.37 and 41.41, which generally govern appeal briefs and reply briefs. In particular, Rule 41.37 states that "[a]ny arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown" (emphasis added). Rule 41.41 further states that "[a] reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence."

While Rule 41.41, on its face, appears to limit what is not permissible in a reply brief to new or non-admitted amendments, affidavits, or evidence, the Majority stated that the purpose of a reply brief is to give an appellant the opportunity to have the last word in order to address new grounds of rejection raised in an Examiner's Answer or changes or developments in the law occurring after the filing of the initial appeal brief. The Majority stated that the reply brief is not intended to provide the appellant an opportunity to make new arguments that could have been but were not made either during prosecution or in the appeal brief. Adopting this position, the Majority further stated that the reference to reply briefs in Rule 41.37 is merely intended to put an appellant on notice that arguments that could be made in a reply brief, but were not, are waived. Rule 41.37 is not, as the Majority stressed, intended to create a right for the appellant to introduce an argument in a reply brief that could have been presented in an appeal brief, but was not.

The Board's reasoning was drawn largely from the analysis of the legislative and rule-making history regarding the reply brief rules. Prior to July 1, 1998, reply briefs were not permitted as a matter of right, and were only permitted when an Examiner introduced a new point of argument in an Examiner's Answer. Further, in such cases, the appellant was required to identify the new point(s) of argument and to direct arguments in the reply brief only to these new point(s) of argument. In 1998, the reply brief rules were amended to preclude new grounds of rejections in an Examiner's Answer and to allow reply briefs as a matter of right. This change was made largely to prevent controversies as to what constituted a new point of argument in an Examiner's Answer. The Board then noted that the current rules, which were adopted in 2004, now permit the Examiner to introduce new grounds of rejections in an Examiner's Answer, but did not expand the role of the reply brief by permitting untimely arguments. In support of this position, the Board cited notes published in the Federal Register during the development of the current rules, which state "the rules continue to permit the appellant to always have the last word ... [but] *[a]bsent* a new ground of rejection in the Examiner's Answer, the record before the Board should remain fixed as of the date the appeal brief is filed so that a reasoned review of the record may efficiently take place." 69 Fed. Ref. at 49980-1 (emphasis in original).

As a side note, the Majority also analogized a reply brief under Rule 41.41 to a reply brief under Rule 28(c) of the Federal Rules of Appellate Procedure, and noted the Federal Circuit has held that a reply brief under Rule 28(c) is "not an appropriate place to raise, for the first time, an issue for appellate review."

When considering Nakashima's Reply Brief, the Majority reasoned that the New Argument could have been presented in Nakashima's Appeal Brief, but was only raised for the first time in Nakashima's Reply Brief. Accordingly, the Majority declined to consider the New Argument in view of Nakashima's failure to provide a showing of good cause. The result of Nakashima's appeal was that the Board affirmed all of the Examiner's rejections from the Final Office Action.

IV. Conclusion (Based on Majority Opinion)

In practice, do not rely upon a Reply Brief to present an argument if it is one that could have been presented in an Appeal Brief, but was not.

V. Dissent

The Minority disagreed with the Majority interpretation of Rules 41.37 and 41.41. Particularly, the Minority noted that Rule 41.41 clearly states that a reply brief *cannot* include “new or non-admitted amendment, or any new or non-admitted affidavit or other evidence.” Thus, based on Rule 41.37, an argument in a reply brief that does not include new or non-admitted amendments, affidavits, or evidence, need not be accompanied by a showing of good cause. The Minority noted that the Majority’s position that arguments that could be made in an Appeal Brief, but were not, are waived is in clear contradiction with the wording of Rule 41.37, which states that “[a]ny arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown” (emphasis added).

The Minority noted that prior to June 1, 1998, reply briefs could only be directed to new points of argument in an Examiner’s Answer, but that this provision was eliminated on June 1, 1998, at which time the rule provided:

Appellant may file a reply brief to an examiner’s answer within two months from the date of such examiner’s answer The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief.

Former 37 C.F.R. § 1.193(b) (now § 41.41).

The notes published in the Federal Register regarding the above-cited rule further state that “Section 1.193(b)(1) provides appellant with a right to file a reply brief in reply to an examiner’s answer which is not dependent upon a new point of argument being present in the examiner’s answer.” 62 Fed. Reg. 53168. Thus, the Minority reasoned that subsequent to June 1, 1998, there was no longer a requirement that reply briefs be limited only to addressing new points of argument in an Examiner’s answer, and could include additional arguments not made in the appeal brief as long as such arguments did not include new or non-admitted amendments, affidavits, or evidence.

Further, with regard to the Majority’s analysis of Rule 28(c) of the Federal Rules of Appellate Procedure, the Minority noted that Rule 28(c) merely states, broadly, that an appellant may file a brief in reply to an appellee’s brief. This broad language is interpreted by the courts on a case by case basis. 37 C.F.R § 41.41, by contrast, specifically dictates what is forbidden in a reply brief.

Here, the Minority noted that Nakashima’s New Argument presented in the Reply Brief did not include new or non-admitted amendments, affidavits, or other evidence. Thus, the Minority believes that Nakashima’s New Argument was not belated or untimely, and should have been considered by the Board in deciding this Appeal without requiring a showing of good cause.

APPENDIX**37 C.F.R. § 41.37: Appeal Brief**

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

...

(vii) Argument. The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. ***Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown.*** Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, 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. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

37 C.F.R. § 41.41: Reply Brief

(a)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

(a)(2) ***A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted 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 § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

Federal Rules of Appellate Procedure: Rule 28(c)

(c) Reply Brief. The appellant may file a brief in reply to the appellee's brief. Unless the court permits, no further briefs may be filed. A reply brief must contain a table of contents, with page references, and a table of authorities—cases (alphabetically arranged), statutes, and other authorities—with references to the pages of the reply brief where they are cited.