**From:** wsteinkraus@vaslaw.com
**Sent:** Tuesday, December 30, 2003 5:50 PM
**To:** AB71 Comments
**Subject:** Proposed revisions relating to decisions by BPAI -OG date: 30 December 2003
Attention:
Kery Fries

The previous position of the Office that a remand was not "a decision" and not "a decision reversing an adverse determination of patentability" is incorrect on its face. Appeals to the Board are taken as a matter of statutory right. 35 USC 135(a). The right of appeal necessarily incorporates the right to an appeal decision. Neither the Board nor the Director, and certainly not an Examiner, has authority to contravene or interfere with this right. Therefore any actions taken by the Office to determine the patentability of a claim on appeal must be undertaken pursuant to the appeal. The decisional authority of the Board on appeal is the only jurisdictional basis which the Office has for issuing an action on the merits of patentability at such point in prosecution. After a Notice of Appeal is filed, therefore, any action taken by the Office which results in the allowance of an unamended appealed claim is necessarily a decision "due to .. appellate review by the Board of Patent Appeals and Interferences," for purposes of 35 USC 154(b)(1)(C), even if an Office delegation procedure permits an Examiner to withdraw the rejection.

Therefore the proposed amendment is welcome. However the proposal still deprives an applicant of the proper term extension.

When the Board remands a case to the Examiner, the Examiner receives an express delegation of authority from the Board - to reconsider - and, in the event that the Examiner concludes that the rejection cannot be sustained, - to make the decision on behalf of the Board. A decision by the Examiner to allow the application is a decision "in the review" and "due to appellate review" because it is made under that delegated authority. The Examiner makes the decision for the Board in the course of their appellate review when the Examiner issues an action finding an appealed claim allowable during remand. This is the only way that the remand procedure can be squared with the applicant's right of appeal under 35 USC 135(a).

An Examiner's decision under delegated authority from the Board is thus "a decision in the review reversing an adverse determination of patentability," for purposes of 35 USC 154(b)(1)(C). Consequently, the period from remand to Notice of Allowance is also part of the pendency of the appeal proceeding and should be counted in the calculation of the extension period.

Similarly the Office should make it clear that if the Examiner upon remand maintains a rejection which is eventually reversed by the Board, the entire period of the appeal, including any time taken by the Examiner during the remand, is counted for the extension period.

Also, amendments during remand canceling or amending claims should not disqualify the remanded case from extension - so long as at least one previously rejected claim is allowed in unamended form. If the Board had made a decision sustaining some rejections, but reversing all rejections as to one claim, the patent would qualify for extension. The same single claim rule should apply to decisions made by the Examiner acting under delegated remand authority from the Board.

Of course any time period between the date of an Examiner's action on remand finding an appealed claim allowable (or the latest date finding an unamended appealed claim allowable - if more than one such claim are involved and they are found allowable at different times during the remand) and the date of allowance of the application, should not be counted as part of the pendency of the review.

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