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Subpart A — General Provisions

§ 41.1 Policy.

(a) *Scope.* Part 41 governs proceedings before the Board of Patent Appeals and Interferences. Sections 1.1 to 1.36 and 1.181 to 1.183 of this title also apply to practice before the Board, as do other sections of part 1 of this title that are incorporated by reference into part 41.

(b) *Construction.* The provisions of Part 41 shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding before the Board.

(c) *Decorum.* Each party must act with courtesy and decorum in all proceedings before the Board, including interactions with other parties.

[Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

§ 41.2 Definitions.

Unless otherwise clear from the context, the following definitions apply to proceedings under this part:

Affidavit means affidavit, declaration under § 1.68 of this title, or statutory declaration under 28 U.S.C. 1746. A transcript of an ex parte deposition may be used as an affidavit in a contested case.

Board means the Board of Patent Appeals and Interferences and includes:

- (1) For a final Board action:

- (i) In an appeal or contested case, a panel of the Board.

- (ii) In a proceeding under § 41.3, the Chief Administrative Patent Judge or another official acting under an express delegation from the Chief Administrative Patent Judge.

- (2) For non-final actions, a Board member or employee acting with the authority of the Board.

Board member means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, the Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges.

Contested case means a Board proceeding other than an appeal under 35 U.S.C. 134 or a petition under § 41.3. An appeal in an *inter partes* reexamination is not a contested case.

Final means, with regard to a Board action, final for the purposes of judicial review. A decision is final only if:

- (1) *In a panel proceeding.* The decision is rendered by a panel, disposes of all issues with regard to the party seeking judicial review, and does not indicate that further action is required; and

- (2) *In other proceedings.* The decision disposes of all issues or the decision states it is final.

Hearing means consideration of the issues of record. *Rehearing* means reconsideration.

Office means United States Patent and Trademark Office.

Panel means at least three Board members acting in a panel proceeding.

Panel proceeding means a proceeding in which final action is reserved by statute to at least three Board members, but includes a non-final portion of such a proceeding whether administered by a panel or not.

Party, in this part, means any entity participating in a Board proceeding, other than officers and employees of the Office, including:

- (1) An appellant;
- (2) A participant in a contested case;
- (3) A petitioner; and
- (4) Counsel for any of the above, where context permits.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.3 Petitions.

(a) *Deciding official.* Petitions must be addressed to the Chief Administrative Patent Judge. A panel or an administrative patent judge may certify a question of policy to the Chief Administrative Patent Judge for decision. The Chief Administrative Patent Judge may delegate authority to decide petitions.

(b) *Scope.* This section covers petitions on matters pending before the Board (§§ 41.35, 41.64, 41.103, and 41.205); otherwise, see §§ 1.181 to 1.183 of this title. The following matters are not subject to petition:

(1) Issues committed by statute to a panel, and

(2) In pending contested cases, procedural issues. See § 41.121(a)(3) and § 41.125(c).

(c) *Petition fee.* The fee set in § 41.20(a) must accompany any petition under this section except no fee is required for a petition under this section seeking supervisory review.

(d) *Effect on proceeding.* The filing of a petition does not stay the time for any other action in a Board proceeding.

(e) *Time for action.* (1) Except as otherwise provided in this part or as the Board may authorize in writing, a party may:

(i) File the petition within 14 days from the date of the action from which the party is requesting relief, and

(ii) File any request for reconsideration of a petition decision within 14 days of the decision on petition or such other time as the Board may set.

(2) A party may not file an opposition or a reply to a petition without Board authorization.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (e)(1) revised, 69 FR 58260, Sept. 30, 2004, effective Sept. 30, 2004]

§ 41.4 Timeliness.

(a) *Extensions of time.* Extensions of time will be granted only on a showing of good cause except as otherwise provided by rule.

(b) *Late filings.* (1) A late filing that results in either an application becoming abandoned or a reex-

amination prosecution becoming terminated under §§ 1.550(d) or 1.957(b) of this title or limited under § 1.957(c) of this title may be revived as set forth in § 1.137 of this title.

(2) A late filing that does not result in either an application becoming abandoned or a reexamination prosecution becoming terminated under §§ 1.550(d) or 1.957(b) of this title or limited under § 1.957(c) of this title will be excused upon a showing of excusable neglect or a Board determination that consideration on the merits would be in the interest of justice.

(c) *Scope.* This section governs all proceedings before the Board, but does not apply to filings related to Board proceedings before or after the Board has jurisdiction, such as:

(1) Extensions during prosecution (see § 1.136 of this title),

(2) Filing of a brief or request for oral hearing (see §§ 41.37, 41.41, 41.47, 41.67, 41.68, 41.71 and 41.73), or

(3) Seeking judicial review (see §§ 1.301 to 1.304 of this title).

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (b) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007]

§ 41.5 Counsel.

While the Board has jurisdiction:

(a) *Appearance pro hac vice.* The Board may authorize a person other than a registered practitioner to appear as counsel in a specific proceeding.

(b) *Disqualification.* (1) The Board may disqualify counsel in a specific proceeding after notice and an opportunity to be heard.

(2) A decision to disqualify is not final for the purposes of judicial review until certified by the Chief Administrative Patent Judge.

(c) *Withdrawal.* Counsel may not withdraw from a proceeding before the Board unless the Board authorizes such withdrawal. See § 10.40 of this title regarding conditions for withdrawal.

(d) *Procedure.* The Board may institute a proceeding under this section on its own or a party in a contested case may request relief under this section.

(e) *Referral to the Director of Enrollment and Discipline.* Possible violations of the disciplinary rules in part 11 of this subchapter may be referred to

the Office of Enrollment and Discipline for investigation. See § 11.22 of this subchapter.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (e) revised, 73 FR 47650, Aug. 14, 2008, effective Sept. 15, 2008]

§ 41.6 Public availability of Board records.

(a) *Publication.* (1) *Generally.* Any Board action is available for public inspection without a party's permission if rendered in a file open to the public pursuant to § 1.11 of this title or in an application that has been published in accordance with §§ 1.211 to 1.221 of this title. The Office may independently publish any Board action that is available for public inspection.

(2) *Determination of special circumstances.* Any Board action not publishable under paragraph (a)(1) of this section may be published or made available for public inspection if the Director believes that special circumstances warrant publication and a party does not, within two months after being notified of the intention to make the action public, object in writing on the ground that the action discloses the objecting party's trade secret or other confidential information and states with specificity that such information is not otherwise publicly available. If the action discloses such information, the party shall identify the deletions in the text of the action considered necessary to protect the information. If the affected party considers that the entire action must be withheld from the public to protect such information, the party must explain why. The party will be given time, not less than twenty days, to request reconsideration and seek court review before any contested portion of the action is made public over its objection.

(b) *Record of proceeding.* (1) The record of a Board proceeding is available to the public unless a patent application not otherwise available to the public is involved.

(2) Notwithstanding paragraph (b)(1) of this section, after a final Board action in or judgment in a Board proceeding, the record of the Board proceeding will be made available to the public if any involved file is or becomes open to the public under § 1.11 of this title or an involved application is or becomes published under §§ 1.211 to 1.221 of this title.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.7 Management of the record.

(a) The Board may expunge any paper directed to a Board proceeding, or filed while an application or patent is under the jurisdiction of the Board, that is not authorized under this part or in a Board order, or that is filed contrary to a Board order.

(b) A party may not file a paper previously filed in the same Board proceeding, not even as an exhibit or appendix, without Board authorization or as required by rule.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.8 Mandatory notices.

(a) In an appeal brief (§§ 41.37, 41.67, or 41.68) or at the initiation of a contested case (§ 41.101), and within 20 days of any change during the proceeding, a party must identify:

- (1) Its real party-in-interest, and
- (2) Each judicial or administrative proceeding that could affect, or be affected by, the Board proceeding.

(b) For contested cases, a party seeking judicial review of a Board proceeding must file a notice with the Board of the judicial review within 20 days of the filing of the complaint or the notice of appeal. The notice to the Board must include a copy of the complaint or notice of appeal. See also §§ 1.301 to 1.304 of this title.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.9 Action by owner.

(a) *Entire interest.* An owner of the entire interest in an application or patent involved in a Board proceeding may act in the proceeding to the exclusion of the inventor (see 3.73 (b) of this title).

(b) *Part interest.* An owner of a part interest in an application or patent involved in a Board proceeding may petition to act in the proceeding to the exclusion of an inventor or a co-owner. The petition must show the inability or refusal of an inventor or co-owner to prosecute the proceeding or other cause why it is in the interest of justice to permit the owner of a

part interest to act in the proceeding. An order granting the petition may set conditions on the actions of the parties during the proceeding.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.10 Correspondence addresses.

Except as the Board may otherwise direct,

(a) Appeals. Correspondence in an application or a patent involved in an appeal (subparts B and C of this part) during the period beginning when an appeal docketing notice is issued and ending when a decision has been rendered by the Board, as well as any request for rehearing of a decision by the Board, shall be mailed to: Board of Patent Appeals and Interferences, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. Notices of appeal, appeal briefs, reply briefs, requests for oral hearing, as well as all other correspondence in an application or a patent involved in an appeal to the Board for which an address is not otherwise specified, should be addressed as set out in § 1.1 (a)(1)(i) of this title.

(b) Contested cases. Mailed correspondence in contested cases (subpart D of this part) shall be sent to Mail Stop INTERFERENCE, Board of Patent Appeals and Interferences, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.11 Ex parte communications in inter partes proceedings.

An ex parte communication about an inter partes reexamination (subpart C of this part) or about a contested case (subparts D and E of this part) with a Board member, or with a Board employee assigned to the proceeding, is not permitted.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.12 Citation of authority.

(a) Citations to authority must include:

(1) For any United States Supreme Court decision, a United States Reports citation.

(2) For any decision other than a United States Supreme Court decision, parallel citation to both the West Reporter System and to the United States Patents Quarterly whenever the case is published in both. Other parallel citations are discouraged.

(3) Pinpoint citations whenever a specific holding or portion of an authority is invoked.

(b) Non-binding authority should be used sparingly. If the authority is not an authority of the Office and is not reproduced in one of the reporters listed in paragraph (a) of this section, a copy of the authority should be filed with the first paper in which it is cited.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.20 Fees.

(a) Petition fee. The fee for filing a petition under this part is: \$400.00

(b) Appeal fees. (1) For filing a notice of appeal from the examiner to the Board:

By a small entity (§ 1.27(a) of this title) \$270.00

By other than a small entity \$540.00

(2) In addition to the fee for filing a notice of appeal, for filing a brief in support of an appeal:

By a small entity (§ 1.27(a) of this title) \$270.00

By other than a small entity \$540.00

(3) For filing a request for an oral hearing before the Board in an appeal under 35 U.S.C. 134:

By a small entity (§ 1.27(a) . . \$540.00

By other than a small entity . . . \$1,080.00

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; paras. (b)(1) through (b)(3) revised, 69 FR 52604, Aug. 27, 2004, effective Oct. 1, 2004; para. (b)(3) corrected, 69 FR 55505, Sept. 15, 2004, effective Oct. 1, 2004; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; para. (b) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004; paras. (b)(1) through (b)(3) revised, 72 FR 46899, Aug. 22, 2007, effective Sept. 30, 2007; para. (b) revised, 73 FR 47534, Aug. 14, 2008, effective Oct. 2, 2008]