

# Will the Board of Patent Appeals and Interferences Rely Upon Dictionary Definitions Newly

Cited in Appeal Briefs? Answer: It Depends

By Richard Neifeld, Neifeld IP Law, PC<sup>1</sup>

## I. INTRODUCTION

Should dictionary definitions be deemed "authority" or evidence? Can an appellants to the Board of Patent Appeals and Interferences ("BPAI") rely upon dictionary definitions in their brief when those definitions were not previously of record in the file history of their application? For example, assume an examiner's answer construes the meaning of a word or phrase in a claim or prior art reference in a manner not previously specified in the record. Can the appellant address that assertion in a reply brief by citing dictionary definitions contradicting the examiner's construction?

Whatever the answer to those questions should be, the USPTO has now taken somewhat inconsistent positions in two different appeals regarding that issue. In *ex parte* reexamination proceeding 90/006,707, the USPTO denied entry of a reply brief relying upon a dictionary definition newly cited in that brief. In application 09/401,939, the USPTO allowed entry of an appeal brief relying upon a dictionary definition newly cited in that brief.

Review of the facts and law relating to these two decisions provides guidance how to present dictionary definitions to the BPAI panel for consideration when those dictionary definitions were not of record prior to the filing of the brief.

## II. THE FACTS

**A. THE DECISION IN 90/006,707**

In 90/006,707, a series of USPTO decisions repeatedly denied entry of appellant's reply brief because the reply brief (1) relied upon a dictionary definition not previously cited and (2) had attached to it a copy of the portion of the dictionary containing the definition.<sup>2</sup>

On 6/4/2007, the USPTO mailed a paper in 90/006,707 stating that "The reply brief filed on 3-30-07 has not been considered because it is not in compliance with 37 CFR 4 1.41(a). The reply brief is non-compliant because the dictionary definitions (e.g. exhibits A-C) are considered new evidence."

On 2/29/2008, the USPTO mailed a paper in 90/006,707 containing a decision signed by Donald T. Hajec, Director, Patent Technology Center 3600, in response to a request by the patentee for reconsideration of a denial of a petition requesting entry of the reply brief. This decision stated that:

In response to the argument that a dictionary definition is not new evidence, the position is maintained dictionary definitions are considered to be evidence and as the definitions and exhibits in question were first presented in the Reply Brief the decision to deny the previous petition followed the procedure of the MPEP and 37 CFR 41.41 (a)(2) and (b) and did not take a position that is contrary to law. ... [f]acts and documentation not previously submitted to the Office and relied upon by the Appellant in a reply brief as proof for their position is considered to be new evidence. ... The petition is DENIED.

On 6/2/2008, the USPTO mailed a paper in 90/006,707 containing a decision signed by John Love, Deputy Commissioner for Patent Examination Policy, in response to petitions requesting entry of a reply brief and waiver of rules necessary to enter the reply brief. This decision stated that "The refusal to enter the reply briefs of March 30, 2007 and October 25,

2007, will not be disturbed, and the rules will not be waived to provide for such entry. The petition is denied."

From the foregoing, it is clear that the USPTO considers dictionary definitions presented in the form of exhibits attached to a brief to be evidence.

**B. THE DECISION IN 09/401,939**

I am prosecuting 09/401,939. In contrast with the facts in 90/006,707, the brief filed in 09/401,939 did not include an attachment containing a dictionary definition; instead it included a quotation of the definition and a cite (to the URL at which I found the definition) to the definition.

On 11/10/2006, the applicants filed an appeal brief in 09/401,939. The appeal brief stated in pertinent part that "A voucher means 'a document that provides supporting evidence for a claim, e.g. a receipt proving that a purchase was made.' See for example:

[http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid\\_1861732375](http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid_1861732375). "

This definition of "voucher" and the URL at which it could be found were not previously of record in the file history for 09/401,939.

On 11/29/2007, the USPTO issued an order in 09/401,939 returning the file to the examiner, which stated in pertinent part that:

Finally, the Appeal Brief, received November 10,2006, contains reference to a dictionary term [sic; voucher] that is technically considered to be evidence (see Appeal Br. 15). This dictionary term should be included along with a copy of said term in the Evidence Appendix Section of the Appeal Brief. See MPEP 5

1205.02. [Interpolation added.]

On 4/21/2008, the USPTO issued a "Notice Of Non Compliant Brief" identifying the alleged error in the brief and requiring the appellants to file a corrected brief.

On 4/29/2008, the appellant filed a petition to withdraw the requirement, stating in pertinent part, the following:

Appellant traverses the notification of non-compliant appeal brief as improper, and requests that the prior reply brief be reinstated. The requirement is improper for three reasons.

First, because content of arguments in briefs are not evidence, a requirement to provide items referenced in the brief in an evidence appendix is improper.

Second, citation to authorities in the arguments section of the brief is expressly provided for in the rules. 37 CFR 41.37(b)(vii).

Third, since that evidence was not submitted during prosecution, inclusion in the Evidence appendix of the brief of that evidence would in fact be a violation of the pending rules for appeal briefs. 37 CFR 41.37(b)(ix) forbids presenting evidence not of record in the appendix. 37 CFR 41.33(c)(2) indicates that submission of new evidence after an appeal will probably result in automatic withdrawal of the appeal, since it would likely be treated as a request to reopen prosecution. The examiner cannot require the applicant to take action resulting in termination of an appeal in the guise of a requirement from the BPAI.

As to the BPAI panel, while the panel is free to discount or ignore suggestions that it consult authority on the meaning of words, such as dictionary definitions, it cannot reject an appeal merely because of that suggestion. In this case, the suggestion is to consider a dictionary definition in the statement in the brief, specifically:

“A voucher means ‘a document that provides supporting evidence for a claim, e.g. a receipt proving that a purchase was made.’ See for example: <http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=1861732375>.” Accordingly, the requirement should be withdrawn and the prior appeal brief reinstated. [Petition filed 4/9/2008 in 09/401,939.]

On 7/16/2008, the USPTO issued a document containing an appeal docketing notice for 09/401,939. At this time, the petition filed 4/29/2008 was undecided.

On 7/17/2008, the appellant filed a document titled "NOTICE OF UNDECIDED PETITION AFFECTING APPEAL," bringing to the attention of the USPTO the existence of undecided petitions.

On 7/22/2008, the USPTO issued a document containing a decision signed by Chief Administrative Patent Judge ("CAPJ") Fleming deciding the undecided petitions filed in 09/401,939. This decision expressly authorized the BPAI merits panel to consider the definition first cited in the appeal brief, stating that:

The merits panel to which this appeal is assigned for decision is authorized to consider, to the extent it may be relevant, Appellants' statement in the Original Brief, p. 15, that: A voucher means "a document that provides supporting evidence for a claim, e.g. a receipt proving that a purchase was made." See for example: [http://encarta.msn.codencnet/features/dictionary/DictionaryResult~.aspx?refid\\_1861732375](http://encarta.msn.codencnet/features/dictionary/DictionaryResult~.aspx?refid_1861732375).

In other words, a brief containing a quotation of a dictionary definition and a citation for that definition not of record was allowed entry, and the BPAI panel was authorized to consider the definition to the extent that it might be relevant in deciding the appeal.

### III. **THE LAW**

The regulatory limitations on entry of evidence in reexaminations and pending applications are the same. Therefore, there is no legal criteria distinguishing the decisions in 90/006,707 (a reexamination) and 09/401,939 (an application). Specifically, 37 CFR 41.33(d) defines the standard for admission of evidence newly cited in an appeal brief for both reexaminations and applications. 37 CFR 41.33(d)(1) states that "An affidavit or other evidence filed ... prior to the date of filing a brief ... may be admitted" under certain conditions, implying

that no evidence filed with or after the date a brief is filed may be admitted. 37 CFR 41.33(d)(2) confirms that implication stating that "All ... affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1). [Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]." <sup>3, 4</sup> 37 CFR 41.33 is revised, effective December 10, 2008. However, the revised version also precludes filing of new evidence in a brief.<sup>5</sup> Thus, the rules relating to entry of evidence in appeals are the same for applications and reexaminations.

The only factual difference impacting the difference in decisions in 90/006,707 and 09/401,939 is that the 09/401,939 appeal brief did not attach a copy of that portion of the dictionary containing the relied upon definition and instead included a citation to the dictionary definition identifying specifically where the definition could be found. That factual difference impacted the USPTO's decisions whether to enter briefs relying upon dictionary definitions not of record. However, that factual difference would not appear to affect probative value of the dictionary definitions. This is because a quotation and a citation in a brief identifying specifically where quoted material can be found is (1) an assertion of fact, not mere attorney argument, and (2) objectively reliable in the same sense as an incorporation by reference. Cf. Advanced Display Systems Inc. v. Kent State University, 212 F.3d 1272, 1281-82, 54 USPQ2d 1673, 1678-80 (Fed. Cir. 2000). Thus, the dictionary definition in 09/401,939 is probative of the meaning assigned to "voucher" by the cited dictionary. Hence, the decision in 09/401,939 indicates that a BPAI panel should consider the dictionary definition quoted in the brief and not otherwise of record in that application to the same extent as if the dictionary definition were of record.

#### IV. DISCUSSION

What do these decisions mean for appellants? It means that inclusion in briefs of dictionary definitions cited in the manner suggested by 09/401,939 should result in the intended effect; entry of the brief and consideration by the panel deciding the appeal of the definition when rendering a decision. In fact, the decision in 09/401,939 is evidence supporting judicial challenge of a BPAI decision in which the BPAI panel refuses to consider such dictionary definitions.

Will the USPTO accord quotations and citations in a brief to non dictionary authorities, such as scholarly journal articles, the same respect as they did for the quotation and citation to a dictionary in 09/401,939? The underlying reasoning (1) that such actions do not violate 37 CFR 41.33(d), (2) that assertions of fact are not attorney argument, and (3) that citations are tantamount to an incorporation by reference, all apply. Therefore, the USPTO would likely enter such a brief and the BPAI would likely consider such quotations in a decision, assuming the USPTO does not backtrack on the decision in 09/401,939. Will the USPTO backtrack on the decision in 09/401,939 in an attempt to preclude quotations and citations to sources in other appeals? Theoretically, it could ignore its decision in 09/401,939 in another case, but that would raise an issue of violation of the Administrative Procedures Act ("APA"). It could issue an official notice clarifying its policy in an attempt to backtrack and also avoid APA issues. Or, it could promulgate a revision to 37 CFR 41.33(d) to backtrack on its decision in 09/401,939.

Another interesting point is why the petition in 90/006,707 was decided in the examining corps whereas the petition in 09/401,939 was decided at the BPAI. Normally, the decision whether to enter or refuse entry of a brief in the first instance resides with the examining corps

because the examining corps has jurisdiction over an application when briefs are filed. This is why the examining corps decided the petitions in 90/006,707. The CAPJ decided the petition in 09/401,939 only because of a USPTO procedural irregularity. Specifically, the examining corps failed to decide petitions before returning the file for 09/401,939 to the BPAI. After the file for 09/401,939 was returned to the BPAI for a decision on the appeal, the appellant filed a paper notifying the BPAI that there were undecided petitions affecting the appeal. As a result, CAPJ Fleming chose to expressly invoke his authority under 41.3(b) to decide the petitions in 09/401,939, and he did so promptly.

Finally, should there be an exception to the current rule precluding submission of evidence after appeal when that evidence addresses a point raised by the examiner after final? There are good reasons to limit new evidence upon appeal if that evidence could and should have been properly submitted earlier. However, it is not possible under current rules to submit evidence addressing a position of an examiner first raised after final or on appeal. In such situations, it is manifestly unfair and undermines administrative due process to preclude applicants from submitting relevant new evidence. In re Kronig, 539 F.2d 1300, 1303, 1976 CCPA LEXIS 140; 190 USPQ 425, \_\_\_ (CCPA 1976)(" Appellants urge that the ultimate criterion of whether a rejection is considered 'new' in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection. We agree with this general proposition, for otherwise appellants could be deprived of the administrative due process rights established by 37 CFR 1.196(b) of the Patent and Trademark Office."). Under current law, withdrawing an appeal generally results in a loss of patent term adjustment, and therefore withdrawing an appeal detrimentally affects the appellants rights. Withdrawing an appeal also

delays resolution of the appealed issues. Proceeding with the appeal without entry of relevant evidence reduces the chances of a just outcome. As a result, the current prohibition on submitting new evidence after final and during appeal in the circumstances noted herein above does not promote the policy underlying BPAI goals specified in 37 CFR 41.1 of a "just, speedy, and inexpensive resolution of every proceeding before the Board." The rules should therefore be revised to authorize appellants to rely upon evidence submitted for the first time in appeal briefs whenever that evidence contradicts a new interpretation by the examiner presented at or subsequent to final status.

ran

November 7, 2008 (11:35am)

C:\Documents and Settings\rneifeld\Local Settings\Temporary Internet

Files\OLK274\CanBPAIAppellantsNewlyCiteToDictionaryDefinitionsInAppealBriefs\_8-24-200

8 (3).wpd

1. I can be reached via our firm's web site [www.Neifeld.com](http://www.Neifeld.com).
2. Specific thanks to Harold Wegner for bringing to my attention the decision in In re Reexamination 90/006,707, 2008 Westlaw 2938366 (PTO Off. Deputy Comm'r 2008)(J. Love, Deputy Comm'r), identifying that a reply brief in 90/006,707 was refused entry because it relied upon a dictionary definition not entered into evidence prior to the appeal.
3. There are exceptions not relevant here. Rules 41.39 and 41.50 relate respectively to the applicant reopening prosecution in response to a reply brief and a remand by the panel. Those

exceptions are not relevant to the USPTO refusing to enter a brief containing dictionary definitions.

4. For inter partes reexamination appeals, rule 1.959 applies. However, all that rule 1.959 specifies is that the rules relating to ex parte appeals apply to appeals in inter partes reexaminations. Specifically, rule 1.959 states that:

§ 1.959 Appeal in inter partes reexamination. Appeals to the Board of Patent Appeals and Interferences under 35 U.S.C. 134(c) are conducted according to part 41 of this title. [Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para (f) added, 68 FR 70996, Dec. 22, 2003, effective Jan. 21, 2004; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004].

5. The revised version of 37 CFR 41.33(d) effective December 10, 2008 reads as follows:

(d) Evidence after notice of appeal and prior to appeal brief. Evidence filed after the date a notice of appeal is filed and prior to the date an appeal brief is filed may be admitted if: (1) The examiner determines that the evidence overcomes at least one rejection under appeal and does not necessitate any new ground of rejection, and (2) appellant shows good cause why the evidence was not earlier presented.