

***Withdraw claim from appeal proceeding  
Ex parte Ghuman***



*Vincent Fong  
EAGLE IP LIMITED  
Hong Kong  
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# Appeal

- Applicant can appeal to any twice rejected claim.
- Applicant may appeal to some of the claims instead of all the claims in the application.
- Appeals are handled by the Board of Patent Appeals and Interferences (BPAI)

# MPEP regarding withdrawing claim in appeal

- §1215.03 (Revision 7 of the 8<sup>th</sup> Edition, July 2008)
- “A withdrawal of the appeal as to some of the claims on appeal operates as an authorization to cancel those claims from the application or reexamination proceeding and the appeal continues as to the remaining claims. The withdrawn claims will be canceled from an application by direction of the examiner at the <sup>\*\*</sup>>time of the withdrawal of the appeal as to those claims. “

# Ex parte Ghuman

- Application on appeal: 10/709,045
- Claims 1-20 were rejected in the Final Office Action of July 26 2006
- Applicants filed a Notice of Appeal in Oct 2006, and filed an Appeal Brief in Dec 2006.

# Appeal

- In the Appeal Brief, the appellants stated that “Claims 1-4 are the subject of this appeal”
- The appellants only discussed and argued on Claims 1-4.
- The appellants did not expressly state that claims 5-20 are withdrawn.

# Decision of BPAI

- Since appellants have not appealed to claims 5-20 and have not argued on those claims. BPAI treat those claims as withdrawn.
- According to the MPEP, “withdrawal” of claims from appeal operates as authorization to cancel those claims.

# Decision of BPAI

- The Board cite another decision *Ex parte Letts* in support of its argument. In *Ex parte Letts*, the Board stated that "[i]f an Appellant wants an appeal withdrawn or dismissed as to a particular claim, the proper course of action is to file an amendment canceling the claim."

# Decision of BPAI

- The application was remanded to the Examiner so that the Examiner can cancel the claims 5-20. (May 1 2008)

# Remarks

- The concern about this decision is that the remand unnecessary slow down the appeal process.
- The speed of the appeal process is a growing concern, as the docket of BPAI has been growing in the last few years.

# Remarks

- According to Harold Wegner, the policy before Ghuman would allow the examiner to take care of the withdraw claims later without remand from the board.
- **Currently Policy:**
  - Referring to a FAQ published by BPAI, the examiner should enter the amendment to cancel the claims at the time of mailing of examiner's answer or before the mailing.  
[http://www.uspto.gov/web/offices/dcom/bpai/rule/faq\\_121008.html#F](http://www.uspto.gov/web/offices/dcom/bpai/rule/faq_121008.html#F)
  - Such clarification of the policy is not included in the current MPEP.