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Sent: Thursday, February 25, 2010 4:18 PM
To: BPAI Rules
Cc: BPAI.Roundtable; ksaunderscomm@msn.com
Subject: Request for Comments on Potential Modifications to Final Rules Re Practice before BPAI

The Honorable David Kappos
Under Secretary of Commerce for Intellectual Property
and Director, United States Patent and Trademark Office

Attn: Linda Horner, BPAI Rules/BPAI Gen. Topics

RE: --Docket No.: PTO-P-2009-0021
--Rules of Practice Before the Board of Patent Appeals and Interferences
in Ex Parte Appeals; Request for Comments on Potential Modifications to
Final Rule
--Roundtable Discussion
Proposed Rule §41.50

Dear Director Kappos:

These comments address proposed changes to Rule § 41.50:

<<**Current Rule**>>

§ 41.50 Decisions and other actions by the Board.

(a)(1)The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed. The Board may also remand an application to the examiner.

<<**Proposed Rule**>>

§ 41.50 Decisions and other actions by the Board.

(a) *Affirmance and reversal.* The Board may affirm or reverse an examiner's rejection in whole or in part.

Affirmance of a rejection of a claim constitutes a general affirmance of the decision of the examiner on that claim, except as to any rejection specifically reversed.

(b) *Remand.* The Chief Administrative Patent Judge may remand an application to the examiner. If in response to a remand for further consideration of a rejection, the examiner enters an examiner's answer, within two months the appellant shall exercise one of the following two options to avoid abandonment of the application or termination of a reexamination proceeding:

(1) First, there is no need to change the current rule. The explanation (at Federal Register, Vol. 74, No. 244, Page 67996, Central Column) for the proposed rule change is merely that "a large majority of remands from the

Board are administrative remands made under the direction of the Chief Administrative Patent Judge due to procedural defects in the application, rather than remands made by an assigned panel of Administrative Patent Judges on the merits." This rationale fails to even aver that there is a problem caused by the current rule.

(2) Second, a remand option is a valuable tool for an assigned panel of Administrative Patent Judges. It enables them to instruct an Examiner to focus on and correct an error or oversight. This promotes efficiency at the BPAI level because it can free Judges from spending time performing the responsibilities of an Examiner when they can merely instruct the Examiner to do so.

(3) Third, it provides an Examiner an opportunity to correct an error, remedy an oversight, or otherwise appropriately address some issue. As a former examiner, I would expect that an Examiner would appreciate a chance to address any issues that the Board identifies as warranting further, or even different, consideration. Moreover, efficiency may be promoted at the level of the Examining Corp because the individual most familiar with the intricacies of a case is given an opportunity to reconsider and address the issues on remand.

(4) Fourth, if the remand option is taken from panels of Administrative Patent Judges, the panel is then forced to "shoehorn" all scenarios into an artificially boolean pair of options--affirm or reverse. At times, the BPAI may not have all of the information to make a correct final decision. The third option, remand on the merits, provides an avenue for issues to be explored and remedied so that a proper patentability determination may be made.

In summary, the current remand option for panels of Administrative Patent Judges creates no problems, and the current Rule therefore does not need to be changed. Maintaining this remand on the merits option promotes efficiency at the BPAI and enables Examiners to fulfill their responsibilities for examination. Moreover, keeping the current remand option improves the likelihood that a correct patentability determination will ultimately be made, which is good for both individual applicants and the entire patent ecosystem.

These comments are submitted on my own behalf as an independent attorney and registered patent practitioner. The views expressed herein do not necessarily reflect those of any past, present, or future client, associated attorney, or affiliated law firm.

Sincerely,
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