

April 21, 2011

VIA EMAIL: [regulatory\\_review\\_comments@uspto.gov](mailto:regulatory_review_comments@uspto.gov)

Office of the General Counsel  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

ATTN: Nicolas Oettinger

RE: Request for Comments on Improving Regulation and Regulatory Review

Dear Mr. Oettinger:

The Patent Prosecution and IP Law Revision Committees of the Minnesota Intellectual Property Law Association (“MIPLA”) are grateful for the opportunity to submit comments in response to the Request for Comments on Improving Regulation and Regulatory Review, 76 Fed. Reg. 15891 (March 22, 2011) (“Request for Comments on Rules”).

The comments submitted here with reflect the views of the chairs of the MIPLA Patent Prosecution and IP Law Revision Committees (“the Committees”) and do not necessarily reflect the view or opinions of MIPLA or any of the individual members or firms of the committees or MIPLA, or any of their clients.

### **General Comments**

The members of our Committees include patent attorneys that are prosecuting a number of patent applications on behalf of clients in a variety of different art group units. Our collective experience is similar to the sense reflected in the Request for Comments on Rules, namely that the number and complexity of the numerous rules and regulations in the Patent and Trademark Office is so large as to be almost overwhelming. Our Committees applaud any effort by the Office to streamline and simplify the regulatory framework promulgated and used by the Office.

A joint meeting of the Committees discussed the five specific questions put forth in the Request for Comments on Rules, and chose to provide three overall comments instead of trying to formulate specific comments in response to these five questions. The three overall comments are as follows:

#### **1. Separate the MPEP into Examiner Guidelines and Applicant Rules.**

While the MPEP has evolved over many years into its current status as the definitive resource for both examiners and practitioners, it is also well understood that the MPEP lacks the force of law or rule in being considered for purposes of any review or appeal of a decision by the examining corps. This dichotomy between actual practice and true legal effect undermines the capability of the Office to effectively manage its regulatory framework.

Our suggestion would be to separate the MPEP into two different kinds of “regulatory” frameworks – a first PTO internal set of guidelines that would be used for the purpose of providing internal examination guidelines and regulations applicable for instructing and guiding Examiners in their jobs; and a second external set of Applicant rules that would have the legal effect of procedural rules formally promulgated by the Office, and upon which both Examiners and Applicants could rely, not only during examination at the Office, but also during review or appeal.

Even though the effort required to “split” the MPEP into these two different kinds of regulatory frameworks would be significant, the ultimate benefit for the efficiency and streamlined operation of the Office could also be significant. Moreover, with respect to the Applicant rules, it is suggested that the best practice and most efficient and proper process for engaging the public in both the establishment and implementation of regulations is the formal regulatory notice-and-comment rule promulgation procedures for procedural rules as authorized and permitted under 35 USC.

The intention behind this suggestion would be that rules could be split based on whether or not the given requirement/guideline was one that would be cited and relied upon in an Office Action as the basis for a rejection or objection to the application (an Applicant rule), or whether the requirement/guideline was one that would be used by the examining corps internally and would not be cited or relied upon in an Office Action (an Examiner guideline).

## **2. Separate Notices for Guidelines and Best Practices into Examiner Guidelines and Applicant Rules.**

As with the suggestion above for the MPEP, we would also recommend that a similar test and division of requirements/guidelines be adopted in place of the current practice of promulgating guidelines and best practices. It is often unclear whether the intention behind the promulgation of guidelines or best practices is to actually create a procedural rule that is meant to apply with the force of law, or whether the guidelines are, instead, meant only to allow applicants and practitioners to better understand how the Office is internally instructing its examining corps so as to, perhaps, better frame and present arguments and submissions.

## **3. Simplify and segregate the promulgated Rules.**

In many situations, there are multiple rules in completely different sections of 37 CFR that need to be considered in terms of complying with the rules. For example, page limits for briefs in *inter partes* reexamination require a practitioner to consult at least three different sections of 37 CFR in order to be in compliance. One key suggestion in this regard is to provide a framework where all of the rules for a particular portion of the practice are in one section of the CFR, e.g., filing rules in one section, prosecution rules in a second section, petition rules in a third section, appeals rules in a fourth section. Also, for procedures or proceedings that are less common (i.e., less than 10,000 proceedings in a fiscal year), all of the rules for these applicable to each of one of these kinds of less common proceedings (e.g., reissue, *ex parte* reexams, *inter partes*, reexams, interferences) should be set forth in a separate CFR section. By segregating the promulgated rules into a set of well-defined sections, it will be not only be easier for Examiners and practitioners to comply with those rules, it will be easier for the Office to promulgate rules on a section-by-section bases for notice and comment in order to solicit significant feedback from the community on the particular aspect of the rules.

The Chairs of the MIPLA Committee look forward to the opportunity to work with the Office in the future on specific proposals for simplifying the regulatory scheme for the Office. As with other rule packages, we would suggest that the Office hold roundtable events to collect further feedback from the applicant and practitioner communities on how best to achieve the worthy objectives of streamlining the regulatory schemes at the Office.

Sincerely,

/Brad Pedersen/

/Tim Bianchi/

/Ted Magee/

The Chairs of the MIPLA Committees