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To: BPAI Rules
Subject: Comments on Proposed BPAI Rules Modifications (37 CFR 41.37(r))

February 25, 2010

Director, United States Patent and Trademark Office:

I am a registered Patent Agent with over 17 years of experience, representing both large and small clients in a variety of areas of technology, in positions at law firms and within corporations.

I would like to express my concern over the proposed modifications to 37 CFR Part 41, Rules of Practice before the Board of Patent Appeals and Interferences in ex parte patent appeals.

In particular, the proposed changes to 37 CFR 41.37(r), which would modify the requirements for the "claims support and drawing analysis section" of the Appeal Brief, would be harmful to both appellants and the patent attorneys/agents who are their legal representatives. The proposed changes would require that the appellant must indicate after each claim limitation where, by page and line or paragraph numbers, the limitation is described in the specification as filed. The proposed changes will be costly and time consuming for applicants, and increase the risk of malpractice for patent attorneys/agents.

Support for claims is typically found throughout the specification (including claims and drawings), and the meaning of a particular claim term is best understood within the context of the full specification. Determining the scope and meaning of a claim term based upon a limited portion of the specification may limit or skew the meaning of the claim term. If appellants are required to identify specific, limited portions of the specification that support particular claim terms, they and/or their legal representatives will be forced to spend significant amounts of time reviewing the specification in order to identify which portions of the specification best convey the meaning of the claim term. However, this will require compromise, in that it is seldom the case that a limited portion of the specification fully conveys the intended meaning and scope of a claim term. Thus, appellants will be forced to make choices regarding what restrictions in claim meaning/scope are least likely to be harmful to them in the future. Such choices will likely be made only after lengthy (and hence costly) review and consultation with legal representatives. In making such a compromise, appellants will lose legal scope of coverage of their invention. Moreover, their legal representatives, in advising on such compromise, will be exposed to risk of committing malpractice.

Finally, I would like to point out that the costs associated with the proposed changes will be particularly burdensome for small companies and independent inventors, and will tend to prevent inventors from obtaining patent scope which is rightfully theirs and, ultimately, stifle innovation.

I believe that the requirements for ?claims support and drawing analysis section? should not be modified to further constrain the manner in which appellants indicate to the BPAI where and how claims are supported by the specification.

Respectfully Submitted,
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