

Horner, Linda

From: Mark R. Buscher [MRB@mg-ip.com]
Sent: Thursday, February 03, 2011 4:52 PM
To: BPAI Rules
Subject: Linda Horner, BPAI rules

Dear Ms Horner,

Regarding the proposed rulemaking set forth in Fed. Reg. Vol. 75, No. 219, Monday, Nov. 15, 2010, I wish to offer the following comments. I realize that these comments are being submitted beyond the published submission date of January 14, 2011. If the rulemaking and comments are still under review, I ask that these comments be admitted and considered anyway. If the process is substantially over, I understand that the comments may not be officially considered. In the hopes, however, that some good can come of them, I submit the following observations.

The proposed Bd.R. 41.37(c)(1)(v) requiring annotations "for each limitation in dispute by appellant" is unclear as to both intent and purpose. If there was a claim construction issue or a §112 rejection of the claim, then the "limitation in dispute" language would make sense. But this rule applies to all rejections. In the context of a §103 rejection, identifying the "limitation in dispute" can be unclear.

For example, consider a claim to a composition comprising A, B, C, and D. The primary reference shows A+B and a general description of additional things that can be added, including C. The secondary reference shows a composition of B + D. The Examiner asserts that combining the two teachings renders obvious A, B, C, and D. Applicant argues that the references cannot be combined (e.g., because of teaching away or incompatibility of the technology, etc.). Which claim limitation is disputed under the proposed rule?

- (a) Only D, because the primary reference is relied upon for A,B,C and D is the added element.
- (b) Only C, because the art doesn't explicitly show C.
- (c) C and D, because one is a genus-species issue and the other is a combining issue.
- (d) None, because none of the limitations are disputed: their meaning is understood by applicant and attorney.

I think (d) is the best answer. The issue in dispute is the claimed combination as a whole, not a single limitation. In this common fact pattern of whether the combination of elements would have been obvious, even though each individual element is known, no single limitation is in dispute. When adding D to ABC, which limitation is in dispute: A,B&C or D? Alternatively, if each of the limitations A-D in this fact pattern are in "dispute," then the limiting of annotations to only "disputed" limitations is only an apparent, indeed, deceptive, curtailing of the annotation requirement. In most case, then, all limitations will be annotated. Clarification in the rule or the comments regarding the meaning of "disputed" is needed.

It would also be helpful to practitioners to understand the goal of this section of the brief. In the past, the purpose was to familiarize the APJ with the claimed subject matter and insure that proper support in the specification existed. If that is still the goal, then why annotate only the "disputed" limitations? Why not annotate the whole claim? On the other side, is any of this annotation actually helpful to the board? If the specification puts a certain gloss or context on a claim term, isn't that explanation and citation to the specification and figures better left to the argument portion of the brief? Then the APJ can see the issue in context.

I am in favor of making it easier for the APJ. If annotating helps them, though I don't see why, then I am in favor of annotating every claimed element. If it does no real service, then I am in favor of skipping the annotation. The currently proposed middle ground of annotating "disputed" limitations seems unanchored to any goal or benefit (and suffers from the ambiguity of defining "disputed" as mentioned above). An explanation of the goal/benefit sought by annotation and why it helps APJ's would be

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helpful to practitioners.

I hope you can consider my comments. For the record, I am a registered patent attorney. These comments reflect my own personal views and not necessarily those of my firm or any clients.

Respectfully submitted,

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