

Horner, Linda

From: Kurt Grossman [KGROSSMAN@whepatent.com]
Sent: Tuesday, November 30, 2010 5:37 PM
To: BPAI Rules
Subject: Proposed Appeal Rules (75 FR 69,828 (November 15, 2010))

Mail Stop Interference
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
Attn: Linda Horner, BPAI Rules

Re: Proposed Rules of Practice Before the Board of Patent Appeals and Interferences
in Ex Parte Appeals (75 FR 69,828 (November 15, 2010))

Dear Ms. Horner:

I am writing in regard to the above-mentioned Proposed Rules. Please note that the comments set out herein are expressions of my own view and do not necessarily reflect the views or opinions of any firm or client with which I am, or may be, associated or representing.

Let me start first with joining in the ever-growing roar of appreciation to the Office for its efforts to improve the patent process. The Proposed Rules appear to continue that laudable effort. While perhaps relatively minor areas, I do have three areas I would like to address in the Proposed Rules for whatever constructive value my comments might have.

1. Citation of Authority (75 FR at 69,830): The current and Proposed Rules apparently encourage inclusion of authority if not available in the United States Reports or the West Reporter System. It is respectfully submitted that the list should also include the United States Patent Quarterly. Indeed, the Office acknowledges that Administrative Patent Judges have ready access to that reporter system as well. 75 FR at 69,830.

2. Appeal Brief – Content of Appeal Brief – Claims Appendix (75 FR 69,836): The Proposed Rules propose to delete Bd.R. 41.37(c)(1)(viii), as a result of which a Claims Appendix will no longer be included in the Appeal Brief. While it is recognized that the Appeal Brief will now refer to the last Response containing the claims as presented on appeal, the lack of the Claims Appendix presents an unnecessary burden on others who examine the file. To that end, anyone examining the file will have to first find in the Appeal Brief where the reference is to the last Response containing the claims, and then have to locate that Response and the claims thereof. With the IFW system, that can become burdensome to the public. By contrast, including the Claims Appendix is a simple effort for Applicants and makes it easy for the public (and the Board) to quickly note the claims as on appeal. Indeed, since the Applicant is already expected to note the last Response where the claims may be seen, the Applicant need merely cut and paste the correct claims into the Claims Appendix, which is thus not considered to be a burden to Applicants. But at the same time, the public can go directly to the Appeal Brief to see the claims, without having to search through the file.

3. Power of the Board to Suggest Allowable Claim Amendments (75 FR 69,842): Proposed Bd.R. 41.50(c) proposes to eliminate the current ability of the Board to suggest how a claim may be amended to overcome a rejection. While this power was rarely used (if at all), it is submitted that the power should be encourage rather than further diminished. The Board is charged with being the final point of review within the

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Office in regard to rejections against the claims. As a consequence, just as the Examiners are encouraged to work with Applicants to achieve allowable claims (again, a practice that should be encouraged, even though rarely used or so it seems), the Board should be permitted to do so as well, especially given that the Board decision ostensibly reflects the thinking of not just one but three experienced Examiners.

Very Truly Yours,

Kurt L. Grossman, Esq.
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