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To: BPAI Rules

Subject: Comments on Proposed Rule Making

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37 CFR Parts 1 and 41

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Preface

In the interest of diligent compact prosecution the following comments are submitted herewith. Additionally submitted are suggested changes.

1) Subject:

Presumption that appeal is taken as to all claims unless cancelled by an applicant's amendment.

Problem:

After an appeal brief is filed it is quite common[†] for the Examiner to yank the application back into prosecution. Cancellation of claims for an appeal allows the Examiner to take advantage of the cancelled claims as the application is yanked back now with fewer claims to examine. This puts the Appellant at a disadvantage because they were cancelled only with respect to the Appeal, not examination.

Solution:

Claims declared explicitly cancelled for purposes of the Appeal would be automatically uncancelled and reinstated for examination upon the Examiner yanking the application back into prosecution.

[†] N.B. The estimate for applications yanked back into prosecution after an appeal brief is filed is 34% based on this Appellant's expertise in patent prosecution practice.

2) Subject:

As to when jurisdiction should pass to the Board.

Problem:

As it currently stands jurisdiction does not pass at the time of filing of the notice of appeal for the stated reason "would foreclose the opportunity for the examiner, upon reviewing the appeal brief, to find some or all of the appealed claims patentable prior to the Board taking jurisdiction ...".

This is a bogus argument and allows the Examiner to not do their job till the brief is filed. That is, they are given a second bite at the apple. The Examiner should have done their job earlier and should stand by their decision.

1/18/2011

Solution:

Jurisdiction should pass to the Board upon notice of appeal. In the rare case[†] when claims are found to be allowable by the Examiner, they can be denoted as such in the Examiner's answer.

[†] N.B. The estimate for allowed claims after a brief is filed is 0% based on this Appellant's expertise in patent prosecution practice.

3) Subject:

Treat as waived any arguments not raised by appellant.

Problem:

There is not parity for the Appellant and so the burden of proof is stilted.

Solution:

Any argument presented by Appellant and not addressed by the Examiner in the answer will be treated as waived by the Board.

4) Subject:

New grounds of rejection in the Examiner's answer.

Problem:

- a) As evidenced by the proposed rules, the extensive proposed definitions, designations, exceptions, appeal grounds, many examples, etc. - this is a quagmire.
- b) It invites the Examiner to not do diligent prosecution by not pointing out with specificity and particularity where the claim limitations may be found and instead trying to shift the burden from "shall be allowed a patent unless.." to the every increasingly popular approach of "the Examiner has cited some sections of the reference, however the Applicant is expected to view the entire reference" – basically shifting the legal burden to the Applicant to hunt through the reference and prove the patentability of the invention

Solution:

"New ground" shall be defined as a prior art reference which first became publicly available AFTER the date of the latest office action from which the appeal is taken.

This establishes a very bright line rule that is easily followed by all and addresses the real issue of really "new" available art that pops up from a previously secret patent application, etc.

It also avoids the prevalent abuse[†] of the case where the Examiner cites "new" art that in fact is old and was publicly available at the time of the examination and was simply not cited. It avoids endless abuse of this approach and will prevent the Examiner from using it as a pocket veto.

[†] N.B. The estimate for this approach of "old" art being cited as "new" is 92% based on this Appellant's expertise in patent prosecution practice.

5) Subject:

Time periods for responses, reply brief, etc.

Problem:

There is a huge disparity between the requirements for the Appellant and the Examiner/Board. In the interest of compact prosecution the USPTO basically requires a reply within 2 months. This would be fine IF the USPTO also had to respond within 2 months. Rather what we have is a situation where the Examiner and/or Board may take years to issue an answer or decision and the Appellant is expected to respond in 2 months. I'm sure part of the rationale is that the USPTO is very busy, well I have news for you, Appellant is also very busy. Additionally while the USPTO is only concerned with rejections/decisions and has

specialists in every area and has an examiner's union to fight for more resources, Appellants have no such massive support or specialization and so in the scheme of things is at a greater disadvantage and so should have more time to respond.

Solution:

However long it takes from the time a brief is filed till an answer is received shall be such length of time as Appellant has to file a reply brief.

However long it takes from the time a reply brief is filed till a board decision is received shall be such length of time as Appellant has to file a request for rehearing.

6) Subject:

Board's power to suggest how a claim may be amended to overcome a rejection.

Problem:

Why is suggesting a problem? It does not commit anyone to anything and provides an opportunity for the Board to explain the specific rationale of why the claim was rejected.

Solution:

Allow the Board to comment on how they believe a claim may overcome a rejection since it does not commit anyone to anything.

7) Subject:

Ex parte Ghuman

Problem:

Indirect reference is made to appeals, references, etc. with the Office admitting projecting based on "these numbers may not represent a precise indication ...".

Solution:

The Office has access to all the appeals and file wrappers and can easily ascertain such things as the number of appeals in which Appellants chose not to appeal all claims[†].

[†] N.B. The estimate for not appealing all claims is 35% based on this Appellant's expertise in patent prosecution practice which is worlds apart from the Office's projection of 1%.

8) Subject:

Administrative Procedure Act

Problem:

This attorney takes issue with the statement that the changes are solely related to procedure. Procedure can have, as here, adverse effects on the legal rights. For example, the Office could declare that time frames to respond are purely procedural and then set a time limit to reply to an examiner's answer at 1 second after the answer is issued.

Solution:

ANY time any rule, code, or case is mentioned (e.g. CFR, USC, legal case) the presumption should be that it is affecting substantive legal rights.

It is respectfully submitted that the discussion above and the proposed solutions will streamline the rules, improve clarity, reduce appeal pendency, and lead to the appeal proceeding expeditiously and efficiently

and with fairness to all.

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