

---

**OLIFF & BERRIDGE, PLC**

---

ATTORNEYS AT LAW

January 11, 2011

277 SOUTH WASHINGTON STREET  
ALEXANDRIA, VIRGINIA 22314TELEPHONE: (703) 836-6400  
FACSIMILE: (703) 836-2787  
E-MAIL: EMAIL@OLIFF.COM  
WWW.OLIFF.COM

Mail Stop Interference  
Director Of The United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attention: Linda Horner, BPAI Rules

Re: Comments Regarding Proposed Changes To The Rules Of Practice Before  
The Board of Patent Appeals And Interferences (BPAI) In *Ex Parte* Appeals

Dear Ms. Horner:

Set forth below are our comments regarding the proposed changes to the rules of practice before the Board of Patent Appeals and Interferences (BPAI) in *Ex Parte* Appeals.

Oloff & Berridge, PLC is a nationwide law firm specializing in intellectual property matters. Its patent practice serves corporations and individuals from every industrialized nation and has prosecuted thousands of matters before the United States Patent and Trademark Office (USPTO), including scores of appeals to the Board of Patent Appeals and Interferences. Its practice before the USPTO provides a perspective and depth of experience necessary to provide the following comments regarding the proposed changes to the rules.

We applaud and support the USPTO's efforts to improve efficiency of the appeal process, and further applaud the improvements made in the previously proposed rules governing practice before the Board of Patent Appeals and Interferences (Board). However, as discussed below, we believe that additional revisions to the proposed rules are necessary for clarity and efficiency.

Our concerns, as well as recommendations for addressing those concerns, are further detailed below.

1. **Proposed Bd.R. 41.37(c)(1)(v) (Claim Annotations)**

Proposed Bd.R. 41.37(c)(1)(v) proposes to revise the current rule to require Applicants to provide an annotated copy of each rejected independent claim, annotating each "limitation in dispute" showing support for the claim language "sufficient for the Board to understand the claim."

**A. The Proposed Rule Is Unclear And Will Lead To Difficulties In Practice**

Neither the proposed rule nor the commentary defines what a "limitation in dispute" encompasses. The lack of clarity regarding what constitutes a limitation in dispute may lead to confusion when Applicants attempt to annotate the claims, and may result in Appeal Briefs being found non-compliant and/or result in Appeal Briefs that do not enhance the Board's understanding of the claims or actual issues in the appeal.

For example, without a clear definition, an Applicant may provide annotations for claim limitations that are not in dispute, thereby creating inefficiencies for the Applicant (spending time unnecessarily annotating limitations not in dispute) and for the Board (having to review annotations for limitations not in dispute). Further, an Applicant may unknowingly leave out an annotation for a claim limitation that is thought not to be in dispute, but later alleged by the Examiner to be in dispute, thereby causing the Appeal Brief to be less useful for the Board, and/or rejected as non-compliant.

An illustrative example shows the problems that may arise with the proposed rule. Where the issue is focused on a primary or secondary reference being non-analogous, what is the limitation in dispute that must be annotated? Should the claim as a whole be annotated as it defines the context of the relevant field? If so, the annotations would be extensive and not informative of the issue regarding why the art is non-analogous. Does the Applicant instead provide no annotation, possibly resulting in the Appeal Brief being found non-compliant?

Numerous additional situations can be envisioned where the proposed rule is similarly problematic in practice, such as when the appeal focuses on secondary considerations issues.

The foregoing demonstrates the problems that will arise over the proposed rule's lack of clarity.

**B. The Requirement For Annotations Should Be Removed**

In view of the above, we propose that the requirement to annotate "limitations in dispute" be removed entirely as it is unclear, poses an unnecessary burden to an Applicant and is unnecessary for the Board because better alternatives exist for providing the Board with an understanding of the claims and issues.

The claims must be construed in light of the entire specification, and not based solely on annotations providing a "concise explanation" or annotations regarding "limitations in dispute." The Board needs to understand the whole claim, and not just "limitations in dispute." Annotating only "limitations in dispute" may thus be detrimental to an understanding of the claims by improperly narrowly focusing on a limitation instead of providing an understanding of the claim as a whole.

Further, later litigants over the patent are likely to argue that the annotation limited the claims, for example by "disclaiming" portions of the specification not referenced in the annotation, even though the annotation was provided to assist the Board's understanding (and was not otherwise intended to be limiting).

Rather than providing claim annotations, the present rule requiring a summary of the claimed subject matter as a whole with reference to the specification and drawings, which may include showing an example of what is being claimed, should be retained. This would provide the Board with improved understanding of the claims, including any issues involving specific claim language. By utilizing the summary of claimed subject matter with reference to the specification and drawings, an Applicant is also relieved of the burden of annotating claims.

**C. If Retained, The Rule Should Be Revised For Clarity And To Indicate The Non-Limiting Nature Of Any Annotation**

If a requirement to annotate claims is maintained, the rule should be revised to (1) provide further guidance as to what is a "limitation in dispute", (2) specifically state that any included annotation is solely for the understanding of the Board, and is exemplary and non-limiting, and (3) clarify that where issues on appeal do not involve a specific limitation in dispute, no annotation is required.

Absent such revisions, it is likely that an Applicant will over-annotate, referencing all occurrences of claim limitations in the specification in order to avoid a limiting construction. This would go far beyond the requirement for understanding by the Board, create inefficiencies, and likely hinder the Board's ability to readily understand the claims. Without revision, the proposed rule will not have its intended effect of providing the Board with an efficient way to understand the claims without review of the entire specification.

**2. Bd.R. 41.41(b)(2) (Reply Brief)**

Proposed Bd.R. 41.41(b)(2) would limit Reply Briefs to addressing only arguments raised in the Examiner's Answer, including any designated new ground of rejection. Arguments included in a Reply Brief that do not meet these criteria will not be considered by the Board, unless good cause is shown.

**A. The Proposed Rule Is Overly Restrictive And Burdensome**

The proposed Rule is overly restrictive and burdensome on an Applicant. During examination, Examiners are under strict time constraints, and often put forth rejections that are incomplete or not fully developed. It is common that not until the Examiner's Answer, where the Examiner is under heightened review and has additional Examiners involved in the review process, is the rejection fully/clearly set forth and the full basis of the rejection becomes clear. In

this regard, the Examiner may essentially re-word the rejection in the Examiner's Answer, but maintain the "same" rejection by still relying upon the same prior art. In other words, the Examiner may re-word the rejection in the Examiner's Answer in such a way that it provides a new understanding of the rejection to an Applicant without setting forth any "new" arguments. Under the proposed Rule, the Applicant is unfairly foreclosed from putting forth additional arguments in the Reply Brief. Such re-wording of a rejection should give rise to the ability to provide further remarks in a responsive Reply Brief.

The proposed Rule holds an Applicant to a different, and more restrictive, standard than that to which the Examiner is held for the Examiner's Answer, which puts both the Applicant (and the Board) at a disadvantage.

Artificially limiting an Applicant's arguments during appeal to only those in the Appeal Brief (or held to be responsive to a new ground of rejection in the Examiner's Answer) diminishes the appeal process by restricting the information the Board has to inform its decision. An Applicant should be allowed to fully argue the issues on appeal, including being able to include arguments in a Reply Brief that are developed based upon a new understanding of the rejection gleaned from new language in the Examiner's Answer. This will also ensure that the Board has the best-developed record upon which to base its decision, and encourages Examiners to be clear and complete in their final rejections. The proposed Rule thus unfairly restricts the record without providing efficiencies to the process.

To the extent it is believed that the right to petition (under Rule 1.181) to have the Examiner's arguments in the Examiner's Answer characterized as a new ground of rejection offsets concerns over the proposed Rule, we strongly disagree. Having to petition in order to be able to include additional arguments adds unnecessary cost and delay to the already expensive and lengthy appeal process. Petitioning also creates additional work and inefficiencies within the Patent Office in having to review and render a decision on such petitions (and possible re-petitions/requests for reconsideration).

Moreover, if the petition is denied, then there is no recourse for the Applicant, forcing the Applicant to decide between proceeding with the current appeal with an underdeveloped record or restarting prosecution via a Request for Continued Examination or continuation application (which wastes all of the sunk costs and fees in the present application and adds the additional costs and fees for restarting prosecution, along with extending pendency). Although such a penalty may be appropriate in a situation where an Applicant has submitted an incomplete Appeal Brief, this penalty unfairly affects the large number of Applicants who are faced with unclear/incomplete Final Rejections, and need to provide remarks in response to a reworded (and more clear) Examiner's Answer.

It is also unclear if arguments in response to a reworded rejection in an Examiner's Answer would be permitted as falling within the "good cause" requirement of the proposed Rule.

Regardless, an Applicant should not be required to undertake additional expense of establishing that good cause for arguments exists when they are directed to re-worded Examiner positions, as this adds needless costs to the appeal process, adds uncertainty as to whether arguments that should be permitted will be allowed, and adds delay for the good cause issue to be decided.

**B. A More Focused Rule Would Address Concerns And Ensure A Complete Record**

If the concern sought to be addressed by the proposed rule is completion/finality of the briefing process, this can be addressed with a more focused rule. For example, the Appeal process would be improved by allowing an Applicant to present responses to all arguments appearing in the Examiner's Answer that do not appear *in haec verbae* in the Final Rejection. This would still allow the Applicant to make necessary arguments without the burden of having to be based on "new" arguments in an Examiner's Answer, but allow an applicant the ability to respond to any re-worded rejections.

If the concern is that an Applicant may "hold out" on presenting arguments in the Appeal Brief to present the arguments in the Reply Brief (for example, to avoid the Examiner potentially addressing the arguments in the Examiner's Answer), the above suggestion also addresses this concern. An Applicant who may otherwise attempt to "hold out" on presenting arguments in the Appeal Brief would risk not being able to present the arguments at all if the Examiner does not re-word the rejection. It is unlikely that an Applicant would thus "hold out" on presenting all available arguments in the Appeal Brief.

Thus, the proposed rule should be revised to allow a complete response by an Applicant in the Reply Brief. This would improve the record and allow the Board to have a complete understanding of all the issues/arguments for decision.

**3. Bd.R. 41.40(b) Rehearing And Tolling Of Time For Reply Brief**

Proposed Bd.R. 41.40(b) proposes that an Applicant would be required to file a Reply Brief within two months from the date of a decision refusing to grant a Rule 1.181 petition requesting review of the Examiner's failure to designate a rejection as a new ground of rejection.

**A. The Rule Is Unclear In Relation To Tolling Of Time When Re-Petitioning**

The proposed rule is silent regarding the possibility of re-petitioning/requesting reconsideration of the decision, and the time period for filing a Reply Brief if an Applicant re-petitions or requests reconsideration under Rule 1.181.

In the case of a re-petition/request for reconsideration, is an Applicant still bound to file a Reply Brief within two months of the decision refusing to grant the original Rule 1.181 petition?

Or, if an Applicant re-petitions/requests reconsideration of the decision refusing the grant of the original Rule 1.181 petition, is the time period still tolled to file a Reply Brief and reset upon a decision on the repetition?

**B. The Proposed Rule Should Be Clarified**

The proposed rule should be revised/clarified to indicate that the time period to file a Reply Brief continues to be tolled during any pendency of a timely re-petition or request for reconsideration under Rule 1.181.

\* \* \* \* \*

We would support the proposed changes to the rules of practice before the BPAI in *Ex Parte* Appeals if modified as detailed above.

Respectfully Submitted,



Christopher W. Brown

CWB:ABW/rav