

Horner, Linda

From: lawrence pope [lawrences2005@yahoo.com]

Sent: Sunday, November 21, 2010 10:24 AM

To: BPAI Rules

Cc: cbullard@oblon.com

Subject: Comments on 15 November Proposed Rules

The USPTO is to be congratulated on an excellent and very carefully thought out proposal. I find it to be an outstanding balance of the competing interests inherent in any set of procedural rules. I do, however, have the following specific comments:

- In 41.12 while no reporter is required it would be more balanced and avoid favoring any vendor to also mention USPQ and Lexis as widely used law sources. You might also consider mentioning Pacer for cases so new they not made it into an official reporter.
- In 41.30 the formal definition of "Record" is a fine idea but it does not address the file wrappers of older cases, particularly in the ex parte Reexamination context, for which no Image File Wrapper exists.
- In 41.31(b) I suggest a more specific reference to 1.33**(b)** as that is the portion of 1.33 which refers to signatures.
- In 41.31(c) I suggest that consideration be given to dealing more extensively with situations in which petitions under 1.181 are outstanding when an appeal is filed.
 - Perhaps a provision could be made for the Chief Judge to decide whether the appeal can proceed despite the outstanding petition or petitions.
 - In addition perhaps a procedure for expediting decisions on petition could be put in place in those cases in which the Chief Judge has determined that a decision is needed for the appeal to proceed.
- In 41.35(b)(5) I suggest that jurisdiction only end if **all** the claims on appeal are covered by a required action under 41.39(b) or 41.50(b). Otherwise why shouldn't the appeal be continued as to claims not covered by the new grounds of rejection? Why not follow the excellent idea of a default assumption in this context and just assume that the appellant just wants to proceed on his other appealed claims and abandon just the ones subject to the new grounds of rejection. That would be the same approach as is taken when the rejection of **some** claims is not dealt with in the Appeal Brief.
- In 41.37(c)(ii) I suggest using "controlled by" as opposed to "owned" and "the real party in interest" as opposed to the "appellant or assignee":
 - The holder of record title in a patent or application may have only a very minor legal interest as in the case of an exclusive license with minimal obligations back to the owner and control of the defense of the patent or prosecution of the application in the hands of the exclusive licensee.
 - The formal appellant may be an exclusive licensor with minimal legal interests no right to influence or control the handling of the appeal.
 - The assignee of an application or patent involved in an appeal may not even know an appeal is in progress depending upon his retained interest even though he may know of related cases in which he has a greater interest.
- In 41.37(c) while I agree with imposing fewer requirements on Pro Se appellants I question exempting them from complying with (iv) calling for the date of the last amendment filed. No one should be pursuing an appeal if they are not familiar with the file of the case.
- In 41.37(c)(v) I suggest clarifying that an annotation for dependent claims which are argued separately is required. The current language could be read that dependent claims need only be annotated if they are **both** argued separately and have means or step plus function language.
- In 41.37(d) why not incorporate the current procedure of having the Chief Judge or his designee review the Appeal Brief for compliance into the rule instead of just having it as a FR Notice?
- In 41.40(b) I question dismissing the entire appeal if the new grounds for rejection don't cover all the claims on appeal. It would be a little odd to petition to have a rejection designated a new grounds of rejection and then not to pursue the reopened prosecution with a proper reply but why couldn't the appeal just proceed. The appellant could just treat the newly designated new grounds of rejection in his Reply Brief. If he failed to do that the appeal would be terminated as to those claims but would continue as to any other appealed claims. It seems inconsistent with the general trend of this rules proposal which streamlines procedures to require a formal reply to reopened prosecution. If during the pendency of the petition for designation the appellant decides not to submit an amendment or new evidence why couldn't such a decision be the default assumption?

1/18/2011

- In 41.41(a) I suggest it be "...within **the later of** two months...". In addition if 41.40(b) is modified as I have suggested a reply brief could also be required in instead of a response to reopened prosecution on the date when a reply under 1.111 was required.

Lawrence Pope
Patent Attorney
Office 414-727-8516