

## Horner, Linda

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**From:** john@rogitz.com  
**Sent:** Friday, November 19, 2010 4:46 PM  
**To:** BPAI Rules  
**Subject:** Comment on proposed rulemaking regarding Ex Parte Appeals

The proposed new rules are a significant step forward from the ANPRM in terms of simplifying and clarifying the appellate process. Experience has shown that further clarification of PTO conduct after reversal is indicated.

Specifically, Rule 198 permits reopening of prosecution after a Board decision has become final provided "sufficient cause" is shown. MPEP 1214.04 appears to clarify this by advising that the examiner should "never regard a complete reversal as a challenge to make a new search to uncover other and better references", but should submit the application to the TCD for reopening only if the examiner has "specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed". In other words, the MPEP appears to amplify Rule 198 that the requisite "sufficient cause" must not be bootstrapped from a new search embarked on prior to receiving TCD approval.

Experience has shown that the above understanding is not universal. First, when a reversed application is reopened, it is rare for the TCD to explain what the relied-on sufficient cause was, other than to simply countersign the new office action. Second and more importantly, it is plain from the file histories of reopened cases that searches were in fact performed and the dates of those searches preceded likely TCD involvement. In other words, that the (unstated) "sufficient cause" is indeed one or more new references bootstrapped from a "hunch" search.

When confronted with the above language from the MPEP, experience has shown that examiners believe that the literal language does not prohibit a new search to bootstrap sufficient cause to reopen. Rather, examiners (and attorneys in the Solicitor's office with whom this has been discussed) believe that they are merely prohibited from subjectively feeling "challenged" to perform such a search. And indeed, when the above language from the MPEP is read literally without regard to its spirit, they are correct.

Accordingly, it is proposed that (1) the rules or the MPEP be amended to require TCDs approving reopening state for the record what the sufficient cause is as opposed to merely signing the examiner's office action, to serve the public notice function; (2) the rules or the MPEP be amended to explicitly state whether good cause may be bootstrapped from a new search, perhaps by explicitly stating that a new search may be made after reversal, if that is the intent of the PTO, or if it not, by changing "never regard a complete reversal as a challenge to make a new search" to "never conduct a new search unless sufficient cause to reopen along with the specific evidence relied on for that cause is articulated on the record by the TCD prior to the search", or equivalent; and (3) whether a partial reversal is to be treated the same as a complete reversal for purposes of allowing or not a new search.

With kind regards, John L. Rogitz  
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