

Horner, Linda

From: Louis Ventre, Jr. [lventre@lventre.com]
Sent: Thursday, December 16, 2010 12:37 PM
To: BPAI Rules
Subject: Comments on Proposed Rule Changes - BPAI

Dear Director of the United States Patent and Trademark Office,

Comments on Proposed Rulemaking

37 CFR Parts 1 and 41

[No. PTO-P-2009-0021]

RIN 0651-AC37

Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals

75 Federal Register 69828, 15-NOV-2010

I compliment the USPTO on a practical and welcome set of revisions to the appeal rules.

I recommend that the USPTO also consider expanding the scope of BPAI authority to "allow" claims of an application or permit the decision to direct an examiner to pass an application to issuance. Currently, the Board's primary role is to review adverse decisions of examiners including the findings and conclusions made by the examiner. See 37 C.F.R. § 41.50(a)(1) ("The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner"). Having this expanded authority would simplify the follow-up processes after an appeal board reversal of the examiner, would eliminate red tape, and would result in a faster disposition of the application for the benefit of the applicant. The BPAI already has discretion to act as a de facto examiner to enter a new ground of rejection of a claim. 37 C.F.R. § 41.50(b). So adding this authority would simply be an implementation of the board's decision to reverse the examiner.

Sincerely,

Louis Ventre, Jr.
Registered Patent Attorney
2483 Oakton Hills Dr.
Oakton, VA 22124-1530

Telephone: 703-242-1247
email: lventre@lventre.com