

Horner, Linda

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To: BPAI Rules
Subject: Appeal Procedure

1. The statistics provided on pre-appeal brief review mask a glaring problem; viz. how many applications have gone through the review, an (unidentified) issue for appeal found, a brief filed, and *then* prosecution reopened. This was the actual sequence of events in one, and only, attempt at using the pre-appeal brief review.

- a. The clear implication of this experience is that the pre-appeal brief review is a joke.
- b. The pre-appeal brief review does not identify/reduce the issues for appeal, causing appellants to waste time briefing all rejections.

2. From personal experience: in the last five years, twenty-four briefs were filed, including a second brief in six applications when prosecution had been reopened after the first brief was filed. Of the twenty-four briefs, ten applications actually went to the Board of Appeals for decision and three applications were allowed in the next Office Action. The eighteen applications in this group received a total of sixty-eight Office Actions, *not* including restrictions. In one application, after a brief was filed, prosecution was reopened to make a restriction requirement. The claims on appeal were the originally filed claims.

- a. This is inefficient, low quality examination.
- b. Obliging the Board to hunt through what can be a voluminous record is not proper. Briefs should be reasonably self-contained.

3. There is no consequence for examiners who make rejections that they do not want to have see the light of day. Once a brief is filed, an examiner should not be allowed to reopen prosecution without the approval of the Group Director.

4. The USPTO should not charge any fees for appeals that do not go to the Board for a decision. The USPTO is taking money under false pretenses.

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