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Attention Linda Horner, BPAI Rules:

Comments of IBM Corporation to Notice of Proposed Rule Making "*Rules of Practice before the Board of Patent Appeals and Interferences in Ex Parte Appeals*", 75 Fed. Reg. 69828 (November 15, 2010)

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## **Introduction**

IBM supports the efforts of the United States Patent and Trademark Office (USPTO) to improve the patent appeal process to avoid unnecessary burden on appellant, the examiner and the Board, and ensure that patents meet statutory requirements. IBM supports the vast majority of the proposed Rules, but recommends the following changes and clarifications.

### **Proposed Rule 41.37(c)(1)(iii) – Status of Claims (Omitted)**

*The proposed rule "omits the requirement for the appeal brief to contain an indication of the status of claims" "to avoid undue burden on appellants or examiners". "The Board will presume that the appeal is taken from the rejection of all claims under rejection unless cancelled by an applicant's amendment." Pages 69828, 69834 and 69847.*

IBM supports this proposed rule change except that appellant should be allowed to cancel a claim **in the appeal brief itself**. Cancellation of a claim does not require justification or examination, and entry would be a simple administrative task by the USPTO. This would save applicant the burden of filing a formal amendment to cancel the claim. Also, under the proposed rule, if an amendment of this type is filed shortly before or on the day of

filing the appeal brief, after appellant fully analyses its position, appellant would not then be able to state in the appeal brief (as required) that this amendment “has been entered”, because of the processing time in the USPTO.

### **Proposed Rule 41.37(c)(1)(v) – Summary of Claimed Subject Matter**

*The proposed rule provides, in part,*

*“Summary of claimed subject matter. An annotated copy of each of the rejected independent claims, which shall, for each limitation **in dispute by appellant**, immediately after each such limitation, refer to the specification in the Record by page and line or by paragraph number, and to the drawing, if any, by reference characters, **sufficient to understand the claim**. ... for every means plus function and step plus function recitation **in dispute by appellant**, the structure, material, or acts described in the specification in the Record as corresponding to each claimed function with reference to the specification in the Record by page and line number or by paragraph number, and to the drawing, if any, by reference characters.*  
(emphasis added) Pages 69834 and 69847

According to the proposed rule, appellant need only provide the annotation for the claim elements “in dispute”. While this proposal would reduce the burden on appellants, it should be more comprehensive and requires clarification, as follows. The terminology “in dispute” is ambiguous. Does “in dispute” mean that the examiner and appellant dispute the interpretation of the claim element, or that the examiner and appellant dispute whether the claim element distinguishes over the prior art? In any event, the elements of a claim are typically dependent on each other for meaning, environment and/or perspective, and a claim element cannot be understood standing alone. Therefore, all elements of the independent claims should include the annotation.

Also, the proposed standard for the annotation, i.e. “sufficient to allow the Board to understand the claim” is vague and subjective in that it depends on the abilities of the Board members, which abilities have not been specified and depend on the specific Board members assigned to each appeal. It would be clearer and more informative to use a more objective standard such as

*“A concise explanation of support from the specification for each of the independent claims involved in the appeal, sufficient to identify*

*principal elements of the implementation, which shall refer to the specification by page and line number, and to the drawings, if any, by reference characters."*

The terms "support" and "principal elements" are determinable by objective standards. Appellants would **not** be required to identify all requisite support for the independent claims sufficient to satisfy 35 USC 112, first paragraph, and appellant's identification of the principal elements alone would not serve as the test for satisfaction of 35 USC 112, first paragraph. Nevertheless, the identification of the principal elements would assist the examiner should the examiner decide to check the claims for satisfaction of 35 USC 112, first paragraph. This issue was not likely resolved in the prior examination because there is not a requirement for applicant to state support for all claim elements, and the length of a specification and time constraints of the examination often impede the examiner from independently making this investigation. Also, in an amendment, applicant may stray from the originally claimed invention increasing the chance that the amended claims lack sufficient support. Appellant is thoroughly familiar with its own specification, and can identify in the appeal brief the principal elements of the implementation for the independent claims with minimal burden, as many practitioners currently do.

The proposed rule also does not require appellant to state in the appeal brief the corresponding structure for all means plus function elements in the independent claims and those dependent claims argued separately. Identification of the corresponding structure of the "means plus function" elements is very important for the examiner, the Board and the general public to understand the meaning and scope of such claims, and was not likely done earlier in the prosecution. Therefore, appellant should state the corresponding structure for all "means plus function" elements in each independent claim and dependent claim argued separately (as is the current rule). In addition, if the examiner disagrees with the corresponding structure identified by appellant for any of the "means plus function" elements, the examiner should identify in the answer brief the corresponding structure which the examiner considers to be encompassed by these elements, and the Board should decide the corresponding structure to the extent it impacts patentability. Because of appellant's familiarity with the specification, the appellant is best suited to make the initial statement of the corresponding structure. The foregoing procedure should substantially assist the understanding of the meaning of these elements, and leverage the knowledge of appellant and examiner.

**Proposed Rule 41.39(a)(2) Pertaining to Reopening of Prosecution by Appellant in Response to a New Ground of Rejection.**

*"(2) An examiner's answer may include a new ground of rejection. For purposes of the examiner's answer, any rejection that relies upon new evidence not relied upon in the Office action from which the appeal is taken (as modified by any advisory action) shall be designated by the primary examiner as a new ground of rejection. An examiner's answer that includes a new ground of rejection must be approved by the Director."*

The summary of the proposed rules clarifies that a "new ground of rejection" includes a new prior art reference applied or cited for the first time in an examiner's answer. (Presumably, the examiner has the choice of filing an answer brief with this new ground of rejection or re-opening prosecution with another Office Action based on this new ground of rejection.) The summary of the proposed rules also gives other specific examples of "factual situations that constitute a new ground of rejection" and "factual situations that do not constitute a new ground of rejection". See Federal Register Pages 69837-69838.

The proposed rule states that the Director must approve a new ground of rejection. IBM supports the proposed Rule in that examiners should be subject to review before citing new prior art after an appeal brief is filed. Frequently, examiners cite new prior art which is not pertinent to the claimed invention, and this burdens appellant with reviewing the new prior art and filing another appeal brief. It is not uncommon for the examiner to repeat this process more than once necessitating appellant to file a third and even fourth appeal brief. However, in some cases one of the additional searches identifies pertinent prior art that impacts claim scope and should be cited. It is imperative to prevent issuance of claims which do not sufficiently distinguish over the prior art. Accordingly, there should **not** be an impediment to the examiner conducting another search after any appeal brief is filed, and making a new ground of rejection (or re-opening prosecution) based on new, **pertinent** prior art. IBM supports the proposed rule requiring the Director's approval to make a new ground of rejection based on new prior art or other ground, provided the standards for this approval include a substantive review of the pertinence of the newly cited prior art. Presumably, a new panel of examiners will represent the Director, but this should be clarified as well.

The USPTO also clarified appellant's options after the examiner makes a new ground of rejection. "Under the proposed rule the Office would allow appellant to reopen prosecution without having to file an RCE only if the

examiner's answer is designated as containing a new ground of rejection." Pages 69837-69838.

There should be a new **Rule** which clearly states (a) if an appellant continues prosecution, either because the examiner has made a new ground of rejection or by responding to an Office Action which reopened prosecution, before a decision on the merits by the Board of Patent Appeals and Interferences, or (b) if appellant reinstates the appeal, the fee already paid for the notice of appeal, appeal brief, and request for oral hearing (if applicable) will be applied to a later appeal if any on the same application. This is fair because the services for which the fees were paid were not provided in the first instance. Currently, MPEP 1208.02 includes such a statement for an appellant who elects to continue prosecution after the examiner re-opens prosecution and later appeals or an appellant who immediately reinstates the appeal,

"See 37 CFR 1.193(B). Whether appellant elects to continue prosecution or to request reinstatement of the appeal, if prosecution was reopened prior to a decision on the merits by the Board of Patent Appeals and Interferences, the fee paid for the notice of appeal, appeal brief, and request for oral hearing (if applicable) will be applied to a later appeal on the same application." MPEP 1208.02 commenting on Rule 1.193(b).

While this statement in the MPEP 1208.02 is helpful, it should be converted into a Rule in 37 CFR so it is binding and more widely known. Also, currently MPEP 1208.02 is directed to 37 CFR 1.193(B) which pertains to reopening of prosecution **by the examiner** and reinstatement of the appeal by appellant, but does not mention reopening of prosecution by appellant after the examiner makes a new ground of rejection. This last option should be encompassed as well under the new Rule.

#### **Proposed Rule 41.41. Reply Brief**

"(a) Timing. Appellant may file only a single reply brief to the examiner's answer within two months ...

*(b)(2) Any argument raised in the reply brief which was not raised in the appeal brief, or is not responsive to an argument raised in the examiner's answer, including any designated new ground of rejection, will not be considered by the Board for purpose of the present appeal, unless good cause is shown."*

IBM supports this proposed rule. However, IBM also proposes that Rule 41.41 be clarified to state that there is no obligation of appellant to file a reply brief, and the absence of a reply brief does **not** raise any inference or presumption that appellant acquiesces to any new arguments made by the examiner in the answer brief. Otherwise, appellant will be forced to scrutinize **every** argument made by the examiner in the answer brief and determine one-by-one whether these arguments are new. This would be an arduous task and require a subjective comparison of the examiner's arguments in the answer brief to the examiner's arguments in the Final Rejection and appellant's arguments in the appeal brief. Moreover, this would cause appellant to file a reply brief when there is any doubt whether the examiner has made a new argument, resulting in still more burden on appellant. It is fairer to simply allow appellant to file an appeal brief responding to all the rejections made in the Final Rejection, and allow the examiner to state the examiner's contrary position; this will frame the issues for the Board. If the examiner states a new argument not addressed in the Final Rejection or the appeal brief, it should be purely an option for appellant to respond; appellant may feel that the new argument is not dispositive, insufficient on its face or addressed by appellant's previous arguments stated in the appeal brief or appellant may not recognize the argument as new. Also, **the fundamental issue is whether the claims satisfy 35 USC 101, 102, 103 and 112, and this does not depend of the examiner's arguments. Rather, this is based on the subject matter of the claims, the prior art and the differences of claims over the prior art.**

This clarification to Rule 41.41 is needed in view of Ex parte Njo Appeal #2009-004173 (serial 10/742,094) where the Board stated, "Appellant ... urges that we improperly noted the absence of a reply brief. This absence does, in our view, also suggest that such inaction may constitute acquiescence with the examiner's argument. "Silence implies assent." Citing *Harper & Row Publishers v. Nation Enterprises*, 471v. 539,572 (USSC 1985)" Page 2 of Board Decision. However, the Board's reference in *Harper & Row Publishers v. Nation Enterprises* to "silence implies assent" was misplaced. The Court in *Harper & Row Publishers v. Nation Enterprises* was explaining why a press aide to Gerald Ford assumed to know what Gerald Ford was thinking. In fact, the assumption based on Gerald Ford's silence was incorrect. The Court was not stating that a failure to rebut an argument in a brief is legal acquiescence to the argument. As explained above, there can be many reasons why appellant does not respond to an argument of the examiner.

## **Proposed Rule 41.50(a) Decisions and other actions by the Board,**

*"(a) 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. The affirmance of the rejection of a claim **on any of the grounds** specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed."* (emphasis added)

Under the current and proposed Rule 41.50(a), the Board is not required to decide all rejections of a claim. For example, under the current and proposed Rule 41.50(a), if a claim is rejected under 35 USC 101 and either 35 USC 102 or 35 USC 103, if the Board affirms the rejection under 35 USC 101, the Board need not decide the rejection under 35 USC 102 or 35 USC 103. This is often inefficient for appellant and the Board, for the following reasons. Often times, applicant in an RCE can readily amend the claims to comply with 35 USC 101, such as where the rejection is based on the type of storage device which is recited in a program product claim. In such a case, applicant will likely have to file another appeal brief, burdening itself and the Board, to resolve the same 35 USC 102 or 35 USC 103 rejection.

Also, in preparing the original appeal brief, the uncertainty whether the Board will decide both the 35 USC 101 issue and the 35 USC 102 or 35 USC 103 issue (or any other statutory issue) often motivates appellant to argue method, system and program product claims **separately** even though the 35 USC 102 or 35 USC 103 rejection is similar so that an affirmance of the 35 USC 101 rejection against one of the claims will not result in an automatic rejection of the other claims. This increases the complexity and length of the appeal brief.

Therefore, for both reasons, IBM recommends that if a claim is rejected under 35 USC 101 and 35 USC 102 or 35 USC 103 (or any other statute), the Board should be required to decide all rejections.

## **Conclusion**

IBM believes that the proposed Rules, with the changes and clarifications noted above, will improve the efficiency and quality of the appeal process, and thanks the USPTO for this opportunity to comment.

Respectfully submitted,

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