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January 26, 2004

Director, U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Mr. Richard Torczon

Re: Consolidated Board Rules

Sir:

Please consider the following comments, which are my comments as an experienced interference practitioner, on the "contested cases" portions of the November 12, 2003, proposed rulemaking relating to the Rules of Practice Before the Board of Patent Appeals and Interferences.

As a general matter, the proposed rules are very confusing as to the sequence of events in an interference following adoption of the proposed rules. For example, the proposed rules and associated commentary indicate that priority is addressed by motions, but also refer to two stages of the interference. There is no indication of the sequence of motions on threshold issues, priority issues or other issues, or of submission of notices such as the Priority Statement. An overview outline of the procedure and timing, either in the final rules themselves or in the commentary accompanying the final rules, would be very helpful for parties and their counsel to make orderly and efficient preparations for participating in interferences under the proposed rules. It would also be helpful to enable the public to provide more meaningful comments on the proposed rules.

Proposed Amended Rule 1.292(a)

I understand that handling of public use proceedings may be delegated to the Board. Thus I recommend that the second sentence of proposed amended Rule 1.292(a) be revised to read "... may designate the Board of Patent Appeals and Interferences or one or more other appropriate officials to conduct ...".

Proposed Amended Rules 1.322-1.324

The references to proposed Rule 41.121(a)(2) in proposed amended Rules 1.322-1.324 seems too narrow (being limited to responsive motions). There are circumstances where the need for a Certificate of Correction is apparent before, and a Request for Certificate of Correction should be filed to support, initial motions -- for instance where a PTO printing error overly narrows a party's claim that is the basis of the count. Thus I suggest that these proposed amended rules simply refer to Rule 41.121(a) rather than Rule 41.121(a)(2).

Proposed Rule 41.2

Proposed Rule 41.2 is difficult to follow and to reference -- for example, within it there are three alternative Rules 41.2(1) and (2). Providing an alphabetical separator for each defined term (e.g., "(a) Affidavit ... (b) Board ... ", etc.) would overcome this problem. In addition, it appears that the word "action" was omitted in the phrase "For a final Board" [action] in the first occurrence of Rule 41.2(1).

Proposed Rule 41.4(a)

Extensions of time for certain deadlines in interferences can generally be obtained by stipulation according to the current Standing Order. Thus I recommend changing proposed Rule 41.4(a) by adding at the end "or Order of the Board".

Proposed Rule 41.105

The explicit text of proposed Rule 41.105, which permits no exceptions, is directly contradicted by the commentary about it, which identifies four exceptions. I recommend that the exceptions, or at least the existence of exceptions, be mentioned in the rule itself.

Proposed Rule 41.106(a)

Exhibits sometimes are a different, but not necessarily larger or smaller, size than the selected paper. Thus I recommend changing the word "larger" in proposed Rule 41.106(a) to "different" in the second sentence.

Proposed Rule 41.106(c)

It has always been unclear in the Standing Order (and the proposed rule) whether the requirement of proposed Rule 41.106(c) has any applicability to electronically filed or fax filed documents. Clarification would be appreciated.

Proposed Rule 41.106(d)

Proposed Rule 41.106(d) does not address hand filing. The current Standing Order has a very useful arrangement for permitting hand filing the morning after a paper is served, to preserve the effect of the fact that the PTO accepts papers in the mail room until midnight, but to allow the mailroom to be bypassed and thereby expedite delivery to the Board even beyond the service provided by Express Mail to the Board's Post Office Box. Since the proposed rule would always be waived if the current Standing Order procedure is continued, I would recommend that the Standing Order procedure be included in the rule.

Proposed Rule 41.106(e)(4)

Proposed Rule 41.106(e)(4) is confusing. For example, if a motion is due to be served on March 1, it may be served by Express Mail on March 1, resulting in its receipt by the party being served on March 2. An opposition is due 30 days after service, according to Rule 41.123. Thirty days after the day it is served would be March 31. However, if March 2 is not counted (per proposed Rule 41.106(e)(4), the thirty days would end on April 1. For clarity, it appears that Rule 41.106(e)(4) should be revised to --The date of service-- rather than "The date service is received." This is the way most courts handle date calculation -- see, e.g., Fed.R.Civ.P. Rule 6(a) -- as well as the way the PTO generally handles date calculation -- see, e.g., proposed Rule 41.155(b)(1). Alternatively, rules setting times based on a service date (e.g., Rule 41.123) should refer to --... days after service of the ... is received-- rather than "... days after service of the ...".

Proposed Rule 41.106(f)(3)(i)

Proposed rule 41.106(f)(1) requires that each paper include a certificate of service. Thus the requirement in proposed Rule 41.106(f)(3)(i) that the certificate of service must include the name of "each" paper being served is contradictory, since the certificate can only refer to one paper. It is also redundant, as well as adding unnecessary burden and generating a potential source of irrelevant error, because the paper whose name must be included on the certificate already has to be attached to the certificate. I would recommend at least modifying (i) to state "The name of the paper served or a reference to the attached paper."

Proposed Rule 41.109

The exception for Rule 608-type Statements and evidence (the proposed Rule 41.202(a)(4)/(d)/(e) explanation and showing) should be included in proposed Rule 41.109 -- i.e., the substance of current rule 612(c) should be retained in proposed Rule 41.109.

The commentary in the proposed rulemaking relating to asymmetry applies only to Rule 131 affidavits. Rule 608-type documents relating to the very cases involved in the interference would substantially never be included in a patent file. Furthermore, the rationale for not

producing Rule 608-type documents is much stronger than that for not producing Rule 131 affidavits. Rule 131 affidavits are, as noted, an important element of the prosecution history, relating to allowability of the claims. Rule 608-type documents, on the other hand, only relate to matters directly at issue in the interference, and create a decided asymmetry if they are produced to the opponent in the first weeks of the interference. A patentee is not required to produce any such compendium of evidence until the priority phase itself, and is not required to produce even a fraction of such evidence until the Preliminary Statement (Priority Statement)/Motion Period.

Further, the commentary suggests that Rule 608-type documents might not need to be produced with "a showing of good cause." This is likely to magnify the paper filing and complexities of substantially all interferences in which Rule 608-type documents have been filed, because applicants will generally feel compelled to file hasty motions to show good cause, which, as noted above, would usually exist. In addition, it would be helpful if the rule required the Order Declaring an Interference to set a time for making such a showing, to ensure that any necessary action is taken before the Board orders file copies to be produced to the parties.

There is also a transitional issue associated with this proposed change. Applicants have filed Rule 608-type documents under the current rules, based on the understanding that they would not be provided to interference opponents until required by the current rules. A change in this process should take into account such expectations. Like the courts, the PTO "must be cautious before adopting changes that disrupt the expectations of the inventing community." Festo Corp. v. Shoketsu Kinzoku Kogyo K.K., 535 U.S. 722, 62 USPQ2d 1705, 1713 (2002). Thus if Rule 41.109 does not include an exception for Rule 608-type documents, it should include a transitional provision that at least exempts Rule 608 documents filed in unpublished applications before the effective date of the rule change.

Proposed Rule 41.110(b)

Proposed Rule 41.110(b), and its counterpart in the existing Standing Order, is a source of unnecessary burden and delay. For example, in preparing Preliminary Motions, Oppositions and Replies, details of claim interpretation and specification interpretation are analyzed, often with the assistance of expert witnesses, much more microscopically than is possible within the first 28 days after an interference is declared. The interpretations resulting from this microscopic analysis and its focus on contested or potentially contested issues, are often much more accurate and precise than possible in the first month of the interference, especially with lengthy or complex specifications and claims. Thus when the annotated claims must be submitted earlier, correction in view of the inevitable later microscopic analysis is often required.

Thus I suggest that the annotations not be required (or at least considered finalized) until Motions, Oppositions and Replies (e.g., the motion record) are being filed. I am unaware of any earlier use of such annotated claims other than an opponent pouncing on them (and endlessly briefing mistakes therein) in Preliminary Motions, which needlessly expands the interference files and magnifies its complexity and cost to the parties and the PTO. If the PTO needs

annotations for a general understanding of the claims before motions are filed, a rule requiring exemplary, rather than exhaustive, drawing and specification references would be much less burdensome on the parties, would avoid many of the above issues, and would appear to serve the Board's needs. Alternatively, provision should be made for changing the annotation when errors or omissions are discovered, without the need for extensive briefing and argument (e.g., applying an "unintentional" standard).

Proposed Rules 41.121 and 41.208(a)(4)

Including priority and priority proofs in motion practice under proposed Rules 41.121 and 41.208(a)(4) would be extremely burdensome to the parties and the PTO. I believe that the priority proofs should still be addressed after the motion phase has been completed and the scope of the interference has been defined.

First, under the present system, the parties have nearly a year to uncover their priority proofs. This is often critical, since it involves locating old records, and locating witnesses who may have changed jobs and/or relocated geographically (occasionally several times). Especially with complex inventions, different departments and/or different companies or other entities may have worked on different parts of a reduction to practice and commercial development of an invention, and testimony from many different people can be required to establish all necessary facts (e.g., conception, reduction to practice, diligence, absence of abandonment, suppression or concealment). Just locating the necessary witnesses and documents can often take several months, and interviewing the witnesses and translating and reviewing the documents (both the witnesses and the documents often being located at disparate geographic locations around the world) can take additional weeks or months. Then preparing declarations of the witnesses can take substantial additional time. This would create a huge burden on a party who was unaware of the approaching declaration of the interference, translating into a much reduced ability of that party to put on a proper substantive priority case.

Second, a major purpose of motions practice is to define the scope of the interference, including the count(s). Until the scope of the count(s) is defined, it can be impossible to finalize adequate priority proofs, or the proofs would have to be expanded to take into account all possible relevant changes in the count(s). Assuming the proofs have to be submitted with a priority motion simultaneously with motions to change the count(s), therefore, a party would have to make impossible predictions or submit needlessly voluminous proofs in anticipation of potential changes to the scope of the count(s) that might be requested by it and the other party, all on a massively accelerated time frame (a few months under the proposed schedule rather than over a year under the existing schedule). This would create a huge burden on both parties, a burden that is inequitably much heavier on a party that is surprised by the interference. It would also create a large burden on the PTO to deal with the unnecessary paper, evidence and arguments relating to contingent variations in the scope of the count(s).

Third, a party requesting an interference would have a major, inequitable advantage over a party that is surprised by declaration of an interference. The requester has at least a year, and often nearly unlimited time to gather its priority proofs and line up witnesses (at least until its application is otherwise allowable, which can be postponed until all claims are placed in allowable condition under proposed Rule 41.102(a)). At present, this is offset by the fact that the surprised party has over a year to catch up on the priority issue, and neither party has to finalize and present its priority proofs until after the scope of the count(s) is defined. Under the proposed rules, both of these equalizing factors are absent, resulting in serious inequities between the parties.

Thus even if motions are to be the means for contesting priority as to the count, the rules should provide that such motions are not due to be filed until a reasonable time after the decision on other motions, including motions to change the count(s), much like current practice.

Who must bring a priority motion is also very unclear. Under proposed Rule 41.207(a), it appears that a junior party must bring the motion in order to avoid entry of judgment against him under the presumption. Is this correct? Must such a motion be filed in order for other motions to be considered? Regardless of whether new or modified counts are being proposed? Or must the senior party move for judgment based on the presumption? The commentary relating to proposed Rule 41.121(b) that "Since priority would be presented as a motion, this paragraph would change the allocation of burden of proof established in Rule 657(a)" would suggest that the senior party would be the one to bring the motion (since otherwise the allocation of burden of proof would not be changed). Alternatively, must both parties simultaneously file priority motions, requiring each party to prove its entire priority history regardless of the proofs submitted by the junior party (thus significantly increasing the burdens on the senior party, which is presently permitted to tailor its proofs to the showing presented in the case-in-chief of the junior party(ies)? This would appear to add to the burden to the parties and the PTO in addressing a much-expanded record with potentially significant amounts of unnecessary evidence and explanation.

Proposed Rule 41.121(c), 41.208(c)(4)(ii)(A) and 41.208(c)(5)(i)

Proposed Rule 41.121(c) eliminates much of the detailed guidance presently provided by Rule 637. Rule 637 is very useful to establish minimum requirements for motions, but sometimes requires action that is not particularly relevant to the motion at hand. Thus I do not disagree with the elimination of such minimum requirements, so long as there is not a sub silentio continuation of those or other minimum requirements that are not apparent to the parties.

The PTO's commentary concerning proposed Rule 41.122 exposes such a danger as to Board-created minimum requirements. There, the commentary requires, for example, that a motion to add a broad claim in an application in which the claims have been narrowed to avoid prior art must address previously applied prior art. In individual decisions, Board panels have imposed the even more stringent requirement that the motion address the closest prior art of

record (in the Board's opinion), whether or not it was applied in prosecution. Such requirements can be very burdensome, page-intensive and subject to highly subjective and unpredictable analyses by the Board. Thus I would recommend that Rule 41.121(c) be clarified to require that a motion must address any contrary positions taken by applicant or the PTO during prosecution, with commentary making clear that it may be left to the opposition and reply to address such items from the prosecution history as unapplied prior art that an opponent may find relevant to the motion. The latter comment also applies to proposed Rules 41.208(c)(4)(ii)(A) and 41.208(c)(5)(i).

Proposed Rule 41.123(c)

The language of proposed Rule 41.123(c) is slightly inconsistent with that of 41.123(a) and (b). I recommend that the word "of" in 41.123(c) be changed to --after-- to eliminate this inconsistency and any confusion that might result from the inconsistency.

Proposed Rule 41.127(b)

It is unclear why abandonment or disclaimer of the invention of the count, previously listed in Rule 662(a), are no longer included in the list of acts that are construed as requests for entry of adverse judgment, and what the practical effect of this omission may be. Clarification is requested.

Proposed Rule 41.128(a)(2) and (3)

Having been faced with many misleading or frivolous arguments in interferences, and having wasted substantial client and personal resources responding to them, I applaud the rationale behind these rules. However, whether an argument is truly misleading is often very subjective. The analysis of whether an argument is frivolous or not, on the other hand, is much more objective and has been the subject of many prior court decisions from which guidance is readily available. Thus I recommend that subsection (a)(2) be revised by deleting "misleading or" in order to avoid unnecessary satellite litigation over sanction issues. Similarly, it is often very hard to determine whether a party's tactics are justified or dilatory, often requiring an intent analysis that is not easily conducted in the interference context. Application of subsections (a)(1) and (a)(2) would appear to cover the intent of subsection (a)(3). Thus I suggest that subsection (a)(3) be deleted in order to avoid unnecessary satellite litigation over sanction issues.

Proposed Rule 41.128 (second occurrence)

Rule number 41.128 appears twice in the proposed rulemaking. It appears from the commentary that the second occurrence should be 41.129.

Proposed Rule 41.150(b)(1)(i)

I recommend that proposed Rule 41.150(b)(1)(i) be expanded to include patent applications (which are often incorporated by reference but not readily available) as well as patents and the other listed materials.

Proposed Rule 41.155

The typographical error in the rule number should be corrected.

With respect to proposed Rule 41.155(b)(1), extensions of time should be authorized for large volumes of evidence, for example such as would accompany a priority case.

Proposed Rule 41.157(b)(2)(ii)

Proposed Rule 41.157(b)(2)(ii) should be expanded to confirm that the parties may stipulate to taking deposition testimony outside the United States (e.g., where both parties' witnesses are located in the same foreign country).

Proposed Rule 41.200(b)

It would be helpful if proposed Rule 41.200(b) also included a statement as to the basis for interpretation of a count in terms of interpretation in light of the respective specifications of the parties. Counts are often, but not always, compilations of claims that appear in one or both parties' applications/patents.

Proposed Rule 41.201

The definition of "constructive reduction to practice" in proposed Rule 41.201 is too narrow in requiring description and enablement of "an embodiment." Where a count is generic, description and enablement of the genus also constitutes a constructive reduction to practice, regardless of whether any specific embodiment is also described and enabled. The case law is replete with holdings that an example (embodiment) is not required in a patent application or patent.

The definition of "earliest constructive reduction to practice" in proposed Rule 41.201 does not require that benefit of the earlier application have been claimed (or timely claimed) in the later application and referenced in the application in accordance with 35 USC §120. Clarification of whether such a claim and/or reference is required is requested.

Proposed Rule 41.202(a)(2)

The word "should" is confusing in proposed Rule 41.202(a)(2). It should be deleted.

Proposed Rule 41.202(a)(4)

The scope of the explanation in proposed Rule 41.202(a)(4) is unclear. Does the explanation have to include a submission of evidence and an explanation of the evidence (much like current Rule 608(b)), or does it merely have to explain the legal basis on which the applicant believes it can prevail? Contrast proposed Rule 41.202(a)(4), which requires an explanation, with proposed Rule 41.202(d), which requires a showing. If the former, the dichotomy between present Rules 608(a) and 608(b) should be maintained. Patent applications are seldom prepared in less than a few months time; thus a detailed showing is unnecessary make-work in applications filed only a few months apart.

Proposed Rule 41.202(b)

Proposed Rule 41.202(b) precludes patentees from pointing out potential interferences to the PTO except in the form of a protest, which is generally unavailable by the time the patentee becomes aware of an interfering pending application (i.e., after it is published). See Rule 291(a)(1). This seems to be contrary to the policy of the Patent Office of making an effort to avoid violation of 35 USC 101 by issuing more than one patent on a single invention. I suggest that this rule be revised to be similar to Rule 99, requiring very restricted disclosure, but permitting commentary identifying interfering claims, even in published applications, and not including the very restrictive time limits of that rule, which do not permit a disclosure to address claims added or amended after publication and which at most should mirror the one-year time limit of 35 USC 135(b).

Proposed Rule 41.202(d)

The dichotomy between present Rules 608(a) and 608(b) should be maintained in proposed Rule 41.202(d). Patent applications are seldom prepared in less than a few months time; thus a detailed showing is unnecessary make-work in applications filed only a few months apart.

In addition, the proposed showing should be required in the interference, rather than in ex parte prosecution, and should be permitted to be made under seal to postpone its disclosure to the opposing party. As noted in the commentary, the interference is likely to be declared regardless of whether the showing is sufficient. Present examining practice is only to determine whether a showing has been submitted, not whether it is sufficient. Thus the showing requirement does not avoid interferences. Furthermore, having the showing made in the interference provides better control on its availability to the opponent and the public, avoiding the inequities discussed above in my comment concerning proposed Rule 41.109. In addition, such a change would permit the

rule to be made applicable to junior party applicants and patentees who do not request the interference, which would make the process more efficient and equitable. However, the requirement should not be too early in the interference, if substantial detail is required, in order to avoid the inequities discussed above in my comment on proposed Rules 41.121 and 41.208(a)(4).

Proposed Rule 41.204(a)

Proposed Rule 41.204(a) appears to be extremely burdensome to the public and the PTO, and far more burdensome than the present Preliminary Statement requirements. The present rules require identification of the first conception, first reduction to practice, beginning of diligence, etc. Because the proofs generally become more and more explicit and corroboratable over time in these matters, parties often end up relying on evidence of later activities when the earlier activities turn out to be faulty in some regard (e.g., unavailability of a corroborator or the like). Furthermore, ongoing activities (e.g., diligence) need not be documented in a Preliminary Statement. Contrary to the implications in the commentary associated with it, the language of the proposed rule would appear to require that a party include its entire priority case in the Priority Statement, including evidence of all conceptions and reductions to practice and all acts of ongoing diligence and absence of abandonment, suppression or concealment, if it later hopes to rely on such evidence. Assuming the Priority Statement is to be filed early in the interference, it also brings out all of the inequities discussed above in my comment on proposed Rules 41.121 and 41.208(a)(4). Thus I believe that the current requirements of Preliminary Statements should be substituted for the all-inclusive requirements of proposed Rule 41.204(a).

Proposed Rule 41.204(b)

The language of Proposed Rule 41.204(b) bears no apparent relationship to the commentary associated with it, and appears redundant with proposed Rule 41.121(c)(1), which also requires a statement of the basis for each motion that is filed. I recommend that the proposed rule be revised to refer to "a list of motions with an identification of the basis for each listed motion" in congruence with the commentary and current practice.

Proposed Rule 41.207(d)

Proposed Rule 41.207(d) is overly burdensome and does not reflect the reality of the facts of invention development or the law of abandonment, suppression and concealment. The commentary supporting it does not rely on analogous law or fact. The proposed rule should be eliminated in view of the case-by-case nature of the analysis, or revised to reflect the present state of the law of abandonment, suppression and concealment.

The case law is very clear that mere delay is not a proper basis for finding abandonment, suppression or concealment, and that a case-by-case analysis is required.¹ In addition, the time required by courts to find delay so unreasonable as to shift the burden of going forward (not the burden of proof) is seldom less than two years, and the inventing public has come to rely on this state of the law.² As noted above with reference to *Festo*, *supra*, the PTO should be cautious before "adopting changes that disrupt the expectations of the inventing community." Here, the basis for selecting a one-year cut-off is arbitrary in terms of the law of abandonment, suppression and concealment, being modeled on one-year statutory bars and incentives for prompt filing, rather than being modeled on the realities of abandonment, suppression and concealment as they have been analyzed by the courts and the Board over the past decades. The courts have also been very careful to keep the burden of proof on this issue on the party alleging abandonment, suppression or concealment, and the PTO should do the same.³

Proposed Rule 41.208

Proposed Rule 41.208 does not address the requirements for the most substantive motions of all, motions for judgment of priority. The whole rule proposal is very vague on the nature of these motions, and how they relate in time and substance to the entire proceeding. For instance, the commentary on proposed Rule 41.208 refers to a second stage of the interference, whose existence is unclear if priority issues are addressed by motion.

¹ See *Checkpoint Systems, Inc. v. U.S. International Trade Commission*, 54 F.3d 756, 761, 35 USPQ2d 1042, 1046 (Fed. Cir. 1995) ("there is no particular length of delay that is per se unreasonable. ... Rather, a determination of abandonment, suppression or concealment has 'consistently been based on equitable principles and public policy as applied to the facts of each case.'). See also, *Dow Chemical Co. v. Astro-Valcour, Inc.*, 267 F.3d 1334, 60 USPQ2d 1519 (Fed. Cir. 2001), *cert. denied*, 535 U.S. 989 (2002).

² See Chisum on Patents, §10.08[3][b][i], page 10-284 (Matthew Bender & Co., Inc. 2002) ("A pattern in the CCPA and Patent Office Board interference decisions since *Peeler* was to find abandonment, suppression or concealment if, but only if, the delay period equaled or exceeded about two years." See also, *id.*, §10.08[1], note 5, page 10-276 ("There is no length of time that will create such an inference. *Shindelar v. Holdeman*, 628 F.2d 1337, 207 USPQ 112 (CCPA 1980), *cert. denied*, 451 U.S. 984 (1981). However, periods of inactivity longer than about 24 months seem to be construed as giving rise to such an inference.")

³ See Chisum, *supra*, §10.03[1][c][iv], citing *Young v. Dworkin*, 489 F.2d 1277, 1279, 180 USPQ 388, 390 (CCPA 1974) ("Thus, under §102(g) interference law involving co-pending applications, once the first party to invent has established priority of invention, the second party to conceive and reduce the invention to practice has the burden of proving that the first party suppressed or concealed the invention. In such an interference, the first party to invent does not bear any burden of proof regarding suppression or concealment once it has established an earlier date of invention."). See also, *Dow Chemical Co. v. Astro-Valcour, Inc.*, *supra*.

Proposed Rule 41.208(c)(3)(iii)

Proposed Rule 41.208(c)(3)(iii) states that a party "must" provide the noted explanation. A party should not be required to provide such an explanation when it accedes to the presumption of proposed Rule 41.207(c) -- i.e., when all claims of both parties are unpatentable over the prior art and thus judgment should be entered against both of them -- or when its arguments are contingent (e.g., relying on the contingency on grant of the motion of proposed Rule 41.207(c)).

Proposed Rule 41.208(c)(4)

Proposed Rule 41.208(c)(4)(i) does not seem to address the situation where a count includes more than one invention. For example, proposing to substitute a count with a single common invention for a count with two inventions, only one of which is common (e.g., a genus and species count, where only the genus is in common) does not appear to be accommodated by the language of proposed Rule 41.208(c)(4)(i). Proposed Rule 41.208(c)(4) should also permit the narrowing of a count to exclude subject matter that is not part of a common invention. For example, it should be possible to substitute a count that does not list a specific claim of one party that the party believes defines a separately patentable invention.

Proposed Rule 41.208(c)(5)(iii)(B)

Proposed Rule 41.208(c)(5)(iii)(B) seems inappropriate where there is, or is proposed to be, a second count to which the claim may correspond. Compliance with this section should not be mandatory to have a claim designated as not corresponding to a count if it corresponds to an opponent's claim that corresponds to another count to which the subject claim also corresponds.

Proposed Rule 41.208(c)(6)

The two halves of Proposed Rule 41.208(c)(6) should both refer to continuity of disclosure, since the reference to continuity in subpart (ii) without a corresponding reference in subpart (i) suggests that such a showing is not required for subpart (i).

Respectfully submitted,

William P. Berridge

WPB:hs

Sent: Friday, 13 February 2004 09:56
To: Torczon, Richard
Subject: RE: Your comments on the proposed Board rulemaking

Dear Mr. Torczon:

Thank you for your e-mail and your careful review of my comments.

I erroneously referred to 41.123(c) rather than 41.123(a)(3). I apologize for this error. The comment should have read as follows:

The language of proposed Rule 41.123(a)(3) is slightly inconsistent with that of 41.123(a)(1) and (2). I recommend that the word "of" in 41.123(a)(3) be changed to --after-- to eliminate this inconsistency and any confusion that might result from the inconsistency.

This is, in fact, a pretty minor point, but I recall that there was a problem in the same usages in the 1986 rules that led to confusion and a subsequent rule change. The ambiguity was more significant there than it is here, as the context here is much more clear.

Please do not hesitate to contact me with any further questions or comments.

Best regards.

Bill Berridge