

Comments on Proposed Board Rules Relating to ex parte Appeals

I respectfully submit the following comments regarding the recently proposed Rules of Practice Before the Board of Patent Appeals and Interferences. I believe that the proposed rules on ex parte appeals impose unnecessary and undesirable burdens on applicants and could be greatly simplified, as I will explain. I also have suggestions for improving practices of the PTO in examining patents, improving quality and reducing PTO costs.

I am speaking for inventors and, in doing so, include employers and others who share the risks involved in investing efforts and money on developing and protecting inventions.¹ What we do costs the public nothing. In addition to paying for everything else, we pay our share of PTO costs and, in recent years, for other governmental operations as well. We do so with expectation of obtaining exclusive rights that protect our investments of time, effort and money and which can attract the capital required for commercialization of our inventions. Our inventions are not always successful but in the aggregate, they have produced tremendous benefits to the public. I think we are entitled to understanding and respect, especially from the PTO.

In the vast majority of cases, examiners do treat us with respect and are helpful, constructive and efficient. They make thorough studies and searches and are oftentimes prepared to allow claims in a first action. Typically, an agreement as to allowance is reached after a second action, sometimes before. In a small proportion of cases, however, the picture is entirely different. All or most claims are finally rejected, interviews are unsuccessful, proposed amendments are refused and filing of an appeal becomes the only option. Examiners are no longer helpful and constructive but are combative, seemingly intent on winning and on preventing allowance of claims whenever possible, thereby acting against the public interest. It is in the public interest to allow claims that can lead to commercialization of our inventions.

¹I believe I am qualified to speak for inventors, after working full time for over twelve years as an independent inventor. Before that I prosecuted patents for over forty years, after serving as an examiner for two years.

Bias Against Inventors is Shown by PTO Comments

The proposed new rules could be used by combative examiners to cause difficulties for inventors. At the same time they have potential advantages for inventors. For example, under existing rules and except as to claims added under Rule 116, an examiner cannot include a new ground of rejection in an answer to appeal brief but must reopen prosecution. The proposed new rules would allow an examiner to include a new ground of rejection in the answer which could be troublesome to the appellant, especially since no limitations are placed on the examiner. However, the inclusion of a new ground of rejection could help an appellant in providing the appellant with the option of either asking that prosecution be reopened or addressing the new ground in a reply brief. With the second option, all patentability issues might be resolved in one appeal procedure, minimizing trouble and expense while enhancing the presumption of validity of all claims of the patent when issued.

My concerns relate to PTO comments which suggest a PTO bias against inventors and makes me wonder how the proposed new rules will be administered.

The PTO comments include the following:

Proposed Sec. 41.39 (a) (2) would permit a new ground of rejection to be included in an examiner's answer eliminating the current prohibition of new grounds of rejection in examiner's answers. Many appellants are making new arguments for the first time in their appeal brief (apparently stimulated by a former change in the appeal process that inserted the prohibition on new grounds of rejection in the examiner's answer). Because the current appeal rules only allow the examiner to make a new ground of rejection by reopening prosecution, some examiners have allowed cases to go forward to the board without addressing the new arguments. Thus, the proposed revision would improve the quality of examiner's answers and reduce pendency by providing for the inclusion of the new ground of rejection in an examiner's answer without reopening prosecution.

From these and other comments, it appears that the primary motivating force behind the PTO proposal to allow new grounds of rejection is directed against inventors. It is apparent that the PTO is concerned about new and persuasive arguments that have been advanced against grounds of rejection asserted in examiner

actions. The attitude of PTO officials seems to be that the examiner should be allowed to retaliate with a new ground of rejection. These comments also suggest a PTO view that before the present prohibition on new grounds of rejection, applicants had been intimidated against making any new arguments against a ground of rejection. While this seems unlikely to have been the case, it does suggest that the PTO thinks that allowing new grounds of rejection will intimidate applicants who wish to make new arguments or even file an appeal in the first place. Indeed, if applicants consider the attitudes reflected by the very lengthy PTO comments on allowing new grounds of rejection, they could well be deterred from filing appeals they might otherwise file. Is this a purpose of the proposal to allow new grounds of rejection?

I will discuss later some changes that could be made in the proposed rule regarding inclusion of a new ground of rejection, but the PTO could make changes other than rule changes. I respectfully suggest that the PTO take steps to insure that the final actions made by all examiners are made after thorough and serious consideration to insure allowance of all claims that can be allowed and to also include all grounds of rejection that are applicable to rejected claims. If applicants are allowed claims that are reasonably broad and are up against rejections that may be difficult to reverse, many appeals might be avoided. When appeals do occur, the issues to be decided would be clarified at an early time. The pendency of applications and costs related to appeals would be minimized.

Content of Appeal Briefs

The PTO proposes that the current grouping of claims requirement of Rule 192 (c) (7) be deleted because it has led to many problems. The PTO also proposes that subparagraphs (i) through (v) of Rule 192 (c) (8), relating to the manner in which arguments are to be made, be eliminated because although they provide useful advice as to what an effective argument ought to include, these provisions have often been ignored by appellants and, for the most part, have not been enforced as set forth in paragraph (d) of that rule. These would be replaced by a proposed Sec. 41.37 (c) (1) (vii) entitled Argument that repeats an initial part of Rule 192 regarding

contentions, adds a statement that any arguments or authorities not included in the brief or a reply brief will be refused consideration by the Board, unless good cause is shown, that imposes specific requirements as to headings, grouping of claims and arguments relative thereto, that authorizes the Board to select a single claim from a group of claims argued together for deciding the appeal as to the group of claims and that states that the failure of an appellant to separately argue claims which the appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.

The PTO also proposes that the requirement in Rule 192 (c) (5) for a concise explanation of the subject matter defined in the claims involved in the appeal, with specific references to the specification and drawings, be repeated but limited to independent claims. In addition, the PTO proposes adding a requirement that for each claim involved in the appeal, every means plus function and step plus function must be identified and the corresponding structure, material, or acts must be set forth with specific references to the specification and drawings. The PTO comments admit that the concise explanation requirement is not being followed in a great number of briefs, but states that It is expected that the proposed requirements will be enforced by the examiner.

I strongly object to the foregoing proposals. There are reasons for the admitted problems with the existing grouping of claims requirements and the admitted failures in forcing appellants to follow other existing provisions. The reasons have to do with the fact that each case on appeal is unique. A grouping of claims or a manner in which arguments are made or a style of explanation of an invention that may be appropriate in one case may be quite inappropriate in other cases. Appellants have pretty good ideas as what the issues are and the arguments in their favor. They can be expected to describe the claimed invention, the references and the issues as clearly and as succinctly as possible to a Board made up of qualified persons capable of understanding issues and arguments in whatever form they may be presented, getting to the merits of a case and making a fair decision. There is no good reason for making

detailed requirements as to the form of presentation of explanations and arguments in an appeal brief.

Compliance with the proposed rules requires admissions as to the scope of claims that are not necessarily in controversy and adds significantly to the time and effort of preparing and reviewing the brief with no significant benefits. With particular regard to the proposed requirements relating to means plus function and steps plus function recitations, such recitations are rarely an issue. When they are an issue, they can be simply addressed as appropriate.

It is noted that the PTO properly assumes that an examiner is capable of responding to any appeal brief under either the existing rule or the proposed rule each of which simply requires a written statement in answer to appellant's brief including such explanation of the invention claimed and of the references and grounds of rejection as may be necessary. Should not the same simple requirements be in effect as to the appeal brief?. What's sauce for the goose should be sauce for the gander.

For the foregoing reasons, I respectfully suggest that proposed parts (v), (vi) and (vii) of Sec. 41.37 (c) (1) be replaced with the following:

Such explanation of the invention claimed and of the references and grounds of rejection as may be necessary.

This will be fair to appellant as well as to the examiner and will simplify the procedures, expedite appeals and reduce costs. It is particularly noted that it will relieve the examiner from spending any time studying briefs to make sure that they conform to a prescribed format that may be completely inappropriate for the case at hand. It will avoid the controversies and problems that would inevitably result if the proposed formal requirements were put into effect and attempts were made to enforce them.

The Examiner's Answer and The Reply Brief

The proposed new rules would replace existing Rule 193 relating to the examiner's answer and the reply brief with Sec. 41.39, Sec. 41.41 and Sec. 41.43. Part

(a) (2) of existing Rule 193 prohibits inclusion of a new ground of rejection in an examiner's answer but allows the examiner's answer to include the rejection(s) of the claim(s) that may have been added under Rule 116. Sec. 41.39 (a) (2) of the proposed new rules would remove this prohibition, reading as follows:

(2) An examiner's answer may include a new ground of rejection.

As has been noted, this would place no limitations whatsoever on the circumstances and motives in and for which an examiner might include a new ground of rejection. The PTO comments recognize that there is a problem, saying that including new grounds of rejection would not be open-ended but is envisioned to be rare, that the Office plans to issue instructions to be included in the MPEP requiring approval of a new ground of rejection by a management official, and also that the Office intends to provide guidance to examiners as to what circumstances, e.g. responding to a new argument or new evidence submitted prior to appeal, would be appropriate for entry of a new ground of rejection. These comments are not only not reassuring but increase my concerns about PTO attitudes toward inventors. No mention is made of circumstances in which inclusion of a new ground of rejection would be clearly beneficial to the appellant, for example when an examiner discovers a reference on which a new ground of rejection could be based. The inclusion of this new ground of rejection would allow the issue to be dealt with and resolved, quite possibly in appellant's favor, while the application is pending. Such inclusion could be embarrassing to the examiner if he or she had failed to find the reference and/or failed to reject claims on the reference. I respectfully suggest that PTO instructions and guidance in these or similar circumstances should require the examiner to include the new ground of rejection and acknowledge any mistakes that may have been made.

I also respectfully suggest the addition of a provision in the proposed rule that any new ground of rejection in the answer be clearly identified as such and the inclusion of an explanation as to the time and circumstances in which the new ground of rejection became known to the examiner, also an identification of any argument in the Brief to which the new ground of rejection is responsive or to which it is addressed.

Part (b)(1) of existing Rule 193, relating to the reply brief, contains no restrictions as to what may be included, allows the examiner to reopen prosecution to respond to the reply brief and states that A supplemental examiner s answer is not permitted, unless the application has been remanded by the Board of Appeals and Interferences for such purpose . Part (b)(2) of existing Rule 193 covers procedures available when prosecution is reopened.

Proposed Sec. 41.41 restricts the reply brief and proposed Sec. 41.43 broadens the circumstances in which a supplemental answer is permitted. Sec. 41.41 (2) states that A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence and refers to Rule 116 and to a proposed Sec. 41.33 that relates to submissions of amendments and affidavits or other evidence. Proposed Sec. 41.43 (a) (1) states that the examiner may furnish a supplemental examiner s answer responding to any new issue raised in the reply brief . I am opposed to these changes. I respectfully suggest that Sec. 41.41 be changed to allow a reply brief to include a new or non-admitted amendment, affidavit or other evidence upon a showing of good and sufficient reasons why they are necessary and were not earlier presented. With regard to proposed Sec. 41.43 (a) (1), the term new issue could be so construed as to permit a supplemental answer in almost any case, to be very unfair to appellant, increase pendency and increase costs. I respectfully suggest that a revision such that a supplemental answer can only be filed in response to the inclusion of a new or non-admitted amendment, affidavit or other evidence in the reply brief.

Summary

I respectfully recommend the following, assuming that rules along the lines of those proposed are to be put into effect:

(1) Replacing proposed parts (v), (vi) and (vii) of Sec. 41.37 (c) (1) with the following:

Such explanation of the invention claimed and of the references and grounds of rejection as may be necessary.

This will be fair to appellant as well as to the examiner and will simplify the procedures, expedite appeals and reduce costs.

(2) Revision of Sec. 41.39 (a) (2) to read as follows:

An examiner's answer may include a new ground of rejection provided that the new ground of rejection be clearly identified as such and provided that the answer includes an explanation as to the time and circumstances in which the new ground of rejection became known to the examiner, also an identification of any argument in the Brief to which the new ground of rejection is responsive or to which it is addressed.

This should assist the Board in evaluating any new ground of rejection included in an examiner's answer.

(3) Changing the first sentence of Sec. 41.41 (a) (2) to read as follows:

A reply brief may include a new or non-admitted amendment, affidavit or other evidence upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

(4) Changing the second sentence of Sec. 41.43 (a) (1) to read as follows:

In addition, the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner's answer for responding to any new or non-admitted amendment, affidavit or other evidence included in the reply brief.

(5) Steps to insure a serious and thorough consideration of all final actions to insure allowance of all claims that can be allowed and, as to any rejected claims, the inclusion of all applicable grounds of rejection. Applicants will then know what they have and what are up against if they file an appeal. Many appeals might be avoided. When appeals do occur, the issues to be decided can be clarified at an early time. The pendency of applications and costs related to examinations and appeals will be minimized.

(6) Instructions and guidance to examiners to insure inclusion of new

grounds of rejection in answers when such inclusion will be in the interest of applicants as well as in the public interest, even though possibly embarrassing to examiners.

Respectfully submitted,

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