

Director of the United States Patent and Trademark Office
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P.O. Box 1450
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Notice of Proposed Rulemaking
Rules of Practice Before The Board of Patent Appeals and Interferences
68 Federal Register 66648 (November 26, 2003)

Dear Director:

Greenblum & Bernstein, P.L.C. appreciates the opportunity to offer comments on the rule changes proposed by the United States Patent and Trademark Office in the subject notice.

Greenblum & Bernstein, P.L.C., located in Reston, Virginia, is an intellectual property law firm of over 30 lawyers with an international practice concentrating in patents, trademarks and copyrights. The firm maintains a full application and prosecution docket; actively participates in reissue and reexamination matters; analyzes, reviews, and prepares licenses and other technology transfer agreements in all aspects of intellectual property, and regularly analyzes patents and provides complete opinions relating to infringement, validity, overall patent strategy and related matters. The firm's litigation group regularly litigates in the federal courts.

The following comments on proposed Part 41 - Practice Before the Board of Patent Appeals and Interferences are primarily directed to those rules contained in Subpart A - General Provisions and Subpart B - Ex Parte Appeals to the Board. Several comments of a "housekeeping" nature are also included. Our comments conclude with several suggestions as to the manner in which the rules are to be implemented.

Comments on Proposed 37 CFR § 41.31(a)(1), (a)(2) and (a)(3)

Proposed rule § 41.31(a) relating to appeal to the Board reads as follows (68 FR at 66676):

§ 41.31 Appeal to Board.

(a) Who may appeal and how to file an appeal:

(1) Every applicant, any of whose claims has been twice or finally (§ 1.113 of this title) rejected, may appeal the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(2) Every owner of a patent under ex parte reexamination filed under § 1.510 of this title before November 29, 1999, any of whose claims has been twice or finally (§ 1.113 of this title) rejected, may appeal from the decision

of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(3) Every owner of a patent under ex parte reexamination filed under § 1.510 of this title on or after November 29, 1999, any of whose claims has been finally (§ 1.113 of this title) rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

We suggest that the conclusion of each of provisions (a)(1), (a)(2) and (a)(3) be reworded to include the following italicized language: "within the time period provided under § 1.134 of this title for reply, at any time during pendency of the application [reexamination], where no time period under § 1.134 is running."

The suggested change would ensure that proposed § 41.31 would not be interpreted more restrictively than 35 U.S.C. § 134, which sets forth no condition regarding when an appeal can be filed, apart from the requirements for claims being twice rejected (as in 35 U.S.C. § 134(a)) or finally rejected (as in 35 U.S.C. § 134(b) and (c)). This would also prevent any potential inconsistency of the rules with the Board's precedential opinion, Ex parte Lemoine, 46 USPQ2d 1420, 1423 (Bd. Pat. App. & Int'f 1994) ("[S]o long as the applicant has twice been denied a patent, an appeal may be filed").

Comments on Proposed 37 CFR § 41.33

Proposed rule § 41.33 relating to amendments and affidavits or other evidence after appeal reads as follows, with the language of concern italicized (68 FR at 66676):

§ 41.33 Amendments and affidavits or other evidence after appeal.

(a) Amendments submitted after the date the proceeding has been appealed pursuant to § 41.31(a)(1)-(a)(3) may be admitted: (1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or (2) To rewrite dependent claims into independent form.

(b) All other amendments submitted after the date the proceeding has been appealed pursuant to § 41.31(a)(1)-(a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

(c) Affidavits or other evidence submitted after the date the proceeding has been appealed pursuant to § 41.31(a)(1)-(a)(3) will not be admitted except as permitted by §§ 1.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

The commentary regarding proposed rule § 41.33 reads as follows with the language of concern italicized (68 FR at 66651):

Proposed § 41.33(a) and (b) would replace the requirements of current Rule 116 with a prohibition of amendments submitted after the date the proceeding has been appealed pursuant to proposed § 41.31(a)(1)-(a)(3), except amendments canceling claims or rewriting dependent claims into independent form and as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1). A dependent claim is rewritten into independent form by including all of the limitations of the base claim and any intervening claims. Thus, no limitation of a dependent claim can be excluded in rewriting that claim into independent form. Proposed § 41.33(c) would replace the requirements of Rule 195 with a prohibition on the admission of affidavits and other evidence submitted after the case has been appealed pursuant to proposed § 41.31(a)(1)-(a)(3), except as permitted by proposed §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1). This would replace the current practice of permitting such evidence based on a showing of good and sufficient reasons why such evidence was not earlier presented. The Office believes that prosecution of an application should occur before the examiner prior to an appeal being filed, not after the case has been appealed pursuant to proposed § 41.31(a)(1)-(a)(3).

This provision may force an applicant to file continuing applications to gain entry of even the most innocuous of amendments, the need for which was discovered post notice of appeal, a result that is wasteful of both applicant and USPTO time and resources. For example, minor corrections, the need for which is discovered during the brief preparation stage, will not be curable by amendment, absent a new ground of rejection by the examiner. While it is obviously desirable that prosecution be as complete as possible prior to filing an appeal, the fact is that some errors only become evident during the preparation of a brief and the impact of this rule would be to prevent entry even of amendments that have no effect on the examiner's rejection.

A related point is that this change will force an applicant to elect to file a more costly third month extension of time rather than a less costly notice of appeal in order to preserve the ability to present an amendment that the examiner has authority to entertain.

We suggest that the USPTO leave existing 35 CFR § 1.116 as it is and dispense with the amendments proposed by § 41.33.

If the USPTO nevertheless decides to adopt a rule similar to proposed rule § 41.33, then at least two changes are suggested. First, to avoid overly literal interpretation of the rule, it ought to be made clear (preferably in the rule, but if that is impossible, in the commentary and the Manual of Patent Examining Procedure) that the words of proposed rule § 41.33(a)(2), "rewrite dependent claims into independent form," includes both of the following two situations:

(1) in conjunction with the rewriting of a dependent claim in independent form, amendment(s) would be allowed changing the dependency of claims which had depended from the independent claim being canceled, and

(2) rather than rewriting a dependent claim in independent form, an independent claim can be amended to incorporate therein the subject matter of a dependent claim that has been identified by the examiner as being allowable.

Second, a third category of permissible amendments ought to be added to proposed § 41.33(a), to wit, "(3) To carry into effect an agreement reached with the examiner, or complying with a requirement of form expressly set forth in any previous Office action." Such an amendment might be made, for example, to correct a lack of antecedent basis (either by revision of a word or expression or by amending the claim so rejected to depend from another claim which would provide such antecedent basis), or any other matter about which an agreement reached by telephone were made (and, perhaps, in lieu of an Examiner's Amendment). This would provide some discretion on the part of the examiner and could also reduce issues on appeal.

Comments on Proposed 37 CFR § 41.37(c)(1)(v)

Proposed rule § 41.37(c)(1)(v) relating to the content of the appeal brief reads as follows, with the language of concern italicized (68 FR at 66676):

§ 41.37 Appeal brief.

* * *

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section: * * *

(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each claim involved in the appeal, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The commentary regarding proposed rule § 41.37(c)(7) reads as follows with the language of concern italicized (68 FR at 66652):

Proposed § 41.37 would generally incorporate the requirements of Rule 192. In addition, it is proposed to: . . .

(7) In paragraph (c)(1)(v), require a concise explanation of the invention defined in each of the independent claims involved in the appeal, which explanation shall refer to the specification by page and line number, and to the drawings, if any, by reference characters. For each claim involved in the appeal,

it is proposed that every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, be identified and that the structure, material, or acts described in the specification as corresponding to each claimed function be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The current requirement of Rule 192(c)(5) to set forth a concise explanation of the invention defined in the claims involved in the appeal by reference to the specification by page and line number, and to the drawings, if any, by reference characters is not being followed in a great number of briefs before the Board. It is expected that the proposed requirements will be enforced by the examiner. Accordingly, any brief filed by an appellant who is represented by a registered practitioner that fails to set forth a summary which references the specification by page and line number, and to the drawing, if any, by reference characters or which fails to identify every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, would be in non-compliance with this section and would be handled as set forth in proposed paragraph (d) of this section.

This provision (1) may unnecessarily introduce file wrapper estoppel by virtue of compliance with the rule, and (2) may be subject to abuse, as where an examiner takes the position that claims not couched in "means plus function" terminology of 35 U.S.C. § 112, 6th paragraph, are nevertheless subject to the provisions of that section and this proposed rule.

The separate and additional requirement pertaining to claims that include "means-plus-function" and "step-plus-function" limitations is not justified, since even claims that do not use such language may be just as problematic for the Board to construe. Moreover, the proposed requirement will necessitate that the appellant provide this identification in every instance, not only in those instances where the construction is necessary to the Board's decision. As a preferable alternative, it should be recognized that existing 37 CFR § 1.196(d) provides ample authority for the Board to require the appellant to provide a statement identifying the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawing, if any, by reference characters, in those situations where the Board considers such an identification necessary for a reasoned decision. Proposed § 41.50(d) provides the same authority. Accordingly, the italicized language of proposed § 41.37(c)(1)(v) ought to be omitted from the final rule.

"Housekeeping" Comments

At 68 FR 66666, left column, first paragraph, "The count is understood be the common inventive concept of the parties" should read, -- The count is understood to be the common inventive concept of the parties.-

In proposed rule § 41.2 (68 FR at 66674), "(1) For a final Board" should read -(1) For a final Board action.-

Proposed rule "§ 1.155" (68 FR at 66687) should read --§ 41.155.-

In proposed rule § 41.200 (68 FR at 66688), "... in subpart C of this part" should read --... in subpart D of this part.--

While we have no fundamental objections to the proposed changes that would permit new grounds of rejection in the examiner's answer (proposed rule § 41.39(a)(2)), given the provisions that maintain the appellant's position as master of his appeal (proposed rule § 41.39(b)(1) and (b)(2)), we are concerned that this authority be exercised judiciously. The rule package contemplates that new grounds of rejection will be rare, not routine occurrences (68 FR at 66653). We applaud this approach and urge the Director to put in place appropriate controls to ensure that this expressed intention is made reality.

We presume that examiners will be instructed that they are to clearly label any new ground of rejection that they make and that the decision mailed (or otherwise communicated) to the appellant will evidence the approval for the new ground of rejection and suggest that the commentary and or the MPEP be amended to reflect such instructions. We also presume that examiners will be instructed to label as new grounds of rejection those rejections that are so changed that the appellant has not had fair opportunity to react to the thrust of the rejection, consistent with the criterion applicable in a decision by the Board under *In re Kronig*, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976). This would preserve the appellant's right to introduce an amendment, thereby re-opening prosecution, in a situation in which the examiner's answer includes an explanation of a rejection that differs sufficiently from that previously advanced that the appellant had not been afforded opportunity to react to the thrust of the rejection. We believe that to be entitled to entry of an amendment, thereby re-opening prosecution, the only burden on the appellant would be to identify (1) the difference in the rejection, as presented in the examiner's answer vis-à-vis the rejection from which the appeal has been taken, and (2) how the amendment addresses the difference, i.e., the new rejection.

Given the potential for new grounds of rejection, the guidelines for interviews set forth in the MPEP ought be modified to afford an appellant an opportunity to discuss the new rejection with the examiner, so that the appellant can determine whether an amendment would in fact advance prosecution.

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