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February 13, 2004

Director of the United States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

Notice of Proposed Rulemaking
Rules of Practice Before the Board of Patent Appeals
and Interferences
68 Fed. Reg. 66648 (November 26, 2003)

Dear Mr. Commissioner:

In the Federal Register Notice dated November 26, 2003, the U.S. Patent and Trademark Office requested public comments regarding the above identified Notice of Proposed Rulemaking. Presented herein are the comments of the American Bar Association Section of Intellectual Property Law ("ABA IPL Section"). These views have not been submitted to the House of Delegates or Board of Governors of the ABA, and should not be construed as representing policy of the Association. The ABA IPL Section appreciates the opportunity to offer comments on the rule and practice changes proposed by the Office in the subject notice with respect to practice before the Board.

The Office's attempt to address practice before the Board is noted with appreciation. Many of the proposals address concerns regarding the

considerable length of time many of these proceedings entail. In this regard, the ABA IPL Section supports improving practice before the Board by increasing the number of Administrative Patent Judges, continuing the Board's mission of educating Examiners as well as practitioners regarding practice before the Board and continuing to examine ways to make practice before the Board more efficient and consistent.

While the ABA IPL Section applauds the Office's efforts to improve practice before the Board, it is our opinion that some of the proposals would not further these goals and should be examined more closely by the Office prior to adoption. In this regard, the ABA IPL Section provides the following comments in response to the Notice.

Part 1 – Rules of Practice in Patent Cases

§1.14 Patent Applications Preserved in Confidence

Revised Section 1.14 provides the Office the authority to "independently publish any decision that is available for public inspection." More troubling, however, is §1.14(e)(2), which provides a great deal more discretion to the Office regarding publishing a decision on a petition which would not otherwise be publishable. The Director may elect publication of a decision if it is believed "that special circumstances warrant publication" and the applicant does not object within the allowed two month time period. If such decisions are published, the ABA IPL Section recommends that all identifying information be redacted from the decision. This is done, for example, by the

Board in publishing interference trial section opinions which otherwise are not subject to publication.

Part 41 – Practice Before the Board of Patent Appeals and Interferences

§41.31 Appeal to Board

The ABA IPL Section suggests that, in section (a), both paragraphs (1) and (2) be amended to clarify that it is the application, rather than Applicant that is determinant of whether an application is ripe for appeal. The change is being suggested to reduce the periodic disputes between Examiners and Applicants as to whether an application under a non-final rejection was ripe for appeal. This arises especially in situations where Applicant files a continuing application which includes claims substantially identical to the ones in the parent application and the Examiner does not make the first action rejection final, though the disputed issues are the same. At times, Applicants choose to appeal the rejection in order to save time and the expense of re-hashing previous arguments which were not found to be persuasive by the Examiner. It is not always clear to Applicants and Examiners whether the application is ripe for appeal. Removal of the alternative clause would make clear that once the Examiner rejects a claim for the second time (in the same application or in a continuing application), the decision as to whether to appeal the rejection or continue proceedings before the Examiner will rest with the Applicant. Since a final rejection will never be made in a first rejection of a claim, the alternative language is not necessary.

The ABA IPL Section further suggests that paragraph (3) be deleted. This would eliminate the requirement that Applicant wait until an Examiner makes a second or subsequent rejection final, before being permitted to file an appeal in an application filed on or after November 29, 1999. This would restore to Patentees the decision as to when to file an appeal in a Reexamination proceeding that is subject to repeated rejections. It would also simplify the regulations as there would no longer be a need to determine filing dates of Reexamination proceedings under this section.

§41.33 Amendments and affidavits or other evidence after appeal

The ABA IPL Section suggests that paragraphs (a) and (b) be amended to refer to the “date of filing an Appeal” as opposed to referring to “after the date the proceeding has been appealed.” This change would ensure consistency with Office language used in other regulations relative to “filing dates.” The original language is confusing as it is not clear whether the date the “proceeding has been appealed” is the date typed by the Applicant on the Notice of Appeal, the date of the Certificate of Mailing affixed on a Notice of Appeal, or the date of filing accorded by the Office to the Notice of Appeal. Similarly, it is not clear what the date is that an amendment was “submitted.” Do certificates of mailing or certificates of facsimile transmission, impact on the date of “submission” or the date that “the proceeding has been appealed”? A well accepted term like “date of filing” used consistently throughout the paragraph would avoid any possible confusion.

In addition, it is suggested that the word “may” be replaced with the word “will” in this section. This suggestion is made to avoid any possible confusion or abuse of the regulations by Examiners. There should be no flexibility given to Examiners in entering minor cosmetic amendments as envisioned in this portion of the paragraph.

Further, the ABA IPL Section suggests to incorporate paragraph (c) with paragraph (b), and have paragraph (b) refer both to “amendments” and “affidavits or other evidence” submitted after filing an appeal. This amendment would avoid separate discussion of amendments, affidavits and other evidence since the prohibition against these filings is the same.

§41.37(v) Appeal Brief

The ABA IPL Section opposes this provision of the proposed rules. The requirements of this section would result in excessive and unnecessary admissions relating to §112, 6th paragraph, claim limitations. It is not necessary for appellants to point to and list, for each appealed claim having a §112(6) limitation, the corresponding subject matter and its location in the specification. This is very burdensome and would create prosecution history estoppel. The requirement should only be imposed if the Appellant is actually relying on the §112(6) limitation to distinguish the invention from the prior art. The ABA IPL Section recommends that this section be replaced by the language of current §1.192(c)(8), as a reasonable compromise between Applicants’ needs and the needs of the PTO.

§41.37 Appeal brief

The ABA IPL Section suggests that paragraph (a)(1) be amended, as suggested for §41.33, to reference the “date of *filing* the notice of appeal,” rather than the uncertainty that might be introduced by the phrase “the date of the notice of appeal.”, particularly as applicants might lose some time where a certificate of mailing was used for filing a Notice of Appeal. In addition, it is suggested that the clause “”or within the time allowed for reply to the action from which the appeal was taken, if such time is later” be added at the end of paragraph (a)(1). This language currently appears in § 1.192(a), and this additional time is a valuable option to Applicants who file a Notice of Appeal with no intention of filing an Appeal Brief, but are filing the Appeal simply to buy some additional time to permit the Examiner to rule on an Amendment filed under § 1.116. Any docketing benefits gained by the proposed change in this paragraph, as discussed by the proposed rule drafters, is far outweighed by the disadvantage to both Applicants and the Office in having Applicants file a Brief simply as a strategy to maintain pendency, while the Examiner renders a decision on an amendment filed under § 1.116.

The ABA IPL Section suggests that paragraph (iii) be deleted in its entirety, as it introduces an unnecessary additional burden on appellants with no discernible benefit to the Office. Since only rejected claims are subject to an appeal, there seems to be no benefit in identifying the status of claims that are not subject to appeal. Furthermore, asking appellants to make this type of listing for claims that are not rejected and thus

are not subject to appeal, would introduce a risk of inadvertent error by appellants and in any event, would likely be ignored by the Examiner and the Board.

The ABA IPL Section suggests that paragraph (vii) be amended to add the word “separate” prior to “patentability” in the last sentence. This would clarify that pointing out what a claim recites will not be considered an argument for “separate” patentability of a claim, since such an argument could in fact establish patentability of that claim without establishing “separate” patentability of the claim.

The ABA IPL Section suggests that paragraph (ix) be amended to require identification of “when the evidence was submitted into the record by Applicants or where in the record that evidence was entered in the record by the Examiner.” This suggestion is made since Examiners will frequently not make a positive statement indicating approval of entry into the record of evidence presented by Applicants. Absent specific indication by the Examiner that any evidence submitted was refused entry, the evidence is presumed to have been entered as of the submission date. The suggested change would remove any ambiguity regarding how to comply with this requirement should the Examiner not make an affirmative entry of the evidence.

§41.39 Examiner’s answer

Section 1.193, directed to the Examiner’s Answer, has been modified and presented in §41.39. The proposed rule provides that an Examiner’s answer *may* include a new ground of rejection without automatically reopening prosecution.

Previously, including a new grounds for rejection would automatically reopen prosecution. In the proposed rule, Applicant would have the *option* of reopening prosecution to address the new ground of rejection, or continuing with the appeal. This approach is favored by the ABA IPL Section. Depending upon what the new ground of rejection is, and how it compares to prior rejections, reopening of prosecution may not be necessary and may prolong examination without any benefit to the Applicant. Applicant may not wish to have prosecution reopened if the new rejection is similar to a prior rejection, or if the evidence of record is sufficient to address the rejection. Giving Applicants the choice of whether to reopen prosecution is favored since it is Applicants' patent term which would be delayed by prolonged examination. If the new ground can be addressed based upon the information of record, then it would be in Applicants' best interest to waive the reopening of prosecution. Alternatively, if additional evidence must be submitted, then Applicant can elect to reopen prosecution so that the evidence may be made of record. In addition, since prosecution would not be automatically reopened, the Examiner may be more likely to make the new ground of rejection, which will improve the examination process. The ABA IPL Section is in favor of this provision, allowing Applicants the choice regarding how to proceed.

While the language of proposed paragraph (a)(2) does not address OFFICE controls over abusive new grounds of rejection issued by Examiners, the background discussion found in the middle paragraph on page 66653 of the Notice indicates that MPEP guidelines would be issued requiring approval of new grounds of rejection by a Technology Center Director. The ABA IPL Section suggests that in situations where the

Examiner enters a new ground of rejection because the original rejection was not found persuasive by a panel during an appeal conference in the Technology Center, that any such new grounds of rejection be subject to approval by that same panel in the Technology Center. Furthermore, it is suggested that an appeal panel authorize any new grounds of rejection by an Examiner after remand by the Board. The reason for this suggestion is that appeal panels are more experienced with substantive technical issues involved in an appeal.

A minor change is suggested in paragraph (a)(1) relative to reference to sections 41.31 or 41.37, instead of sections 41.31-41.37. The ABA IPL Section further recommends that this rule be amended to clarify the manner in which the Director will notify the public as to the time within which the primary examiner will be required to furnish a written answer to the appeal brief.

§41.43 Examiner's Response to Reply Brief

These comments are presented regarding comments made in the background discussion of the proposed rules. The discussion relative to §41.43(a)(1) in the middle column on page 66654 of the Notice discusses situations that would not give an appellant the right to file a reply brief. The ABA IPL Section suggests that the discussion be changed to remove any such prohibition. Appellants should have the right to file a reply brief in any situation. The Office had an earlier procedure that specified situations in which reply briefs could be filed. This resulted in disputes and petition filings, where the examiner and the appellant disagreed as to whether the filing

of a reply brief was permissible. Current rules no longer prohibit the filing of a reply brief. This practice should continue, and appellants should always be permitted to have “the last word.”

§41.50 Decisions and Other Actions by the Board

The discussion regarding this proposed rule, in the middle section of the left column on page 66655 of the Notice, gives examples of situations where the Board may remand an appeal to the examiner. The ABA IPL Section suggests that these examples be deleted and that the Board in fact discontinue the practice covered by the examples. The Board is an impartial panel resolving disputes between appellants and examiners. No special consideration should be given by the Board to an examiner’s position. The Examiner must establish a *prima facie* case of anticipation or obviousness, which appellant must persuasively demonstrate to be in error. Just as the Board would not give appellant an opportunity to present a more persuasive traversal, the Board should not give an opportunity to the Examiner to more clearly meet his or her burden. If a *prima facie* case of unpatentability was not adequately made by the examiner, the rejection should be reversed.

Subpart C – Inter Partes Appeals to the Board

§41.66 Time for filing briefs

In this provision, the indication that, “if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so,” appellant’s brief will be due upon

“the expiration of time for filing (by the last party entitled to do so) such notice of appeal or cross appeal” is confusing. It is not understood how the appellant will know whether another party will file a notice of appeal on the last day when the time for filing expires. If a notice of appeal is then filed, the brief would be due two months later, whereas if it is not filed, it could be due on that day.

§41.68 Respondent’s brief

In Section (a)(4), the word “other” should be added to indicate that “[a] requester’s respondent brief may not address any brief of any other requester.” The requester should be able to refer to any arguments made in a previously filed brief by that same requester.

§41.69 Examiner’s answer

In this rule, the ABA IPL Section recommends that sections (b) and (c) be eliminated from the rule. The Examiner should not be required to reopen prosecution if he or she is persuaded by one side or the other that a rejected claim is in fact patentable or that a patented claim is in fact unpatentable. In an *ex parte* appeal, the Examiner may drop any ground of rejection when arguments in an appellant’s brief are found persuasive. Moreover, new grounds of rejection may be made in the Examiner’s answer in an *ex parte* appeal without reopening prosecution. The same standards should apply for *inter partes* appeals. Both the appellant and the requester should be

entitled to respond to the Examiner's new grounds of rejection, however, this can be done without reopening prosecution.

The Examiner's Answer in an *inter partes* appeal is more of a quasi-judicial statement than an absolute position as in the case of an *ex parte* appeal. Forcing reopening of prosecution when the Examiner has been persuaded by one party or the other would be a waste of time and resources. The same issues would remain in the appeal regardless of whether the Examiner supported them or not. Both sides would have to repeat their positions in repetitive filings, which would add unnecessary costs to the proceeding. Instead, the Examiner should explain to the Board in the Answer why he was persuaded one way or the other by the briefing filed.

In accordance with the above suggestion to eliminate sections (b) and (c), section (d) should be amended so that it is consistent. Section (d) should require that "any proposed new ground of rejection, or any proposed new determination not to make a proposed rejection, shall be stated by the examiner in a separate section of the examiner's answer, and shall include reasons why the examiner has been persuaded to propose such new ground of rejection or new determination not to make a proposed rejection, referring to the corresponding arguments in the requester's or owner's briefs."

Subpart D – Contested Cases

§41.105 Ex Parte Communications

This section proposes that an *ex parte* communication about a contested case with a “Board member or a Board employee conducting the proceeding is not permitted.” This rule is confusing as to what is “a Board employee conducting the proceeding.” If it is the intent of this rule to preclude contacting Board paralegals or staff to set up telephone conferences between counsel and a Board member, it is too restrictive and contrary to the current practice. This would similarly be a burden on Board employees since they would have to have counsel for both parties on the phone to discuss administrative details such as scheduling telephone conferences with the Board member. The ABA IPL Section recommends that the rule be modified by deleting “or a Board employee.”

§41.106 Filing and Service

In the Standing Order of the Interference Trial Section, double spacing is required. This proposed rule provides further formatting requirements and is favored by the ABA IPL Section. These requirements should eliminate the ability of practitioners to format a document to avoid page limits. These proposals should be adopted to put parties on equal footing in terms of the length of argument presented.

The ABA IPL Section suggests that the rule also include, as an alternative to meeting a page limit, a specific limit on the number of words. This would be similar to the requirements of the Federal Circuit for briefing.

§41.120 Notice of Basis for Relief

This provision states under (a) that a party may be required to file “a notice stating the relief it requests and the basis for its entitlement to relief.” Under (b), “a party will be limited to filing substantive motions consistent with the notice.” While (c) states that the notice may be corrected, the correction will only be entered “if entry would serve the interests of justice.” Since that requirement is not defined and vague, as well as the fact that the comments state that this subsection will “set a high threshold for entry of the correction,” it is difficult to determine how it will be applied. The ABA IPL Section suggests that the current practice of the Interference Trial Section with respect to lists of intended motions be adopted. Under current practice, a party may be allowed to file additional motions if good reason exists for late identification of the motion. Often, only in the preparation of other motions, is a certain issue identified. For example, not until the stage of preparing the motions, for example, are experts identified and consulted regarding issues in the interference. Such consultations often raise additional issues. Since an estoppel may apply if the issue is not raised and to eliminate piece-meal resolution of issues, a party should be entitled to contact the Board and request permission to revise the list to include additional motions. No prejudice to the opposing

party or delay would result in the proceeding since this revision would only be allowed prior to the due date for filing the motions.

Proposed rule §41.120(c) provides the same high standard for correcting a list of motions as for correcting a Preliminary Statement. The ABA IPL Section suggests that the higher standard for correcting a paper such a Preliminary Statement is not required for correcting a list of proposed motions. When the Preliminary Statement is filed, the fact finding regarding priority date should be completed. By contrast, when the list of motions is being filed, the fact finding is just beginning since the actual motions have not been prepared.

§41.121(b) Motions

This section proposes that the party filing a motion has the burden of proof to establish that it is entitled to the requested relief. This proposed rule correctly puts the burden on the moving party; however, it does not state the burden to be met. The ABA IPL Section recommends that the rule be amended to state, in accordance with legal precedent, that the burden of proof is a preponderance of the evidence unless otherwise stated.

§41.123 Time for Acting on Motions

This rule provides due dates for oppositions, replies and responsive motions. The default time for filing such papers is 30 days after service of the preceding paper.

This time period is very short, particularly if cross-examination of expert witnesses is required. The ABA IPL Section suggests that longer default time periods be given.

In addition, as now phrased, both oppositions and responsive motions would be due on the same date. The ABA IPL Section suggests that the rules provide for notice to be given that a party intends to file a responsive motion, e.g., as in §41.120. If responsive motions are to be filed, the time for filing oppositions could be reset so that all the oppositions, including those to the responsive motions, are due at the same time.

§41.155 Objection; Motion to Exclude; Motion in Limine

Provision (b)(1) of this proposed rule states that any “objection [to evidence] must be filed within five business days of service of evidence.” It is respectfully believed that this time period is too short and should be eliminated. The Board should have discretion to set an appropriate time period for objections, e.g., depending upon the type and volume of evidence being submitted. Alternatively, a minimum time period, for example, at least ten days, should be provided in the rule with the option given to a party to request additional time. In a priority dispute, for example, the amount of evidence submitted would be significantly higher than for an unpatentability motion. This should be recognized and provided for in the proposed rule.

Subpart E – Patent Interferences

§41.203 Declaration

This section defines interfering subject matter. This definition involves a “two-way test,” which asks whether the subject matter of a claim of one party would, if prior art, anticipate or render obvious the subject matter of a claim of the opposing party and vice versa. This test follows recent Board and Federal Circuit case law. However, the ABA IPL Section advocates a one-way test, in particular, in the situation where one party claims a species and the other a genus, and the species is filed first and would invalidate the later genus claims. This will prevent the issuance of an invalid patent, which is an important objective of the Office. Alternatively, the applicant or patentee with the species claims should be given the option to allow the interference to go forward with the opposing party’s genus claims. Since the species claims would be dominated by the genus claims, the inventor of the species should be allowed to prove priority over the genus claims in the Patent Office.

§41.204(a) Notice of Basis for Relief

This section defines the requirements of a priority statement. This section of the rule provides that the statement “must include all bases on which the party intends to establish its entitlement to a judgment on priority and must include documentary support for each basis when the documentary support is a unique record under the control of the party or its real party-in-interest.” This requirement appears to differ from the

current requirements of preliminary statements, for which notice of the earliest dates of conception and reduction-to-practice a party intends to prove is provided. If the intent of this proposed rule is to require a party set forth its entire priority case separate from a motion for judgment, The ABA IPL Section recommends that this section of the rule be deleted. Providing such proofs is a timely and costly burden on the parties. During Preliminary Motions, a party may have claims invalidated and/or the scope of the Claim may change. It does not make sense to require a party to put forth its entire case prior to the resolution of issues raised by Preliminary Motions. In the event that this proposed rule merely intends to continue the current practice of filing preliminary statements, the ABA IPL Section recommends that the proposed rule be revised to be consistent with current rules §§ 1.621-629.

§41.207(d) Presumptions

As stated in the comments regarding the proposed rules, this section of the proposed rule is completely new. This section sets forth a presumption of abandonment, suppression or concealment of interfering subject matter if the accorded date of the party's earliest constructive reduction to practice is more than one year after the party's actual reduction-to-practice. The ABA IPL Section does not agree with this proposal, and recommends the deletion of this section of the proposed rule.

Alternatively, the ABA IPL Section recommends that the time limit for the presumption be extended to at least eighteen months. A longer time before the presumption applies is supported by legal precedent. *See, e.g., Fujikawa v. Wattanasin*, 93 F.3d 1559,

1568-69 (Fed. Cir. 1996) (finding of no inference of suppression or concealment even though 2 years elapsed between actual reduction to practice and filing.

Deletion of the presumption is supported since the question of abandonment, suppression and concealment is extremely fact specific and should be decided on a case-by-case basis. It is unfair, in some areas of technology, to place this added burden on a party. In the comments regarding the addition of this requirement, it states that the proposed rule is “modeled after the one-year statutory bars (*e.g.*, 35 U.S.C. 102(b), 102(d), and 135(b)) and other incentives for prompt filing (*e.g.*, 35 U.S.C. 119(a) and 273(b)(1)).” Page 66666. The ABA IPL Section suggests that, since it is being modeled after statutory provisions, should this presumption be added, it should be made by statute rather than rule. There is no legal precedent which presumes abandonment, suppression or concealment based upon a one year period between actual reduction-to-practice and earliest constructive reduction-to-practice. Instead, legal precedent suggests a longer time period before abandonment, suppression and concealment is presumed.

§41.208(c)(4)(ii)(A) Content of Substantive and Responsive Motions

This proposed section would require, in a motion to broaden a count, that a party show that the proposed broader count “does not include prior art subject matter.” The ABA IPL Section suggests that this provision not be included in the rules. This requirement would require the moving party to prove a negative. Such showings are generally not required. See, *e.g.*, 1217 OG 17 Interference Practice - Interference

Rules Which Require a Party to "Show the Patentability" of a Claim (1998). The ABA IPL Section recommends that this provision be deleted. An opposing party may attack the proposed count on the basis that it is unpatentable in view of prior art. At that time, the moving party would have to show that the proposed broader count does not include the particular prior art subject matter. Having to show in the abstract that the broader count does not include prior art subject matter without a specific reference being cited would be next to impossible.

§41.208(c)(5)(i) Content of Substantive and Responsive Motions

This section of the propose rules would require a party to show in a motion to add a claim why the added claim "would be patentable in the patent or application" and thereafter states that the showing of patentability must "include" a showing of where the disclosure of the patent or application provides written description of the subject matter of the claim. This provision is somewhat confusing as written. It is presumed that this provision is meant to be consistent with current practice, where the showing of patentability necessary by the movant is merely a showing of written description. See, 1217 OG 17 Interference Practice - Interference Rules Which Require a Party to "Show the Patentability" of a Claim (1998). Since this proposal is confusing as written regarding whether a further showing is required, the ABA IPL Section suggests that the rule be revised to require only a showing of written description with the filing of the motion. Should the claim be attacked on other grounds, additional showings of patentability of the claim to the moving party must then be shown.

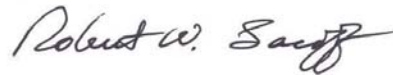
Director of the United States Patent and Trademark Office
January 30, 2004
Page 21

Conclusion

The American Bar Association Section of Intellectual Property Law appreciates the opportunity to comment on the proposed Rules of Practice Before the Board of Patent Appeals and Interferences. We thank the Office for providing this opportunity.

If there are any questions regarding these comments, please do not hesitate to contact me.

Sincerely,

A handwritten signature in cursive script that reads "Robert W. Sacoff".

Robert W. Sacoff
Chair
American Bar Association
Section of Intellectual Property Law