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By Email *BPAI.Rules@uspto.gov*

Attn: Linda Horner, Administrative Patent Judge  
Board of Patent Appeals and Interferences (BPAI)  
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Re: BPAI Rules of Practice in Ex Parte Appeals, in Response to  
Requests for Comment at 74 Fed. Reg. 67987 (Dec. 22,  
2009)

Dear Judge Horner:

The Boston Patent Law Association (“BPLA”) thanks the U.S. Patent and Trademark Office (“USPTO”) for the opportunity to comment on the USPTO’s Request for Comments on Potential Modifications to Final Rules (hereinafter “the Notice”). The BPLA appreciates that the USPTO is considering anew the Rules governing practice before the BPAI (final rule making published in the Federal Register (73 FR 32937) (Jun. 10, 2008), effective and applicability dates postponed). In particular, we appreciate that the USPTO is considering modifications to the Final Rules intended to reduce additional burdens placed on practitioners practicing before the BPAI in *ex parte* appeals.

The BPLA offers the following comments regarding the Notice and regarding the Final Rules in view of the potential modifications, in a desire to assist the USPTO. Our comments generally fall into three categories: (a) comments on the Final Rules relating to the Appeal Briefing requirements, (b) comments on the Final Rules relating to the acceptable timing of New Grounds of Rejection, and (c) comments on the Appeal Rules generally.

The BPLA is an association of intellectual property professionals, providing educational programs and a forum for the interchange of ideas and information concerning patent, trademark, and copyright laws in the Boston area. These comments were prepared with the assistance of the BPLA Patent Office Practice Committee.

These comments are submitted solely on behalf of the BPLA as its consensus view. The stated arguments, contentions, or positions do not necessarily reflect the views of any individual BPLA member, associated firm, or client of a member.

## **I. Introductory Comments**

The BPLA appreciates the Patent Office's attempts under the new administration to provide practitioners and applicants greater input into the rulemaking process. We appreciate the opportunity to work with the Patent Office on the BPAI Final Rules as well as other proposed rules packages. The BPLA thanks the USPTO for their efforts to revise several of the existing office practices and policies in a concerted effort to improve examination and reduce the pendency of both patent applications and appeals. Overall, the BPLA is appreciative for the apparent direction the Patent Office is moving.

Specifically, the BPLA appreciates that the Patent Office is considering modifications to the Final Rules governing practice before the BPAI as set forth in the Notice. In particular, we are in favor of modifications which may reduce the number of returns based on briefs determined to be "defective" and which delete certain sections of the final rule that place an unnecessary burden on Appellants appearing before the BPAI in *ex parte* appeals.

We note that the Office is also considering modifications to the Final Rules which may result in Appellant and Examiner more efficiently framing the dispute for the benefit of the Board and appeal conferees and, in particular, is considering anew portions of the Rules which speak to whether and/or at what stage in the Appeal new arguments and new rejections can be introduced.

We are aligned with proposed modifications that go to reducing the pendency of Appeals and appreciate that revised Rules may be needed to ensure that a complete record is before the Board prior to deciding an Appeal. We remain concerned, however, that certain aspects of the Final Rules, even with proposed modifications, may still place undue procedural and financial burdens on Appellants.

We therefore provide the following comments on proposed modifications to the Final Rules and, where appropriate, on the Final Rules in general.

## **II. Briefing Requirements**

The BPLA understands the need for the Board to have before it a complete record in an *ex parte* appeal and understand the significance of the appeal brief. We appreciate the effort on behalf of the PTO to clarify certain provisions of the rules governing appeal briefs and are pleased to see that some of the requirements for appeal briefs have been deleted (e.g., the requirements for the filing of a jurisdictional statement, a table of

contents, table of authorities, and statement of facts in reply briefs). These efforts are appreciated as they are perceived to reduce burden on Appellants.

We remain concerned, however, with the high number of briefs returned for alleged failure to comply with various briefing requirements. In the experience of several BPLA members, briefs are often returned for minor technical reasons and even on occasion have been returned improperly, for example, returning a brief for minor errors in the title of a section heading or for omitting one of the required appendices even where the brief is clear that there is no intended content for the appendix. This experience can lead to considerable delay between filing of the appeal brief and docketing of the appeal to the Board. The BPLA feels that this goal can most readily be achieved by reducing the procedural and formal requirements of the brief, without impacting the substantive quality of the briefs for review by the Board. Further efforts could also be made to more effectively train and monitor the appeal center specialists who are presently responsible for reviewing briefs for procedural requirements. This could potentially facilitate the appeal process moving forward in a more efficient manner, without undue delay based on technicalities.

Should the Board and the Office ultimately find it necessary to adhere to strict briefing requirements to ensure completeness of the record, it is suggested that careful consideration be given to balancing these requirements such that the burden is not unduly shifted to Appellants.

**A Requirement for a claim support and drawing analysis section - Bd.R. 41.37(r)**

The BPLA is particularly concerned with Bd.R. 41.37(r) that requires that an appeal brief contain a detailed “claim support and drawing analysis section.” Specifically, we are opposed to the requirement that Appellant map the support for claim limitations that are not at issue in the appeal. If at the time of the appeal, the meaning of, or support for, a certain claim limitation is not in question, it may be unnecessary, and potentially against Appellant’s interest, to be required to put on the record details about such claim limitations. During prosecution the Examiner is tasked with interpreting the claims, giving the claims the broadest reasonable interpretation consistent with the specification. The Examiner then proceeds with analyzing the patentability of such claims.

As the Board no doubt appreciates, claim interpretation in an enforcement context is a detailed and complicated analysis and the outcome of such a claim interpretation can have consequences of great magnitude. Any statements made regarding claim language could have significance and potentially result in harm to Appellant later in claim interpretation in an enforcement context. Therefore, it is our belief that Appellant should at most be required to describe the support for claim limitations at issue in the appeal, e.g., those relevant to rejections maintained during prosecution which are

appealed to the Board. There should be no requirement that Appellant map claim limitations that are not at issue in the appeal.

**B Arguments to explain Examiner error - Bd.R. 41.37(o) (Presumption of correctness)**

We understand that sections of the proposed Rules now include default outcomes for instances where Appellant allegedly fails to meet a certain briefing requirement. It has been proposed by the Office that these default outcomes will reduce the rate of returned appeal briefs. While we agree with the goal of reducing returned briefs, one of these defaults is of particular concern. Specifically, the BPLA is concerned with the proposed potential modification to the final rule which provides that the Appellant shall explain why the Examiner erred as to each ground of rejection to be reviewed. By default, unchallenged findings or conclusions made by the Examiner will be presumed to be correct.

The BPLA is troubled by this proposed Rule which could result, by default, in a substantive detriment to Appellant based on an alleged failure to meet a procedural requirement. Furthermore, we are not convinced that this “presumption of Examiner correctness” is in line with existing case law, and indeed it might effectively overrule established Federal Circuit precedent. In particular, the BPLA is concerned that Bd.R. 41.37(o), as now proposed, places on Appellants the burden of persuasion to show examiner error. While we accept that Appellants bear the *burden of identifying* specific Examiner errors, once an error is identified, the *burden of proving* unpatentability rests with the USPTO, and the USPTO must carry that burden to a preponderance of evidence. Appellants have no burden of persuasion. On appeal, if Appellant comes forward with either argument or evidence, the Board must review the case anew, considering all evidence and evaluating the relative persuasiveness of the arguments. The rules should make clear that Appellants have no burden to persuade the Board of error, only to identify error.

### **III. New Arguments and/or Grounds of Rejection**

We are aware, based on the USPTO Roundtable held January 20, 2010, that the Office is further considering whether new arguments should be permitted in Appellants’ briefs and whether new rejections should be permitted in the Examiners’ answers. In the experience of several of our members, new arguments are often necessary in the appeal briefs. For example, legal arguments may first be presented in the appeal brief that were not presented to the Examiner during prosecution due to time or cost constraints, or change in counsel. New arguments may be required in view of new case law or BPAI precedent not available during prosecution. New arguments may also be required to rebut an argument advanced in an Examiner’s answer. Such new arguments are necessary to ensure that a complete record is before the Board prior to deciding the appeal. It is also noted that Rules requiring the identification and special

treatment of new arguments may be difficult to carry out in practice and effectively misappropriate resources – expending resources on deciding whether procedural requirements have been sufficiently met rather than focusing resources on determining the actual merits of the case. Therefore, we are not in favor of any requirements for identifying new versus previously presented arguments.

Moreover, the BPLA feels that the opportunities for Examiners and Appellants to supplement the evidentiary record must be symmetric. For example, the Notice proposes to permit Examiners to add new references “as evidence of the prior statement made by the examiner as to what is ‘well-known’ in the art”. In each instance where Examiners are permitted to supplement the record, Appellants must have an equivalent right to adduce new evidence to show that an Examiner’s factual assertions are incorrect.

We are also aware from the Roundtable that the Office is further considering whether the Board should be allowed to introduce new grounds of rejection during the Appeal. We are of the opinion that restricting the Board from so doing could result in the record and treatment of the merits of the case on Appeal being incomplete, and therefore view this as necessary. This would also appear to be in line with the PTO’s obligations to raise new grounds of rejection when they are recognized. We suggest, however, that the Board do so most sparingly.

Moreover, we note that the decision by an Applicant to appeal is often a significant decision with considerable attendant costs. Often, Applicant is seeking to have the Board reverse an incorrect or intractable position taken by an Examiner during prosecution. Accordingly, we are of the opinion that the Rules should promote sparing and timely use of remand by the Board.

Lastly, the BPLA feels that the PTO must continue to focus on “compact prosecution” incentives to encourage Examiners to examine cases completely and raise rejections at the earliest time possible. This, in turn, would reduce the likelihood that the Board would have to introduce “new” grounds of rejection at the appeal stage. Moreover, Appellants must have appropriate procedural safeguards and ample right to respond to any new grounds of rejection raised by the Board during the appeal.

#### **IV. General Comments**

In general, we feel that the appeal process must be readily practicable by the routine practitioner. It is the experience of at least some of our members that only a select number of cases warrant the filing of an appeal, and this is most often accomplished by the routine practitioner responsible for the underlying prosecution of a case. As such, we believe the Office should refrain from Rules which promote overly rigid formal requirements that do not substantially enhance the Board’s decision-making process. The briefing requirements should not be onerous, and waiver of the requirements

should be available except where procedural deficiencies affect the Board's ability to effectively reach and decide the merits of an appeal.

Members of the BPLA also expressed interest in having access to statistics regarding the most common reasons underlying the return of briefs. Moreover, it is suggested that practices believed by the Board to improve the quality of the record on appeal may be presented in the form of a guidance document to practitioners where these practices are not formal requirements found in a Final Rule. Lastly, it is requested that if the Office or the Board has data evidencing a critical nature of any of these practices, such information be shared with practitioners in order to more fully understand positions taken by the Office and Board with respect to the Final Rules.

Thank you for consideration of our comments.

Sincerely,

Boston Patent Law Association

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