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**Sent:** Friday, February 26, 2010 5:33 PM  
**To:** BPAI Rules  
**Cc:** infiniteprogrss@comcast.net  
**Subject:** Comments on Rules of Practice in Ex Parte Appeals Before the Board of Patent Appeals, Advanced Notice of Proposed Rule Making

February 26, 2010

**Via Email**

The Honorable David J. Kappos  
Under Secretary of Commerce for Intellectual Property and  
Director, United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22314

Subject: Rules of Practice in Ex Parte Appeals Before the Board of Patent Appeals  
and Interferences in Ex Parte Appeals, Advanced Notice of Proposed  
Rule Making

Dear Director Kappos:

For the reasons given herein, I am compelled to submit these comments regarding the Board of Patent Appeals and Interferences' Rules of Practice in Ex Parte Appeals, Advance Notice of Proposed Rulemaking, published on December 22, 2009. I am commenting in the capacity of a prolific patent attorney in my individual capacity, and not on behalf of any particular client. Having a 10 year old son, I am also commenting as a citizen concerned, especially, with the opportunities for venture funded startups and/or self-funded startups to get the patent claim scope coverage they deserve at the earliest possible date when they are entitled to it. I do not believe it is good for the health of our economy or nation for inventors to go through endless rounds of prosecution, continuations, and appeals to achieve, after 7 years, what they should have obtained at year one. It is my hope that my son will someday be one of the principals of those venture funded companies, so I have a personal long-term stake in making sure the present proposed rules are all withdrawn.

I will not mince words here: the proposed rule changes are a **HOLDOVER REFLECTIVE OF THE LAST FAILED REGIME** and appear to be **CALCULATED TO MAKE LEGITIMATE PATENT APPLICANTS ATTRIT BY RUNNING OUT OF MONEY** as they try to function within the unjust system created by the rules (thereby eliminating the huge BPAI backlog which is the direct consequence of the BPAI's current malfeasance). Director Kappos, **YOU HAVE**

TAKEN ON THE HERCULEAN TASK OF CLEANING UP THE MESS LEFT TO YOU/US BY THE LAST FAILED REGIME. Please do not compound the already extreme difficulty of your work by allowing the proposed unjust rules to create yet another GSK-Tafas v. Dudas like fiasco (the patent bar will sue to block these rules).

I observed the BPAI Roundtable on these rules, and I note that NONE of the industry luminaries present thought that there was any need for any of the proposed rule changes. Please follow the will of your customers and withdraw all of these ill-considered rules and instruct the BPAI to start following CAFC law (e.g., ensuring that examiners carry the burden of establishing prima facie unpatentability, sending bad examination back to examiners for rework if they don't meet such a burden).

If the BPAI abandons its current course of malfeasance of rubber-stamping/rehabilitating bad examiner behavior, and instead returns to its pre-Whealan-Doll roll of serving as a check on egregiously bad examiner behavior, the BPAI backlog will take care of itself as examiners pull their bad rejections off appeal and issue the claims, as was done in the pre-Whealan-Doll era when the BPAI performed its traditional gatekeeper function.

My comments will be brief and to the point. I will identify specific rules and explain how their true purpose is to make legitimate cost-sensitive patent applicants attrit by running out of money, thereby reducing the BPAI's self-created backlog. This is WRONG and I appeal to you to stop this.

### **Bd. R. 41.37 Appeal Brief**

Bd. R. 41.37(g) Statement of Related Cases: This rule seems *calculated to drive up costs so as to make applicants attrit through lack of resources*. For instance, buried in the middle of the rule is the requirement to disclose "by application, patent, appeal, interference, or court docket number all prior or pending appeals, interferences or judicial proceedings ... related to, directly affect, or would be directly affected by, or have a bearing on the Board's decision on appeal." This requirement is so over-broad and vague so as to make likelihood of inequitable conduct charge later on down the line virtually certain. Accordingly, patent applicants and attorneys will be forced to spend hours trying to comply, and, given the enormous downside of inequitable conduct, enormous over disclosure and burden on the BPAI is likely to result. Please withdraw this ill considered rule. The patent attorney already has a Duty of Candor under his State Bar and PTO Professional Conduct Rules. I beseech the PTO to withdraw these ill-considered anti-inventor, anti-small business rules.

**Bd. R. 41.37(o), (o) (1), and (o) (2) Argument:** These illegal rules are contrary to the Patent Statute and CAFC precedent, *and appear to be intended to make patent applicants attrit through lack of resources*. The Patent Statute and CAFC prima facie case precedent has set the BPAI up to protect patent applicants from all-powerful patent examiners who act as prosecuting attorney, judge, and jury in their own cases. This rule converts what should be a protector and champion of the patent applicant into his torturer and ultimately executioner. The rule's requirement that the patent applicant address all statements of the patent examiner, no matter how trivial or

incorrect, else such challenges are waived coupled with the patent attorneys' ethical duties and malpractice concerns seem perfectly calculated to drive up costs and make all but the most wealthy of companies attrit. The presumption of examiner corrects contravenes all practical experience with patent examiners. I beseech the PTO to withdraw these ill-considered anti-inventor, anti-small business rules.

Parts of these illegal rules state that if a patent applicant argues two or more claims together, the board can ignore the claim argued and select a different claim from the group upon which it can decide an appeal – this is a BAD idea, and deprives applicants of skilled counsel's arguments. Parts of these illegal rules state that merely stating what a claim says is not considered an argument for patentability, which is directly contrary to law and all practical experience with patent examination: applicants should be able to point out what a claim says as reason for patentability, especially if an examiner ignored claim language during prosecution, since such is all that would be necessary to establish patentability. I beseech the PTO to withdraw these ill-considered anti-inventor, anti-small business rules.

**Bd. R. 41.37(r)-(s) Claim Support and Drawing Analysis Section/Means or Step Plus**

**Function:** These illegal rules are contrary to the Patent Statute and CAFC precedent, and appear to be intended to make patent applicants attrit through lack of resources and/or to force patent applicants to make damaging admissions against interest when there is no reason to do so. The attempted required “mapping” of the claims to the detailed description runs counter to all patent attorney training and their duties of zealous advocacy. Actually requiring the patent applicant to do a partial claim interpretation of the means-plus-function claims is arguably patent attorney malpractice under almost any analysis framework. Accordingly, the PTO can expect the patent bar to fight back, hard, against these illegal rules, and accordingly the massive inefficiencies for the office and patent applicants that will arise therefrom.

Also, the patent applicant's sole duty during the patent process is to pursue valid claims in light of known prior art. It is the PTO's duty to interpret the claims if they allege unpatentability. So this rule is contrary to law and likely to generate massive inefficiencies for the office and costs for the applicant – which is likely the intent, since these rules appear to be intended to make the smaller inventors attrit. I beseech the PTO to withdraw these ill-considered anti-inventor, anti-small business rules.

**Bd. R. 41.39 Examiner's Answer + Bd. R. 41.50 – Decisions and other actions by the Board:**

This deadly combination of rules is anti-small inventor/anti-small business/anti-entrepreneur and seems overtly constructed to make patent applicants attrit through lack of resources. Although it may not be readily apparent to the PTO, small inventors, businesses, and entrepreneurs need some of the most expensive legal talent. This is because the IP can be critical to building up the underlying business, so they need the best. Every time such legal talent has to “touch” an in process patent application, the bill ranges from a low of around 2K to a high of about 8K. This proposed rule allows an examiner to do shoddy examination at the start, and to do more or less continuously new prosecution throughout the process, with the BPAI administering the coup de grace at the end. For example, what should be one office action with one response – about a 6K bill at mid-range for a complex e-commerce application and moderately priced legal talent,

easily becomes 4 rounds of prosecution under this deadly combination of rules: shoddy first Office Action, Final Office Action, Examiner's Reply Brief, and Finally the Board Decision with new grounds, for, conservatively, a 24K bill. What a convenient way to make those most deserving of patent protection to attrit from the system. I beseech the PTO to withdraw these ill-considered anti-inventor, anti-small business rules.

In summary, Director Kappos, instead of implementing the proposed rule changes, I urge the USPTO to indefinitely delay/withdraw their implementation, and, instead, to continue pursuing the solid reform process you introduced last year.

Sincerely,

Dale R. Cook, in his individual capacity and not on behalf of any client past/present.  
PTO Reg. # 42434  
Texas State Bar: 04724500 (active);  
Washington State Bar: 31634 (active).