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**VIA EMAIL: [bpai.rules@uspto.gov](mailto:bpai.rules@uspto.gov)**

USPTO Mail Stop INTERFERENCE  
Director of the United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sirs:

Please consider the following comments in connection with the December 22, 2009 Advanced Notice of Proposed Rule Making (“Notice”). Kindly attribute these comments only to myself, as I am not writing on behalf of any other person or entity.

As an initial matter, the undersigned acknowledges and appreciates the efforts of the PTO in responding to the many comments and concerns expressed in response to the rules as originally promulgated in 2007.

Nonetheless, there remain concerns with the amended rules. First, proposed Rule 41.56, which provides for “sanctions,” should not be adopted. This rule suffers from a number of serious drawbacks that have not been addressed by amendments to the rule or by the associated PTO commentary.

Second, the PTO should modify and limit Rule 41.37(r) and (s). These rules should require appellants to provide the analyses required by these rules only for those claim elements that are directly at issue on the appeal. The rules should not require appellants to do so for other claim limitations not specifically discussed in the appeal. Also, under Rule 41.37(r), it is unduly burdensome to require identification of every place in the specification where a particular claim limitation might find support. The purpose of this rule is to educate the Board on the nature of the claimed subject matter. For this reason, the PTO should amend this rule to clarify that reference is required to exemplary support in the specification, in a manner sufficient to educate the Board.

Finally, the rules should require the Examiner and the Board's clerical staff to accept a brief if the brief substantially complies with the clerical requirements of the rules.

If the PTO does not withdraw Rule 41.56 or amend Rule 41.37 as indicated herein, I would appreciate it if the PTO answered the numbered comments below.

### **RULE 41.56**

The PTO earlier promulgated Rule 41.56 in its 2007 rulemaking notice.<sup>1</sup> Although the PTO received many comments concerning the scope and applicability of this rule, the PTO did not respond to most of the comments. The Notice attempts to address some, but not all, of the earlier comments, but in doing so introduces new issues.

#### **Comment 1: Rule 41.128 does not provide a comparative analogy.**

As an initial matter, the Notice points out that existing Rule 41.128 contains provisions that are similar to those in proposed Rule 41.56. The Notice suggests that rule 41.56 is merely an attempt at bringing conformity to the rules as between *ex parte* and *inter partes* procedures. Respectfully, this assertion lacks merit. The *inter partes* proceedings under Rule 41.128 are different in kind from the *ex parte* proceedings covered by Rule 41.56. The specified grounds for sanctions ("frivolous request for relief," etc.) have no meaning in *ex parte* proceedings. Also, as discussed further below, the commentary on Rule 41.56 has introduced new ambiguities that affect both proposed rule 41.56 and existing rule 41.128.

#### **Comment 2: Rule 41.56 solves no identified problem**

One principal problem with rule 41.56 is that it is a solution in search of a problem. What is the need for this rule? The Notice itself points out that existing provisions of the CFR provide authority to impose procedural sanctions, and that rule 41.56 "merely makes clear that the Director's existing 37 CFR 11.18 authority to impose procedural sanctions extends to ... an *ex parte* appeal." But if the authority for imposition of procedural sanctions is already clear, why then is there a need for a new rule? On its face, the new rule does much more than clarify the existing authority of the director. Why pass a new rule if the PTO intends only clarification of an existing rule?

The Notice (but, significantly, not the text of the rule itself) states that the rule is meant to be employed only in "egregious cases." How many cases of egregious misconduct occur each year? Have there been cases that the existing ethical and

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<sup>1</sup> I submitted comments on September 24, 2007. See [http://www.uspto.gov/web/offices/pac/dapp/opla/comments/bpai/a\\_hoover.doc](http://www.uspto.gov/web/offices/pac/dapp/opla/comments/bpai/a_hoover.doc).

procedural rules fail to adequately address, such that a new rule is required? If indeed the rule merely makes clear the Director's existing authority, why doesn't PTO simply put out a notice to this effect? In other words, if this is all that the PTO intends, what does the new rule add?

If the PTO continues to promulgate this rule, the PTO is requested to clarify the following, as I believe is required by the Administrative Procedure Act and Paperwork Reduction Act:

- **Comment 3:** Can the PTO provide examples of specific instances of past applicant "misconduct" that justify the need for this rule? Specifically, have there been instances when the Board has perceived there to be "misconduct," but for which no relief was available to the Board because of the absence of such rule? If there exist such cases, why were the existing procedural and ethical mechanisms insufficient?
- **Comment 4:** Is the PTO willing to amend the rule itself (as opposed to only the accompanying commentary) to clarify that the rule applies only in cases of "egregious misconduct"?
- **Comment 5:** If indeed the rule merely makes clear the Director's existing authority, why doesn't PTO simply put out a notice to this effect? In other words, why is a new rule needed to announce authority that is already in the existing rule? How does Rule 41.56 avoid the problems of divergent interpretations that attend redundant laws?
- **Comment 6:** What experience, if any, does the PTO have with Rule 41.128? How many cases of "misconduct" have been found under this rule, and what was the result for the application in question? What result was there for the attorney or agent involved?

**Comment 7:           The designation "misconduct" is improper.**

Another serious flaw in the rule relates to the designation "misconduct." "Misconduct" is a loaded term, and, significantly, this term has ethical connotations for attorneys and agents. By the time an appeal is prosecuted before the Board, in almost all cases, the applicant is represented by a registered attorney or agent. A finding of "misconduct" can have serious personal ramifications for the practitioner, particularly where the practitioner is an attorney. Even if the PTO assesses a penalty against the appellant, actions of the attorney almost always will have created the misconduct.

If the PTO has labeled an attorney's actions "misconduct," this might have serious personal ramifications for the attorney. The attorney might have to report the purported misconduct to the OED or to the attorneys' state licensing authority, or to his

or her malpractice carrier. At a minimum, a finding of misconduct will reflect poorly on the attorney.

For this reason, it should be expected any attorney charged with misconduct under rule 41.56 will attempt to seek to overturn such finding. This would be so *even in cases where the patent has issued* despite the purported misconduct.

- **Comment 8:** To what extent do the misconduct rules supplement the applicable rules of ethics for attorneys under state law, or under the PTO's rules of practice?
- **Comment 9:** Is it possible for an attorney to commit "misconduct" without running afoul of the ethical rules? That is to say, does Rule 41.45 define a new category of conduct, one that could be called "ethical misconduct"? If so, I ask the PTO to provide examples of Rule 41.56 attorney misconduct that would not rise to the level of an ethical violation.
- **Comment 10:** It would seem that the same effect could be achieved without calling the actions in question "misconduct." Couldn't the goals of the proposed rule be accomplished without labeling such activity "misconduct"? In other words, couldn't the rules simply say "an applicant who fails to timely file an appeal brief will have his or her appeal dismissed," without referring to such activity as "misconduct"? What does the term "misconduct" add?
- **Comment 11:** If the PTO passes some form of sanctions rule, would the PTO consider substituting a different term instead of the loaded term "misconduct"? Even if the PTO made no changes other than to rewrite the existing rule without the "misconduct" appellation, this would improve the rule.

**Comment 12: The lack of any apparent intent requirement is problematic.**

Another fundamental problem with rule 41.56 is the lack of clarity as to the intent required to trigger a finding of misconduct. As written, the rule contains no apparent intent requirement – unique among the rules of practice that govern attorneys. Is the rule a strict liability rule? What level of intent is required before "misconduct" would be found? While the Notice speaks of egregious activity, this language is not in the rule itself.

For instance, one of the specified grounds for "misconduct" is "failure to comply with an applicable rule." Many failures to comply with the rules are inadvertent or innocuous, and not worthy of the "misconduct" label. For instance, Rule 41.37(e) mandates certain headings in appeal briefs. If an attorney inadvertently omitted one of the headings, this would be a "failure to comply with an applicable rule." As a matter of

present practice, an attorney who mis-formats a brief will receive a notice to correct the brief and an opportunity to file a corrected brief, and will simply re-file a corrected brief.

Yet under the text of Rule 41.56(a)(1), the Board could deem this inadvertent omission “misconduct.” And while the comments to the rule suggest that the rule would have more limited application, the plain text of the rule is not so limited. One can envision a future Board taking the position that these comments are not binding, and imposing sanctions for innocuous and trivial rule violations. Certainly, it is easy to envision a finding of misconduct for something less than egregious bad acts.

- **Comment 13:** What is the intent requirement for a purported violation of rule 41.56?
- **Comment 14:** Would the PTO consider amending the rule to specify a level of intent? Nobody would seriously question that punishment would be appropriate for instances of intentional flaunting of the rules. Can’t the rule be amended to be limited to intentional bad acts? If not, why not?
- **Comment 15:** Will a finding of “misconduct” be made in cases where an attorney or applicant inadvertently violates a rule? If not, can the PTO so amend the rule?

Under present practice, minor clerical problems with appeal briefs are dealt with via a notice an opportunity to correct. Does the Board intend to continue this practice? Can the PTO confirm that the Board does not intend to find “misconduct” in such cases?

**Comment 16: Rule 41.56 provides no standards for application**

Another fundamental problem with rule 41.56 relates to the standards by which sanctions would be imposed. The notice indicates:

Whether and what sanction, if any, should be imposed against an appellant in any specific circumstance would be a discretionary action.

This paragraph provides insufficient notice as to the standards by which sanctions should be imposed. What exactly does the Notice mean by a “discretionary action”? Other ethical rules and standards provide strict guidelines under which misconduct might be found. Interpretation issues arise even under the well-established rules of professional conduct, which have been in development for decades. Under Rule 41.56, a brand new rule, there is no guidance in the rule or associated commentary as to when sanctions should be issued, nor is there a body of case law that could provide guidance.<sup>2</sup> If

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<sup>2</sup> In the previous round of rulemaking, the PTO indicated cryptically that “precedent of a court [in the context of Rule 11] may or may not be helpful” for providing guidance in this respect.

unbridled discretion is the standard, it is difficult to see how Rule 41.56 could survive a due process challenge.

- **Comment 18:** What is meant by “discretionary action”?
- **Comment 18:** Given the serious sanctions available against an appellant and his attorney (abandonment of an application; potential ethical problems for the attorney), aren’t there “fair notice” and due process problems with Rule 41.56 under a discretionary standard? How does the PTO intend to address such problems?
- **Comment 19:** What limits, if any, does Rule 41.56 place on the discretion of the particular panel of the Board? Does any other provision of law limit the Board’s discretion?
- **Comment 20:** What training, if any, will the PTO provide to members of the Board to determine how the Board should exercise discretion in evaluating misconduct?
- **Comment 21:** Will the PTO or the Board implement any limits on, or standards for, the discretion to impose sanctions?
- **Comment 22:** Will the Board publish guidelines for its exercise of discretion? Until such publication, how will the public know what guidelines to follow?
- **Comment 23:** What change, if any, does the PTO contemplate to existing appeal practice via the discretionary ability to grant sanctions?

It is easy to see that unfettered discretion is not a proper standard for a determination of misconduct. This is especially truly in light of the potential ramifications of a finding of misconduct, which are very serious.

**Comment 24: The application of misconduct rules in other contexts is not relevant.**

In response to a comment in the previous rulemaking notice, the PTO stated that “Courts and other agencies have administered sanctions rules without any apparent difficulty.” This statement is off the mark. The experience of courts and other agencies is with well-defined rules of ethics that have been in place for decades and refined over time, guided with a large and well-understood body of precedent. No court or ethical

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rules are as vague as Rule 41.56. No court or agency rules specify that a tribunal may find misconduct as a matter of “discretion.”

Note that even with the wealth of guidance available from the rules themselves and from the body of case law under the rules, questions still arise frequently as to interpretation and application. State bar associations and other entities have such things as ethics “hotlines” (telephone access to ethics professionals, who can give guidance in this area).

**Comment 25:**           **The stated grounds for misconduct are vague, partially redundant to existing rules, and partially inconsistent with other rules.**

**Comment 25a:** The specific grounds of misconduct specified in the appeal also are vague. For instance, rule 41.56(a)(1) specifies that an appellant may commit misconduct for failure to comply with an order entered in the appeal. If an appellant doesn’t obey an order, won’t this already lead to an outright dismissal of the appeal under the existing rules?

**Comment 25b:** As discussed above, another ground for misconduct is failure to comply with an applicable rule. Again, don’t existing rules already cover this? If an applicant fails to comply with an appeal rule, the Board will dismiss the appeal (unless the applicant corrects the error). Why does rule 41.56 suggest that some lesser sanction might be applied? Why is any new rule needed at all in these situations?

**Comment 25c:** Rule 41.56(a)(2) specifies that advancing a misleading or frivolous “request for relief” is grounds for sanctions. In an *ex parte* appeal, essentially the only relief that an appellant may seek is the reversal of the Examiner. What exactly might constitute a frivolous “request for relief” in an *ex parte* appeal? Can the PTO provide an example?

**Comment 25d:** This rule also specifies that advancing a frivolous argument would be grounds for sanctions. Again, if an argument is deemed “frivolous,” the Board will reject it. Thus, doesn’t existing procedure adequately address frivolous arguments? Also, what exactly would constitute a frivolous argument? Who would decide whether an argument was frivolous, and under what standards?

**Comment 25d:** Rule 41.56(a)(3) specifies that engaging in “dilatory tactics” is grounds for sanctions. This is perhaps the most confusing ground of all. In an *ex parte* appeal, all deadlines are set by rule, and failure to comply with these rules leads to automatic dismissal of the appeal. What, then, does the rule contemplate by “dilatory tactics”?

The “dilatory tactics” language would be redundant, unless it applied to appellants who *were timely under the rules but deemed nonetheless to be dilatory* in the discretion of a particular panel of the Board. Does the PTO intend for the Board to be able to say that a particular applicant has been “dilatory” even if the appellant’s filings are timely under the rules? If not, what does “dilatory tactics” mean?

Under the present rules, an appellant who fails to meet the deadlines will face dismissal of the appeal. Is the PTO now allowing that some lesser sanction might be imposed?

**Comment 25d:** I request a specific example of what might constitute “dilatory tactics” in an *ex parte* appeal. If an applicant used all available time for filing an appeal brief, could the Board deem that “dilatory”?

This rule is particularly problematic in light of the stated standard for imposing sanctions, the “discretionary action” standard. Consider two appellants who each wait until the very last day to file their opening briefs. Does the rule contemplate that, as a matter of discretion, the Board might punish one of those appellants for misconduct?

**Comment 25e:** Are there other grounds for misconduct, beyond those explicitly specified in the rule? If so, what other grounds exist?

**Comment 26:**           **The lack of procedure is problematic and inconsistent with the OED’s rules and with the Administrative Procedure Act, and with due process.**

Yet another problem with Rule 41.56 relates to the lack of any specified procedure for the imposition of sanctions, and the lack of any appeal mechanism. Indeed, in the previous rulemaking notice, the PTO stated “*Generally*, sanctions are not applied without giving an appellant an opportunity to explain and justify his behavior.” This language expressly reserves the right to apply sanctions without notice in particular cases. This easily could be a violation of procedural due process, particularly for the imposition of unspecified sanction for an unspecified violation, imposed as a discretionary matter. Also, if the PTO were to impose sanctions for attorney misconduct, this arguably would be inconsistent with 35 U.S.C. 32, which provides for exclusion of practitioners in any particular case only after notice and an opportunity to be heard.

Also, how would an appellant (or the attorney) appeal a misconduct finding? The appellant will already be at the Board of Appeals, and there exists no superseding body within the PTO to whom to appeal. It is unclear whether Rule 41.56 comports with the Administrative Procedure Act. *See, e.g.*, 5 U.S.C. 706(2)(D) (requiring courts to set aside agency action found to be “without observance of procedure required by law”).

The OED provides well-defined procedural mechanisms for investigation of, responses to, and appeal of misconduct allegations. See 37 C.F.R. 10.23 (proscribing “misconduct”); *see also* 37 C.F.R. 10.130-10.170 (establishing investigation, response, and appeal procedures). A finding of misconduct under Rule 41.56 conceivably could lead to OED sanctions, but without the procedural safeguards provided by the OED’s rules.

Rule 41.56 thus is inconsistent with the OED’s procedural rules, especially Rule 10.23. If the OED seeks a finding of misconduct, the rules specify many procedural safeguards. But if the Board deems that an attorney has committed misconduct, there are no safeguards – not even a guarantee that the appellant will be provided with prior notice. Even if the rule is written to specify something other than misconduct, the lack of any procedure is concerning.

Also, because “misconduct” in most cases will be found for actions of the attorney, Rule 41.56 appears to violate the Administrative Procedure Act. Title 5 U.S.C. 558(c) provides:

Except in cases of willfulness or those in which public health, interest, or safety requires otherwise, the withdrawal, suspension, revocation, or annulment of a license is lawful only if, before the institution of agency proceedings therefor, the licensee has been given--

- (1) notice by the agency in writing of the facts or conduct which may warrant the action; and
- (2) opportunity to demonstrate or achieve compliance with all lawful requirements.

Under Rule 41.56, the Office has expressly reserved the right to find “misconduct” – an action which could lead to suspension of an attorney’s license – without notice or opportunity to comply.

In *Halvonik v. Dudas*, 398 F. Supp.2d 115 (D.D.C. 2005), *aff’d* 192 Fed. Appx. 964 (Fed. Cir. 2006), *cert. denied*, 549 U.S. 1305 (2007) the court held that permission to practice before the PTO was a “license” under 35 U.S.C. 558. *Id.* at 124 n. 16. The court rejected Mr. Halvonik’s 558(c) challenge to the PTO’s procedure, because the PTO had followed the well-established procedures of the Office of Enrollment & Discipline, *including prior notice* to Mr. Halvonik. In contrast, the Board has reserved the right to impose Rule 41.56 sanctions without prior notice.

If an attorney is found to have committed “misconduct,” and is subsequently investigated by the OED, how could the OED comply with 5 U.S.C. 558? Consider a case of egregious attorney misbehavior. How could the OED take action against the attorney, if the misconduct had been announced by the Board without prior notice or

opportunity to respond? Wouldn't a court be required to reverse any such suspension under 5 U.S.C. 706(2)(D)?

- **Comment 27:** What procedural safeguards against the granting of sanctions are to exist?
- **Comment 28:** Will the PTO consider amending the proposed rule to specify that sanctions are to be awarded *only* after notice and an opportunity to comment? If not, why not?
- **Comment 29:** Will the PTO provide any mechanism for appealing a finding of misconduct? If not, what remedy does an applicant have?
- **Comment 30:** Absent provisions for notice, the opportunity to respond, and a mechanism for appeal, aren't there procedural due process concerns with this rule? It would seem that a rule that allows sanctions to be awarded without prior notice, as a matter of mere discretion, could hardly comport with procedural due process. Also, wouldn't the imposition of sanctions sometimes violate 35 U.S.C. 32? How does the PTO propose to address those concerns?
- **Comment 31:** Doesn't Rule 41.56 violate the Administrative Procedure Act? If not facially, wouldn't Rule 41.56 as applied in many cases violate the Administrative Procedure Act?

**Comment 32:**           **The specified sanctions are *ultra vires*.**

Another problem relates to the specified sanctions under Rule 41.56. The PTO lacks the statutory authority to impose sanctions under the rule as written.

As the Federal Circuit has made clear several times, most recently in *Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir. Jan. 7, 2010), the PTO “does not have the authority to issue substantive rules, only procedural regulations regarding the conduct of proceedings before the agency.” *Id.* at 6, *citing Wyeth v. Dudas*, 580 F. Supp. 2d 138, 141 (D.D.C. 2008). In some cases Rule 41.56 creates sanctions that are beyond the authority of the Board.

If an appellant has complied with the statutes and rules governing appeals, but has done something that the Board in its discretion feels merits sanctions, the appellant nonetheless is *entitled*, by statute, to have his appeal heard. *See* 35 U.S.C. 134 (“An applicant for a patent, any of whose claims has been twice rejected, *may appeal* from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal”); 35 U.S.C. 6(b) (the Board “*shall*, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents”). Rule 41.56 and its list of sanctions state otherwise, and to this extent the rule is contrary to statute.

For instance, if the appellant has advanced a frivolous argument, the Board is not somehow entitled to dismiss the appeal outright. Nor would the presentation of a frivolous argument entitle the Board to fail to enter a docketing notice for the appeal (which apparently would *de facto* terminate the appeal), or to enter the other specified sanctions. If the Board deems an argument to be frivolous, it can, of course, reject the argument and affirm the Examiner. But that is the Board's only option. The Board does not have authority to terminate the appeal, to enter other sanctions that would have the same effect, or to do anything else.

Likewise, an appellant whose filings are timely under the rules, but whom the Board nonetheless deems "dilatory" in some respect, still is entitled to have his appeal heard. The Board cannot dismiss the appeal or impose equivalent sanctions. This rule is particularly troubling under the "discretionary action" standard announced in the Notice. The Board does not have discretion to declare someone "dilatory" and to refuse to hear the appeal. The Board can (and indeed must) dismiss an appeal if the appeal brief is untimely, but the Board does not have other, unspecified discretion to dismiss an appeal if the briefs are timely filed within the rules.

Other sanctions specified in the rule are equally dubious. It is unlikely that the Board has authority to expunge papers that have been timely filed, or to exclude evidence, or to preclude an appellant from contesting issues properly raised in the appeal.

The Notice states that earlier comments on Rule 41.56 were "based on the mistaken premise that the final rule creates totally new misconduct sanctions." But this is not a mistaken premise. The plain text of the rule does indeed create new sanctions. Most of the specified sanctions – e.g., failure to enter a docketing notice, holding facts to have been established, expunging papers – are indeed new.

**Comment 33: Rule 41.56 fails to provide notice of what other sanctions the Board might impose.**

Another problem is that Rule 41.56 is ambiguous in that it does not identify whether other sanctions might be available. Does Rule 41.56 provide for other sanctions in addition to those expressly specified? What other sanctions might the Board impose, and in what circumstances?

**Comment 34: The Board does not have jurisdiction to impose sanctions.**

Another problem with the rule is that the OED, not the Board, has authority to make a finding of misconduct against a registered practitioner. Title 35 U.S.C. 6(b) specifies the duties of the Board, and indicates that the Board's roles are to handle appeals and interferences. This statute does not provide the Board with authority to impose sanctions.

**Comment 35: The PTO has not complied with 5 C.F.R. 1320.8(a)(4).**

In an earlier letter to the Office of Management & Budget, I estimated the paperwork burden for Rule 41.56 to be in the tens of millions of dollars, possibly exceeding \$100 million. Before passing Rule 41.56, the PTO must provide, pursuant to 5 C.F.R. 1320.8(a)(4), a specific and objectively supported estimate of the burden of Rule 41.56.

In summary, Rule 41.56 the rule and accompanying comments purport to allow the Board to impose one of many sanctions (including sanctions not specified), for any number of violations (including violations not specified), with or without notice, and in the apparent unbridled discretion of the Board. Nobody would question the PTO's authority to deal with bad acts, but the rule as written encompasses a much broader scope of conduct. The rule provides no procedural framework under which the Board might find misconduct, and provides no opportunity for appeal. It appears that Rule 41.56 violates other provisions of the patent statute, is inconsistent with well-established rules of the OED, violates the Administrative Procedure Act, violates the Paperwork Reduction Act, and raises serious due process concerns. In short, this is a bad rule.

If the PTO is to pass a new misconduct rule, the PTO should expressly limit the rule to egregious cases of intentional misconduct. Better yet, because it is clear that the existing mechanisms of the PTO are equipped to deal with such matters, the PTO should scrap rule 41.56 altogether. I urge the PTO to drop this rule.

**RULE 41.37**

The PTO should revise rules 41.37 (r) and (s) in two respects. These rules should be applied only to claim elements at issue in the appeal. The PTO should amend rule 41.37(r) to require identification of exemplary support, in a manner sufficient to educate the Board on the technology in question.

**Comment 36: Rule 41.37(r) should apply only to claim elements in dispute, and should require exemplary support.**

This rule continues the existing "claims mapping" requirement. The undersigned has prosecuted many appeals, and under the present rules has had many times to attempt to map the claims to the specification. In my experience, this process has been very time consuming, and it is difficult to see how the resulting product could have been of any benefit to the Board. The claims mapping section tends to extend for many pages, and becomes repetitive where there are multiple independent claims each specifying similar elements.

Of course, anything stated in the prosecution file will be heavily scrutinized in subsequent litigation or licensing efforts. Thus, although the Board will have little use for

the claims mapping section, the attorney must make significant efforts to be sure that the statement of support will not be read later as unduly limiting the claims. An attorney who fails to scour the specification for a complete statement of support, or who fails to include qualifying language, will risk a later argument that the unidentified portions of the specification are excluded from the scope of the claims. If the attorney makes even a minor clerical mistake, an opponent in litigation will seize on the mistake in an effort to invalidate the patent or defend against infringement. Rule 41.37(r) thus provides yet another trap for the unwary prosecutor.

In a typical appeal, there are a small number of claim limitations that are at issue. An appeal might center solely on one claim element. In some cases, the Board may have reason to require a showing of support for the element in dispute, but there is no good reason to require a statement of support for other elements not at issue. Nor is there good reason to require a repetitive showing of support for all of the claims on appeal.<sup>3</sup> The PTO should limit Rule 41.37(r) accordingly.

Also, because the purpose of these rules is to educate the Board, the PTO should amend rule 41.37(r) to require the applicant to provide *exemplary* support for elements at issue in the appeal. As written, the rule requires identification of “the page and line or paragraph” where the claim limitation is described in the specification, but in practice, a claim term will find support in multiple places throughout the specification. For example, in a chemical patent application, the same claim element (e.g., a “solvent”) might be described generally in one part of the specification and later exemplified in numerous examples. In a mechanical application, the same structural element (e.g., a “beam”) might be disclosed in many of the drawings.

In practice, it can be difficult and burdensome to identify all of the places in the specification or drawings where a claim element might appear.<sup>4</sup> It serves no purpose to require the identification of all theoretical potential support for some claim element (e.g. every figure in which a beam is shown, or every chemical example that includes a solvent).

**Comment 37: Rule 41.37(s) should apply only to claim elements in dispute**

The situation may be different for means-plus-function claims, where the law provides for limitations on claim scope based on the disclosure of the specification. But

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<sup>3</sup> For instance, if the claim called for an automobile having “means for propulsion” and a specified braking system, the issue on appeal might be whether the prior art fairly discloses that braking system. There is little reason to require the appellant to enumerate all support for the “means for propulsion” and other claim elements if those elements are not contested on appeal.

<sup>4</sup> Some applications contain an incorporation by reference to other documents. (“The disclosed brake system may be used with automobile chassis as described in the following patents, all of which are incorporated by reference.”). In such cases, the material incorporated may provide support.

again, if the particular claim element at issue is not under discussion in the appeal, there is no benefit to the Board in requiring the appellant to provide the means-plus-function analysis under 41.37(s).

For these reasons, any rule requiring identification of support in the specification should require reference to exemplary support in the specification, sufficient to educate the Board as to the nature of the claimed technology. Applicants should not have to repeat this exercise for the same claim terms used in separate claims. Of course, if the Board does not understand some aspect of the invention, the Board can request more detail from the appellant.

**Comment 38: The PTO should recast the rules in a manner limited to the purpose of the rules.**

The purpose of these rules is to educate the Board on the meaning of the claims at issue. The rules do not exist to create unnecessary makework for the attorney, nor to set up a “gotcha” in subsequent litigation. The PTO should amend the rules accordingly. The PTO should amend rule 41.37(r) and (s) to require an analysis section only for limitations that require discussion in the appeal. Rule 41.37(r) should require reference to exemplary support in the specification, sufficient to educate the Board on the nature of the claimed technology.

**Comment 39: The appeals rules should require the Examiner and the Board’s clerical staff to accept substantially conforming briefs, and should prohibit the imposition of new clerical requirements.**

In recent years, both the examining corps and the Board’s clerical staff have become overly technical in their clerical analysis of appeal briefs. If there is a clerical fault with the appeal – real or imagined – the Examiner will reject the initial appeal brief as noncompliant. After resubmission, the Examiner will find a new clerical fault in some other part of the brief, and will reject it again. This process repeats until the Examiner can find no more faults. Once the brief passes the Examiner, the Board’s clerical staff reviews the brief, and thus begins a new hunt for clerical problems.

Also, the PTO sometimes will reject a brief for requirements that are not in the rules, such as finding fault with the way the applicants cite cases, or with certain headings.

Again, the purpose of the appeal brief rules is to assist the Board by providing a standardized document. If a brief appears to conform substantially to the formatting requirements, the rules should require or at least encourage acceptance of the brief.

Thank you for considering the above comments.

Very truly yours,

/s/ /Allen E. Hoover/

Allen E. Hoover

AEH:dps

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