

February 24, 2010

Via Electronic Mail
BPAI.Rules@uspto.gov

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

Attention Linda Horner, BPAI Rules:

IBM Corporation Comments in response to Notice of Proposed Rule Making
"Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals", 74 Fed. Reg. 67987 (December 22, 2009)

IBM continues to support the United States Patent and Trademark Office's efforts to improve patent quality. Practice before the Board of Patent Appeals and Interferences (Board) is an important aspect of the process for obtaining patent protection, one that is often dispositive of applicants' rights when the applicant and examiner are unable to reach agreement. Therefore, IBM thanks the Office for reconsidering the Final Rule published in 73 Fed. Reg. 32937 on June 10, 2008. Although the Office's goal of enabling the Board to process appeals in a timely manner is laudable, we feel that the Office needs to strike the appropriate balance between improving the Board's decision-making efficiency and the burden on the appellant in achieving this goal. Thus, we offer the following comments on the currently proposed rules.

Rule 41.37(o) - Argument

The proposed rule provides, in part, that the argument include an explanation why the appellant believes the examiner erred as to each ground of rejection to be reviewed. The explanation would have to address all points made by the examiner with which the appellant disagrees.

Although it is incumbent upon an appellant to persuade the Board that the examiner's rejections are not proper, the rules should not unduly micro-

manage an appellant's ability to do so. Parsing each office action to determine what arguments or "points" are made by the examiner and what those arguments or "points" actually mean is inefficient, burdensome and could lead to unintended adverse consequences. While some office actions are clear and concise, others are not. Office actions may include arguments that are not clearly written, opinions as to what the prior art suggests, or the examiner's interpretation of the prior art. Therefore, it is unclear how addressing each and every point made by the examiner, many of which are not relevant to the question of whether the claim ultimately distinguishes over the prior art, helps the Office achieve the stated goals of efficiently framing the dispute between the appellant and the examiner – while providing the best opportunity for resolution of the dispute without proceeding to appeal (see Fed. Reg. at 67993).

Also, addressing all points made by the examiner would complicate appeal briefs by adding unnecessary arguments because if the appellant inadvertently fails to comment on every argument with which they disagree, they risk having the appeal brief deemed non-compliant or the Board deciding the appellant has not sufficiently challenged the examiner's arguments. Therefore, we believe that this rule could potentially undermine the ability of appellants to assist the Board and examiner in focusing on the issues relevant to patentability. The focus of an appeal brief should not be the examiner's interpretation or opinions of the cited prior art. The proper focus of the appeal brief is a comparison of the claims to the cited prior art.

Furthermore, the cost and length of appeal briefs would increase because it is not unusual to receive a lengthy office action containing 5 to 15 pages of examiner arguments.

The proposed rule further provides that any finding or conclusion reached by the Examiner that is not challenged will be presumed to be correct.

IBM contends that the examiner should not be afforded the presumption of correctness. Failure to challenge an examiner's finding or conclusion does not deem the finding or conclusion to be correct. As stated above, office actions are often unclear or not concise and can contain several pages of arguments. Therefore, it may be difficult for the Board to ascertain with complete certainty whether the appellant has sufficiently challenged all findings and conclusions reached by the examiner. If this presumption stands, if an appellant fails to respond to an examiner's finding or conclusion the appellant could lose the appeal – even if the examiner is incorrect.

Rule 41.37(o)(2) - Arguments Considered

The proposed rule provides that only those arguments which are presented in the argument section of the appeal brief and that address claims set out in the claim support and drawing analysis section in the appendix will be considered. Appellant waives all other arguments in the appeal.

The proposed language that the "[a]ppellant waives all other arguments" is troublesome because it is ambiguous as to what is meant by this waiver. The examiner has the burden of establishing a *prima facie* case of unpatentability. Therefore, the Board should not defer to the examiner and the appellant should not be precluded from making further arguments during continued prosecution.

Thus, we respectfully request an explanation of what is meant by waiver. Although the Fed. Reg. at 67993 states that the proposed rule is "[k]eeping with the well-established rules of waiver," since waiver usually refers to losing the ability to make an argument in the future, does this waiver mean that the appellant cannot raise the argument "waived" either in an appeal to the Federal Circuit or during further prosecution? The former is appropriate because the Federal Circuit will likely decline to consider arguments not presented before the Board, but the latter is troubling because it forces the appellant to take an unnecessarily extreme approach and attack everything the examiner said in this one appeal so as not to "waive" any rights. Therefore, since the duration of this proposed waiver is unclear, we recommend that the Office clarify that this waiver is for the *purposes of the appeal only*.

Rule 41.37(r) - Claim Support Section and Drawing Analysis Section

The proposed rule provides, in part, that the appeal brief contain a "claim support and drawing analysis section" in the appendix. For each independent claim argued and for each dependent claim argued separately, this section would consist of an annotated copy of the claim, and if necessary any claim from which the argued claim depends, indicating in bold face between braces { } after each limitation where, by page and line number, or paragraph, the limitation is described in the specification as filed.

IBM fully agrees with this proposed rule with the clarification that appellant should not be required to identify every instance of support in the specification for a limitation. Typically, support for a particular claimed element or feature can be found throughout the specification. However,

referring to a particular section of the specification could be construed as limiting and may cause appellants to be conservatively over inclusive of specification support references, which would defeat one of the key purposes of helping guide the Board to find support in the specification. The incentive to receive a favorable decision on appeal should be sufficient to ensure that appellants direct the Board's attention to the "best" supporting description in the specification.

Rule 41.37(s) - Means or Step Plus Function Analysis Section

The proposed rule provides, in part, that the means or step plus function analysis section would include each independent claim argued, and each dependent claim argued separately that contains a limitation which appellant regards as a means or step plus function limitation in the form permitted by the sixth paragraph of 35 U.S.C. 112. For each limitation, the appendix shall include an annotated copy of the claim, and if necessary any claim from which the argued claim depends, indicating in bold face between braces { } after each limitation where, by page and line number of the specification and the drawing figure and element numeral that describes the structure, material or acts corresponding to each claimed function.

IBM fully supports this proposed rule change because a separate statement of the "corresponding structure or acts" for means or step plus function limitations creates a clear record of the claim scope asserted by appellant and also provides an important basis for file wrapper estoppel. However, we propose the clarification that if an appellant does not identify the corresponding structure or acts for other claim limitations, where those limitations are described by function, then *for purposes of the appeal*, such other claim limitations should not be interpreted as limited under 35 USC 112, sixth paragraph to the corresponding structure or act described in the specification.

Rule 41.37(t) - Evidence

The proposed rule provides in part that the evidence section contain only papers which have been entered by the examiner. The evidence section would include: (5) affidavits or declarations upon which the appellant relied before the examiner; (6) other evidence filed prior to the notice of appeal and (7) other evidence filed after the notice of appeal.

IBM believes that these are additional burdens which are unnecessary because the examiner and the Office already have this information available via PAIR.

RULE 41.56(a) – SANCTIONS

The proposed rule provides that the Director may impose sanctions against an appellant for misconduct.

We feel that the proposed rule is unnecessary because it is redundant with other rules such as 37 CFR Section 11.18 already in force – as stated by the Office in the Fed. Reg. at 67998.

Conclusion

While improving the quality of the examination process will ultimately benefit everyone, we encourage the Office to adopt rules that advance the mutual interest of the Office, as well as appellants. IBM looks forward to continuing to work with the Office in furtherance of its goal of processing ex parte appeals in a timely manner.

Respectfully submitted,

Manny W. Schecter
Chief Patent Counsel
Intellectual Property Law
IBM Corporation
schecter@us.ibm.com
Voice: 914-765-4260
Fax: 914-765-4290

Lynne D. Anderson
Sr. Program Manager
U.S. Patent and Trademark Office Liaison
IBM Corporation
Washington IP Law Dept.
lynnea@us.ibm.com
Voice: 703-299-1455
Fax: 703-299-1475