

**From:** Brian Johnson [patentsmith@gmail.com]  
**Sent:** Friday, February 26, 2010 2:20 PM  
**To:** BPAI Rules  
**Subject:** Docket No. PTO-P-2009-0021 RIN 0651-AC37

Dear PTO,

Thank you for allowing me the opportunity to participate. The comments below in general, regard the degree of inventor-friendliness found at the PTO, and in particular, how the proposed rules under BdR. 41.50 impact inventor-friendliness of the PTO. My fifth grader recently learned the details of how some of the drafters of the U.S. Constitution just happened to take a ride on an experimental boat powered by – of all things - steam while on break from their drafting duties and thought it was a good idea to encourage inventors. Thus the concept of inventor-friendliness was introduced into the U.S. Constitution and the PTO and those in the patent community followed suit. We should never forget this original idea that the PTO and we in the patent community make our living to encourage inventors to invent – thus, inventor-friendliness should be at the top of our list of priorities. To remind us of this priority, the word “inventor” is substituted for the word “applicant” below since behind every application is at least one inventor.

Proposed rule 41.50(b) An apparent “efficiency” problem is raised by the PTO in that currently the Chief Administrative Patent Judge (herein “the Chief”) is directing the board on most if not all remands that regard procedural defects, but is not directing the board on remands on the merits. The solution proposed is to grant the Chief sole authority regarding remands for both procedural defects AND on the merits and to take away all involvement by the Board regarding remands. This solution seems to be overly reaching since, as explained, the Chief is directing procedural defect remands, NOT on the merit remands.

Giving the Chief sole involvement with all remands is not an inventor-friendly move in the right direction. Centralizing and concentrating decision making power (e.g. there is a plurality of Supreme Court Justices rather than just one Supreme Justice) is not a good thing for inventors who are appealing their cases. As stated in the justification portion, there were only 33 remands on the merits in Fiscal Year 2009, an investigation could be conducted as to why the number is so low. Are the examiner’s really doing their jobs that well? What is next on the list that is the sole prerogative of the Chief – reversals? In any event, no reason has been given to give the Chief sole power over ALL remands. The proposed rule 41.50 lacks merit.

In addition to the other inventor-unfriendliness about the proposed 41.50(b) rule, the two month period of response found in the proposed rule 41.50(b) if it has no provision to extend is not an inventor-friendly proposal and rather should be extendible. Extensions are handled as a matter of routine by the PTO so should not impose any undue burden to the PTO. On the other hand lack of extension possibilities could certainly impose undue burdens on inventors if their lack results in an abandonment of the inventor’s application.

Proposed rule 41.50(d) seems to be a codification of the idea that a function of the Board is to not only review the work of others but to also grab a shovel and jump in to help out with the

rejection process – “hey, quick, bring the club; I think this one is still alive over here.” So who reviews the Board’s rejections – the examiner? Yeah, right. So how is the examiner being given the political will and power and the economic incentive to overturn the Board’s rejections when called for? What incentives are in place for the examiner to objectively review the Board’s rejections?

The proposed rule 41.50(d) contains a provision that if the Examiner maintains the Board’s rejection, that the inventor could appeal the Board’s rejection to the Board. Why is this not the fox guarding the hen house?

Furthermore, in the proposed rule 41.50(d), to reopen prosecution, the inventor is told to submit amendments or new evidence – that’s it. What happened to the inventor’s right to challenge the examiner’s initial burden to put forth a prima facie case for unpatentability before the burden shifts to the inventor to have to produce evidence in favor of patentability? Or is it that since the Board is making the rejection, there is no such burden by the Board to first establish a prima facie case of unpatentability by the Board?

In addition to all the other inventor-unfriendliness about the proposed rule 41.50(d), the two month period of response is not an inventor-friendly proposal and rather should be the typical three month period with three months of extensions since afterall, it is a new rejection. A three month period with three months of extensions are handled as a matter of routine by the PTO so should not impose any undue burden to the PTO. On the other hand, the proposed two month period could certainly impose undue burdens on inventors.

Proposed rule 41.50(f) looks more like an unlimited fishing license than a rule. A reason for the unlimited fishing license (proposed rule 41.50(f)) is that Rule 41.50(d) has been working so well – so why do we need yet another “rule”? Unfortunately, the inventor is going to have to pick up the tab for the unlimited fishing license through the resultant fishing trip – although this fishing trip is not to be enjoyed nor most likely understood as to relevance. Why cannot the Board review the inventor’s appeal brief and the examiner’s response and use what has been working apparently so well for the Board since 1999? Why more burdens on the inventors? Why?

On top of this inventor-unfriendliness (scariness) of proposed rule 41.50(f), there is also a non-extendible drop dead response mandate proposed with an unspecified floating amount for the period to respond to be decided by the PTO depending upon what holidays are coming up? Well, what if the inventor does not celebrate the typical holidays and instead has a child that is in the hospital due to a serious illness in the middle of March? If the PTO can accommodate some periods in the year why not just be accommodating in general? The very fact that the PTO can accommodate for some periods of the year shows that the review function will not bear undue burden if the PTO has to wait for the inventor to respond. Having a non-extendible response period with a length that fluctuates dependent upon how the PTO characterizes the particular time of year sounds ripe for abuse by the PTO at the expense of the inventor. The PTO can wait for the inventor to respond and the response time should be three months with three months of extensions possible.

As this review started, it will also end, with an attempt at a broader perspective than merely our beloved Bd.R. 41.50. Efficiency was given as justification for at least some of the proposed rules. If efficiency is the prime goal of the Board, then it is worth a brief look at the subject of efficiency. Efficiency can be viewed solely as a percentage or a ratio such as involving so many units of output for so many resources expended. For an efficiency percentage or ratio to really be impressive and matter, however, a total number of units outputted should also be taken into account.

Thus, one organization would be at least subjectively viewed as being more efficient if that organization produced ten times more units than another organization even though both had the same efficiency percentage or ratio. With this in mind, the following scenario is offered as an attempt to be further illustrative.

In another country, most likely a small country that possibly no one in the US has ever heard of, where resources are limited, there may exist a patent office that has an appeal board, but given the limited resources, the appeal board has only one person that the patent office can afford to pay. One day the appeal person gets an idea to not only outdo the USPTO in efficiency percentage and ratio regarding appeal cases reviewed, but also to outdo the USPTO in number of appeals reviewed per year.

Being encouraged by the idea, the appeal person constructs an elaborate wheel with various markers on the wheel arranged so that when the wheel is spun a result is indicated such as affirm, reverse, remand, and concur. After a trial period and some thought, the final version of the wheel has a convincingly vast majority of affirm markers on it with just an ever so slight number of reverse and remand markers on it. The concur markers are dropped in the final version of the wheel since they require more work than needed and do not add any perceived value.

During the trial period of the wheel, the appeal person used one prototype version that had all affirm markers on it with the idea that overall efficiency would be greatest since the wheel would only have to be spun once for each of the appeal cases reviewed because none of the cases would be sent back down for further work by the examiners so none of the cases would be sent back up for the wheel to be spun again. The appeal person realized over time, however, that the wheel with all affirm markers on it caused some problems that were not initially anticipated with the largest problem being that the appeal person stopped getting any appeals to review.

The reason being was that over time the examiners found out about the wheel and that the wheel had all affirm markers on it. They soon realized that since all of their rejections would be affirmed, it did not matter how they rejected the claims. And more importantly, when the inventors showed them how they had not properly rejected the claims, the examiners did not back down since the examiners realized that the inventors effectively could not do anything about it given that the wheel had all affirm markers on it. The examiners further reasoned that not only could they reject the inventor's claims with little or no reason, but the examiners could also not allow anything even after being shown their errors. With no allowances, the examiners could never be faulted for making a mistake since all the reviews of the examiners were conducted on allowed cases.

The inventors had been historically relying on an antiquated concept that the examiner had the initial burden of showing unpatentability of the claims and without meeting this burden, the inventors had no burden to prove patentability of the claims using evidence. The inventors remembered that when the concept was in place, they did not have to file appeals hardly at all since the examiners abided by the concept as well and would allow claims when shown that they had not met their burden. Most of the few times that appeals had to be filed, the appeal person would reverse the examiner's rejection since the examiner had not met the examiner's initial burden. Of course, there were also a few times when the inventor did not have it right and the appeal person would affirm the rejection. This concept was thrown out however once the appeal person started using the trial version of the wheel and over a span of time even the inventors started to forget that the antiquated concept had existed.

With the all affirm markers on the prototype wheel, however, after a while the inventors stopped filing more applications since it was hopeless for them. Then after a while the inventors stopped inventing since the patents in the past had protected their property rights in their inventions, but now the patents were impossible to get. Fortunately most of the inventors found other things to do with their time besides inventing.

When the backlog of appeal cases were almost gone, the appeal person realized that no new appeal cases were being received and also realized that something had to be done to fix the situation. The appeal person thought a bit and then replaced some of the affirm markers with a slight few reverse markers and an ever so few remand markers. The appeal person reasoned that if an ever so slight few appeal cases were reversed or remanded it would give an adequate amount of hope to the inventors so that they would start to file applications again. The appeal person reasoned that inventors by nature are quite optimistic and hopeful so there need not be many reversals leading to allowances to give the inventors at least some hope that at least some of their applications would eventually become patents.

With hope reinstated in the land new inventors started to invent and then file patent applications. Given the examiners proclivity to reject at all cost and maintain their rejections through conditioning by the all-affirm version of the wheel of appeal, the number of appeals soon started to fill the pipeline to the appeal person once again.

Given that few affirm markers needed to be replaced by reverse or remand markers, in order for the pipeline to be filled up again, the appeal person reasoned that the wheel was in good enough shape to go final. One happy outcome for the appeal person was that the diameter of the pipeline over time had to be enlarged since the ever so slight allowance rate was plenty of encouragement to the happy go lucky inventors so that applications started coming in by the truck load. Thus in the end the appeal person reached the goal of surpassing the USPTO with a higher efficiency rate/percentage and a higher total number of appeals processed per year.

On a more sad note, those inventors that had decided to get out of inventing mainly remained in occupations other than inventing since they remembered a better day for inventors where the patent office of the small little known country put them first above efficiency.

It was once said, “No man can serve two masters: for either he will hate the one, and love the other; or else he will hold to the one, and despise the other.” The context at the time was a comparison between serving God and serving mammon, which could be certainly relevant in general to the present discussion, but could be rephrased to suit the present specific context:

“No man can serve two masters, for either he will hate the one, and love the other; or else he will hold to the one, and despise the other. Ye cannot serve the inventor and efficiency.” Either the PTO will have as its mission to efficiently crank out millions of office actions, appeal reviews, and various other things thereby meeting production quotas and other metrics or the PTO will have as its mission to encourage inventors to invent.

The PTO cannot have two masters.

Sincerely,

Brian Johnson