

February 25, 2010

*Via Email*

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

Re: 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:

It is out of deep concern for the for the future innovative capacity for the United States that I submit the following brief 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 inventor, with numerous issued patents and patent applications, as a consultant to inventors and investors in innovation, as an investor, and as a concerned citizen.

Many of the rules in the above referenced document will have a profoundly negative impact in invention and innovation in the US, especially on its economy and its innovative capacity, as well as on its capacity to attract and benefit from new innovative talent. The time and resources simply do not allow me to adequately address all of these negative effects in detail, however a few rules in particular are worth close examination:

Bd. R. 41.39, transfers responsibility for an incomplete, faulty, or inadequately researched examiner response to the applicant. This is not only burdensome to the applicant, but effectively creates a process (potentially repeated at each stage application and appeal) that has no upper bound in expense for the applicant, or the USPTO.

At each stage in the process, the applicant can be confronted with new, previously undisclosed material to which he must respond, making it impossible to make any determination of expected costs in terms of technical, financial or other resources. Such an unbounded, open-ended process also discourages responsible performance on the part of examiners, and wastes limited USPTO resources on what is essentially a game of attrition in which the party with the fewest resources is ultimately forced to capitulate. The immediate outcome of such a rule will be to drive all but the largest and most resource-rich applicants from the system, and drain USPTO resources in open-ended disputes in which the outcome is determined by the amount of resources that can be brought to bear, rather than the merits of the case. The ultimate effect will be an exodus of

individual and small-scale inventors, who are responsible for the bulk of field-opening innovation, from the US system to other countries where more rational processes are employed.

The interests of the US, and the responsibilities of its government, are best served by an approach that requires examiners to adequately research application subject matter thoroughly in the first instance, and to disclose such findings in their initial responses. Such an approach conserves applicant and USPTO resources, and creates an environment that will attract innovation and preserve the US position as a leader in invention.

Bd. R. 41.37(o), would have a similar effect, creating a burden on the applicant to correct every error in an examiner's findings, rather than simply focusing on those necessary to demonstrate that what is claimed is not equivalent to the examiner's findings.

In light of these and many other potentially damaging aspects of the proposed rule changes, I urge the you, Director Kappos to *delay their implementation and instead continue with the process of improvement you began last year.*

Sincerely,

A handwritten signature in black ink, appearing to be 'B. Kappos', written in a cursive style.

43 Somerset Road  
Lexington, MA 02420

(718) 674-1020