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Director of the United States  
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**By Email**

Re: Comments on Proposed Rules  
Docket No.: PTO-P-2009-00211

Dear Sir:

Please consider the following comments relating to the December 22, 2009, proposed rule changes entitled "Rules of Practice Before the Board of Patent Appeals and Interferences in *Ex Parte Appeals*" (generally "Rules").

Oloff & Berridge, PLC is a private intellectual property law firm that files and prosecutes several thousand patent applications per year, including at least several appeals per year, on behalf of a wide range of applicants, including independent inventors, small businesses, universities and major U.S. and international corporations. As a Member of the firm, I am providing the following comments that represent the views of the firm as developed from interviewing a sampling of registered patent attorneys within the firm. However, these comments are not intended to represent the views of any specific client or clients of the firm.

We would like to commend the United States Patent and Trademark Office ("USPTO") on its recent efforts to enhance quality and efficiency in its operations. While change is often difficult to all involved, it is clear that change is needed, and we are very pleased that the USPTO has again begun to move forward in a spirit of communication and cooperation with the applicant community to achieve necessary and appropriate changes that "promote the progress of science and useful arts."

We also appreciate the efforts of the USPTO in reviewing the rules for *ex parte Appeals* before the Board of Patent Appeals and Interferences ("Board"). We appreciate that many of the more burdensome and less cost-effective changes announced in the June 10, 2008 Federal Register Notice entitled "Rules of Practice Before the Board of Patent Appeals and Interferences in *Ex Parte Appeals*; Final Rule" ("the stayed Final Rules") will not be included in the forthcoming Rules. The USPTO indicates that it is considering the changes to the Rules, incorporating significant revisions to the stayed Final Rules, (1) "to efficiently frame any dispute between the appellant and the examiner for the benefit of the Board and the appeal conferees to provide the best opportunity for resolution of the dispute without the necessity of proceeding

with the appeal," and (2) "to reduce the number of returns based on defective briefs." We recognize that the proposed revisions to, for example, Rule 41.12,<sup>1</sup> entitled "Citations to authority," and Rule 41.33, entitled "Amendments and evidence after appeal" are made to streamline and/or clarify the procedures covered by these provisions. However, we believe that some of the other proposed revisions will not serve to achieve either of the above-stated goals (1) and (2).

While we appreciate the efforts of the USPTO, we are very concerned that the proposed Rules (1) do not address certain of the difficulties that the user community has with the current Rules, and (2) will prove prejudicial to Appellants<sup>2</sup> by adding undue burden for Appellants who seek to have the status of their applications finally resolved on Appeal.

Appellants seek review on Appeal to gain adjudication of their patent rights when the examination process has reached impasse. Often, the decision to seek adjudication on Appeal is based on a breakdown in communication between the Examiner and the Appellant. In this regard, the Appeal process should provide an Appellant a full and fair opportunity to articulate the issues and to have them finally adjudicated.

We undertake specific discussion of the most troublesome Rules provisions and proposed modifications below.

## **I. 37 C.F.R. §41.35**

Rule 41.35 should be revised to pass jurisdiction to the Board when a Notice of Appeal is filed, with discretion of the Examining Division to settle the Appeal, *i.e.*, by allowance of the application. The waste of time and effort that occurs in the briefing phase, based on hyper-technical and inconsistent application of the Rules, for example, regarding the sufficiency of the Brief on Appeal may be reduced through central oversight by the Board regarding implementation of the Rules, and the exercise of the same discretion that the Board exercises in other contexts. Failing this, Bd. R. 41.37, discussed in detail below, should include a provision that harmless errors in format for an Appeal Brief should not provide grounds for finding the Brief to be non-compliant.

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<sup>1</sup> Consistent with the December 22, 2009 Federal Register Notice, we use the term "Rule 41.XX" when discussing the current rules (2007 revision) and "Bd. R. 41.XX" when discussing specific potential modifications to the Rules, as outlined in the Notice. The individual section headings below are more general and intended to cover the current rules and the potential modifications discussed in each section.

<sup>2</sup> For consistency, we use the term "Appellant" or "Appellants" throughout this letter to refer to Applicant(s) and Appellant(s).

**II. 37 C.F.R. §41.37****A. The Proposed Rules Do Not Address Inconsistent Implementation**

Rule 41.37 is among the Rules of most interest to Appellants. This Rule provides a basis for much frustration in the Appeal process long before the Board sees the Appeal. We are heartened that many of the burdensome requirements that were imposed by the stayed Final Rules have been removed. However, sufficiency of Appeal Briefs (and Reply Briefs) is currently decided in an unfairly arbitrary and inconsistent manner across the Technical Centers. Appeal Briefs are routinely returned as non-compliant for the most minor procedural defect, or even when they precisely comply with the stayed Final Rules (an option that Appellants were afforded in December 2008). For example, we were recently forced to file a Supplemental Brief on Appeal in response to a Notice of Non-Compliant Appeal Brief ("Notice") because one Technical Center does not approve of the presence of additional sub-headings in the Argument section of the original Brief. The Notice imposed a burdensome requirement on the Appellant to reformat the headings for verbatim compliance with the "exemplary" format discussed in MPEP §1205.02. The result is wasted time and effort on an Appellant's part, degradation of the clarity and ease of access to the arguments, and an overall delay based on there being no consistent oversight of the implementation of the Rules. For reasons that will become clearer in the detailed review of the currently-proposed revisions below, there is still potential for improper findings of non-compliance based on the proposed Rules.

**B. Minor Variations In Form Should Not Render A Brief Non-Compliant**

It should be understood that Appellants and practitioners generally try to precisely follow the Rules. Appeals cost money and time. Most Appellants believe that they are forced to Appeal based on a lack of proper examination of their applications. It is not a process that is taken lightly. It benefits no one to attempt to circumvent, or otherwise obfuscate, the process only to incur additional expense and delay. There needs to be some recognition of this in the Rules. Bd. R. 41.37 should expressly state that minor procedural or formatting deviations can be accepted. In other words, the Rules should expressly include a waiver provision for minor procedural variations in an Appellant's Brief. For example, Bd. R. 41.37(e) could be revised to read "The appeal brief must contain, under appropriate headings and in the order indicated, the *items listed below*. *An appeal brief that substantially complies with the content requirements will not be deemed non-compliant for minor errors in form.*" Otherwise, such a provision could be added as a separate paragraph, for example, as Bd. R. 41.37(v) *Minor errors in form.*, and include the last sentence above. We believe that it is preferable that this provision be stated as early in Bd. R. 41.37 as appropriate.

**C. The Rules Should Be Clear That There Is No "Verbatim" Requirement**

The plain language of Rule 41.37 requires sections to be included in an Appeal Brief, in a particular order, and "under *appropriate* headings." Many Examiners view the quoted requirement as "under *verbatim* headings." The proposed Rules modification maintains the term "appropriate" here, but the specific provisions regarding each of the sections imply a "verbatim" requirement. In each instance, the title of the section appears in quotes in the body of the Rule (*see, e.g.* the proposed modifications in Bd. R. 41.37(f), (g) and (l) - (p)). An Appeal Brief should not be returned as non-compliant because, for example, the section headings are not precisely worded according to the specific language set forth in the Rule. This is a standard that the plain language of the Rule itself does not impose, and is an example of the flawed implementation that will not be corrected by the currently-proposed revisions of the Rules.

As noted above, minor deviations should be excepted with any revision in, for example, Bd. R. 41.37(e), or the addition of a new Bd. R. 41.37(v), to indicate that "*An appeal brief that substantially complies with the content requirements will not be deemed non-compliant for minor errors in form.*" It is appropriate too that the commentary associated with Bd. R. 41.37 reiterate, for example, that "No provision of this Rule is intended to impose an absolute requirement of form, or any verbatim requirement in the language used, in any section of an appeal brief. The Examiner has discretion to waive the requirements of any provisions that do not substantively affect the contents of the Brief."

The proposed rules also appear somewhat self-contradicting. Bd. R. 41.37(e), as proposed, states that "[t]he appeal brief *must* contain ... the following items." Other provisions of Bd. R. 41.37, however, indicate assumptions that the USPTO will apply if the information is not provided. *See, e.g.,* the final sentence of Bd. R. 41.37(f) and (g). We are concerned that there remains a disconnect in the provisions, *i.e.,* between indicating what the Brief "must" contain, and implying that certain portions may be omitted. We believe that this will lead to even more varying implementation of the Rules. Thus, we recommend at least adding "Except as otherwise noted herein," at the beginning of Bd. R. 41.37(e).

**D. The Related Cases Requirement Should Not Be Expanded**

The proposed revision to Bd. R. 41.37(e) seeks to include an additional requirement for the definition of related cases to be expanded to include "any continuing application of the application on appeal." It is unclear what bearing the identification of such continuing applications may have on a pending Appeal. Further, the proposed Rule would then impose a need to update the Board, throughout pendency of the Appeal, regarding any final decision made in the prosecution of the continuing application, the claims of which may be completely

different. This adds burden on Appellants with no foreseeable benefit to the deliberations of the Board. Therefore, this additional requirement should be deleted from the proposed Rule.

**E. The Rules Should Not Inappropriately Limit Appellants' Arguments**

Bd. R. 41.37(o) proposes a burdensome level of precision to the content of the argument section and threatens to limit Appellants' rights in ways that are unacceptable. Rule 41.37(c)(vii) states that "[a]ny arguments or authorities not included in the brief *or a reply brief filed pursuant to §41.41* will be refused consideration by the Board, unless good cause is shown." Bd. R. 41.37(o) proposes that "[o]nly 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" (emphasis added).

The proposed Rule modifications appear aimed at codifying the current thinking of the Board that "[a]ny basis for asserting error, whether factual or legal, that is not raised *in the Principal Brief*, is waived." *See Ex Parte Atsuhisa Nakashima*, Appeal No. 2009-001280 at 7 (BPAI January 7, 2010) (emphasis added). However, the proposed language is too strong even for that purpose, in that it expressly precludes consideration of arguments properly presented in a Reply Brief. There should be some limited option for an Appellant to raise additional or revised arguments in a Reply Brief responsive to comments made in an Examiner's Answer, or to intervening changes in the law. We believe that the plain language of any proposed Rule should at least afford some appropriate, albeit limited, opportunity to restructure and expand an Appellant's arguments in a Reply Brief under Bd. R. 41.41. Consideration should be given to modifying the proposed Rule to maintain the provision for consideration of other permitted arguments. For example, the proposed Rule should be modified further to read "Only those arguments which are presented in the argument section of the appeal brief, *a reply brief that complies with §41.41, or an oral argument that complies with §41.47*, and that address claims set out in the claim support and drawing analysis section in the appendix will be considered."

**F. Any Waiver Provision Must Be Limited**

Bd. R. 41.37(o) also proposes that "Appellant waives all other arguments in the appeal." The waiver provision should be limited. For example, the Rule could be limited such that "Appellant waives all other arguments [in] *only for the purposes of the appeal*." Here too, the commentary associated with this Rule should specifically reiterate the limits on any waiver. This limit on the waiver provisions, in combination with a specific limit on any presumption of correctness by an Examiner, discussed in Section F. below, is essential to preserve Appellants' rights.

**G. Presumption Of Correctness In Favor Of An Examiner Must Be Likewise Limited**

Bd. R. 41.37(o) further proposes that

The "argument" shall explain why the examiner erred as to each ground of rejection to be reviewed. *Any explanation must address all points made by the examiner with which the appellant disagrees. Any finding made or conclusion reached by the examiner that is not challenged will be presumed to be correct.*

(Emphasis added).

The Rules, and commentary, should indicate that any "presumption" is only for the proceedings before the Board, and only based on the contents of the Office Action from which the Appeal is taken. Appellants should focus on what they consider to be controlling issues. There should be no implication that an Appellant's failure to challenge a particular finding or conclusion of the Examiner could be considered as acquiescence, or otherwise an admission, in any other proceeding, such as in a continuing application or after a Request for Continued Examination. In order to avoid lengthy briefs covering irrelevant but incorrect Examiner assertions and ancillary issues, the proposed Rule should be limited to "*Any explanation must address all points made by the Examiner that the Appellant intends to contest in the appeal. Any finding made or conclusion reached by the examiner, which is set forth in the final rejection or other office action from which the appeal is taken, that is not challenged....*" This, in concert with the above-discussed waiver limitation, will avoid the need to address Examiner misstatements that are not at issue in the appeal.

Imposition of a presumption on behalf of the Examiner, unless specifically limited as discussed above, will lead to over inclusion of information in an Appeal Brief in the face of the possibility of waiver. This burdening of the Record will not serve to streamline or otherwise crystallize issues. Rather, the real issues to be resolved by the Board will be presented awash in a sea of arguments presented only as a guard against an assertion of waiver. Appellants will tend to challenge all issues, even secondary, tertiary and lesser non-dispositive clear errors to avoid waiver. Limits on the presumption as proposed may ease the burden on the process.

**H. Evidence Section Should Be Strictly Limited**

With regard to the evidence section, Bd. R. 41.37(t)(6), the additional evidence that Appellants are required to duplicate in the record when filing a Brief should be minimal. A strict

limitation to affidavits and declarations is appropriate. Alternatively, we believe that the Rule, or at least the commentary, should specify examples of the "other evidence" as a guide to both Appellants and Examiners in preparing and reviewing Briefs and the requirement to provide such other evidence that is already of record should be limited. For example, it should be made clear whether there is a need to attach copies of the references applied in the rejection (both the Examiner and the Appellant generally rely upon the content of those references to respectively support and refute a rejection). Are copies of other U.S. patents of record required if Appellants rely on their teachings?

**I. Possible Petition Requirement Should Not Be Considered**

We also note that the comments indicate that "[c]onsideration was given to proposing a requirement for a petition to extend the time for filing an appeal brief," and that such consideration has been deferred. Consideration of such a requirement should not only be deferred, it should be dismissed. Such a petition requirement would only cause additional delay and burden on Appellants, and the Appeal process in general, without any countervailing benefit whatsoever.

**III. 37 C.F.R. §41.39**

**A. New Rejections, Arguments and Evidence Should Not Be Permitted From An Examiner Without a Full Opportunity To Respond**

Bd. R. 41.39(b) maintains language from the current Rule as follows: "If an examiner's answer contains *a rejection designated as a new ground of rejection.*" The highlighted language should be stricken. This language has, in the past, tended to slow the proceedings or potentially lead to additional burdensome and time-consuming efforts on the part of Appellants where an Examiner, in his or her sole discretion, chooses not to characterize a new ground for rejection as such. While possible, the need to resort to the petition process to contest the lack of such a designation will slow the overall adjudication of an Appeal. Again here, the potential prejudice to the Appellant is clear in view of the comments at page 67994 of the Notice.

Furthermore, potential confusion in the application of the Rule, as written, is highlighted where the comments provide that

Where a newly cited reference is added in the examiner's answer merely as evidence of the prior statement made by the examiner as to what is "well-known" in the art which was challenged for the first time in the appeal brief, the citation of the reference in the examiner's answer would not ordinarily constitute a new

ground of rejection within the meaning of Bd. R. 41.39(a)(2) and 41.39(b). Similarly, it would not ordinarily be a new ground of rejection for an examiner to cite an additional reference in an examiner's answer in the following situations: (1) To prove a previously applied reference contains an enabling disclosure; (2) to explain the meaning of a term used in a previously applied reference; or (3) to show that a characteristic not explicitly disclosed in a previously applied reference is inherent. The basic thrust of the rejection remains the same in these above-referenced situations because the additional reference simply explains a previously applied reference or is evidence of what was taught in a previously applied reference in response to a new argument.

In other words, not only does the Examiner decide what to designate as potentially a new ground or not, but the comments now provide guidance regarding the proper words to use to cut off the Appellant's ability to reasonably respond even while new references are being relied upon by the Examiner. The Rules should treat the participants equally. Examiners cannot be afforded an opportunity to make a new case in an Examiner's Answer while the Rules prohibit additional arguments by Appellants. To the extent that it is inappropriate for an Appellant to raise a new argument or present new evidence, it must also be inappropriate for the Examiner to raise a new argument or present new evidence. If the Examiner finds that a new argument or new evidence is warranted, the proposed Rules should provide that prosecution should be reopened, and a non-final rejection should be mailed, or Appellants should be entitled to fully address the new argument or evidence with their own countervailing new argument or evidence in the Appeal.

**B. No Separate Request To Docket An Appeal Should Be Required**

It is unclear why Bd. R. 41.39(b)(2) proposes to impose what appears to be an additional requirement on Appellants to separately request that the Board docket the Appeal. The current procedure under Rule 41.39(b)(2) to "[r]equest that the appeal be maintained by filing a reply brief as set forth in §41.41" is adequate without any requirement for an additional submission with additional "magic words" by the Appellant. This requirement should be stricken.

**IV. 37 C.F.R. §41.41**

Because there is only one section to a Reply Brief, *i.e.*, arguments, no format, including section heading, needs to be specified. Setting forth in the comments, although not in the Rule, specific forms for response in a Reply Brief should be avoided. Bd. R. 41.41(d) should be reserved in its entirety.

The only limits currently imposed on the content of a Reply Brief by Rule, for example, are that it "shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence." Rule 41.41(a)(2).

In view of delays in adjudication of Appeals and the changing legal landscape, the Rules should not further limit Appellants' rights in a manner that may be unduly prejudicial. The Examiner (*see* Rule 41.39(a)(2) and Bd. R. 41.39(a)(2)) and the Board (*see* Rule 41.50(b) and Bd. R. 41.50(d)) are afforded the discretion of raising new points throughout the process. Contests over what are new issues, rather than adjudication of a case on its merits, only serve to further burden the system, or otherwise force Appellants to be overly inclusive and hypothesize as to Examiners' positions and reasoning in Appeal Briefs, lest they be considered to have waived substantial rights early in a proceeding. Examiners' Answers are often the first time that some Examiners finally crystallize or clarify their positions, all the while asserting that they are not raising new issues. Clarification and revision of an Appellant's arguments in a Reply Brief should be afforded the same deference. The proposed revisions to the Rule do not appear to provide such deference. We believe that an appropriate, albeit limited, opportunity to restructure and expand an Appellant's arguments in the Reply Brief must be included in the Rule.

The discussion in Section II. D. above regarding presentation of arguments throughout the pendency of an Appeal applies to the modifications proposed in Bd. R. 41.41(d)(5) and (g). The basic premise remains that all appropriate arguments should be considered in order that the Board can make an informed decision on the totality of the Record. Appellant should have an opportunity to fully respond to new language in an Examiner's Answer. Imposing waiver regarding arguments that an Examiner may unilaterally consider to be not properly made, or not properly responsive, particularly where the characterization of new evidence presented with the Examiner's Answer may be questionable, is inappropriate and unwarranted. Language that supplements the above-discussed modifications of Bd. R. 41.37(o) is appropriate. For example, Bd. R. 41.41(g) should be modified to include "Any arguments raised in the reply brief which (1) *are not related to an argument or issue raised in the appeal brief, or* (2) *are not responsive to points made in the Examiner's answer...."*

Finally, in view of the delays between filing of Appeal Briefs and Examiner's Answers, and to avoid legal error by the Board, an exception to §41.41(g) should be added along the same lines as the exception in §41.47(j).

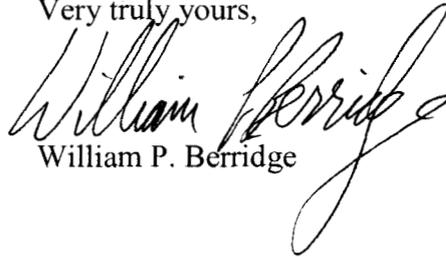
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In summary, we are concerned that some of the proposed modifications to the Rules shift equities away from Appellants seeking final resolution regarding the patentability of their claims in applications while levying more burden on the Appellants. Most troubling are the provisions that the Examiner and the Board can raise new issues with little or no scrutiny while Appellants'

submissions are subject to specific scrutiny for their sufficiency and content that prohibit Appellants from fully responding to such new issues.

We appreciate the opportunity to express our concerns and the rationale behind those concerns, as outlined above.

Very truly yours,

A handwritten signature in black ink, appearing to read "William P. Berridge". The signature is fluid and cursive, with a large, sweeping flourish at the end.

William P. Berridge

WPB:DAT/cfr