

**Response to Request for Comments Rules of Practice Before the Board of Patent Appeals and Interferences in Ex parte Appeals
PTO-P-2009-0021**

Submitted by Brad Pedersen, Reg. No. 32,432. These comments are submitted on behalf of Mr. Pedersen, individually. They do not represent the comments or opinions of Patterson, Thuente, Skaar & Christensen as a firm or of any clients of the firm.

I. Categories of Public Comments Requested

Category 5 – Appeal to Board

Comment I-1: The apparent conflict between 37 C.F.R. §§41.33 and §556(d) of the Administrative Procedures Act (“APA”

The Office should resolve the apparent conflict between the prohibition of affidavits and other evidence following the filing of an appeal, pursuant to 37 C.F.R. §§41.33 and the right to submit rebuttal evidence in formal agency proceedings, such as an appeal to the Board of Patent Appeals and Interferences (“BPAI”), guaranteed under §556(d) of the APA. While applicants can submit evidence after appealing to the BPAI by demonstrating: (1) that the evidence overcomes *all* rejections under appeal¹ and (2) good and sufficient reasons as to why the evidence is necessary and was presented late 37 C.F.R. §41.33(d), the strict standard imposed on applicants seeking to submit rebuttal evidence seemingly conflicts with the clear language of the APA, which states that parties to formal agency proceedings are “entitled... to submit rebuttal evidence.” In addition, the inflexibility of this rule is compounded by the rule-making decision to deny entry of evidence after a final rejection is non-appealable under 37 C.F.R. §41.31(e).

Apart from conflicting with the APA, the strict evidentiary rule also conflicts with case law, holding that the Board must consider rebuttal evidence submitted by the Applicant. *In re Sullivan*, 498 F.3d 1345, 1352 (Fed. Cir. 2007). Furthermore, recent BPAI decisions demonstrate the necessity for providing applicants an opportunity to present rebuttal evidence and even potentially penalizing applicants for failing to present rebuttal evidence. *In re Jung*, Appeal 2008-003711, pg. 4-5 (holding that the applicant must present rebuttal evidence demonstrating that the applicant has met the statutory requirements for patenting over the rejection of the Examiner and cannot simply demonstrate that the Examiner failed to make out a *prima facie* rejection). Moreover, the ability of Board to suspend its

¹ The Request for Comments incorrectly states that the evidence to be submitted need only overcome one rejection under appeal to be admissible. PTO-P-2009-0021, pg. 67991.

own rules, regarding no submission of evidence on appeal, and request such evidence under 37 C.F.R. §41.50(f) cuts against the legitimacy of what otherwise amounts to an effective blanket rule of no rebuttal evidence on appeal.

The Office purports to justify the strict evidentiary rules on submission of rebuttal evidence as necessary for the efficient administration of the appeals process. While modifying the rules to comport with the APA and the case law will undoubtedly increase the workload of the Office, the current rules cannot rely solely on administrative efficiency to justify violating due process and the right of applicants to a full and fair appeal of an Agency decision. A potential solution to the conflict is for the Office to modify the rules so as to encourage submission of evidence prior to the Examiner's answer. This will provide applicants an opportunity to submit rebuttal evidence as well as allow the Examiner to comment on the rebuttal evidence.

Category 7 – Appeal Brief

Comment I-7a: Clarified Definition of Related Case

The Office should clarify the scope of “related case” as defined in 37 C.F.R. §§41.37(g) with respect to other definitions of “related case” currently adopted by the Office. A “related case” as defined in 37 C.F.R. §§41.37(g) includes any continuing applications or requests for continued examination. The narrow definition of “related case” adopted by the Office in 37 C.F.R. §§41.37 with regards to appeal briefs differs in scope with the significantly broader definition of “related case” adopted by the Office with regards to Information Disclosure Statements (“IDS”). *See e.g. Larson Mfg. Co. v. Aluminart Products Ltd.* (Fed.Cir. 2009) *McKesson Information Solutions v. Bridge Medical* (Fed.Cir. 2007). The different definitions of “related case” creates confusion for parties as to which definition of “related case” is applicable. The Office should either clarify the relationship between the two definitions of “related case,” adopt new terminology for one or both definitions, or adopt a common definition for both usages.

Comment I-7b: Authority for the presumption of correctness

The Office should present authority supporting the presumption of validity accorded to any decision of the Examiner unchallenged by the Applicant on Appeal pursuant to 37 C.F.R. §§41.37(o)(2). While there may be case precedent establishing the standard of review and presumptions to be accorded a judicial review of an Agency determination, the commenter is unaware of any judicial or statutory authority for the proposition of a presumption of correctness of an

initial agency action in an informal agency process. Given the ex parte and relatively informal nature of the agency proceedings before an Examiner, the creation of this kind of presumption solely by rule-making is beyond the authority of the Office and in direct conflict with the spirit and letter of the APA, which by statute, affords any party before an agency the benefit of due process and the right to effectively present a case, including rebuttal evidence, to the final body that renders the action for the Agency.

General Comments

It is recommended that the Office look to other kinds of intra-agency appeals that can serve as good analogs for helping to craft the Ex parte Appeal Rules—e.g., Social Security in context of ex parte more informal agency actions. Given the push by the Office for more efficient resolution by advocating for early interviews and early submission of evidence, the Office looks to engage applicants in a more hearing like interaction that moves these agency actions along the spectrum from informal to formal agency action. In pushing for these kinds of changes, however, the Office cannot ignore the requirements of the APA and attempt to craft the very kind of special rules for patents which the Supreme Court has in numerous recent decisions invalidated.