

From: Craig Rochester [comprising@gmail.com]
Sent: Friday, February 26, 2010 8:09 PM
To: BPAI Rules
Subject: Linda Horner; BPAI Rules modifications comments
Dear Sirs,

I write in regard to several proposed rules for 37 CFR Part 41 discussed in the Federal Register, Vol. 74, No. 244 [Docket No.: PTO-P-2009-0021].

**Rules of Practice Before the Board of
Patent Appeals and Interferences in Ex
Parte Appeals; Request for Comments
on Potential Modifications to Final
Rule and Notice of Roundtable During
Comment Period**

I am a registered patent attorney (Reg. No. 43,052), and I find several of the proposed rules unnecessary and potentially detrimental to my ability to serve my client.

Specifically, with respect to proposed rule 41.3:

“Bd.R. 41.3 is amended to include a delegation of authority from the Director to the Chief Administrative Patent Judge to decide certain petitions authorized by Part 41. The delegation of authority would be in addition to that already set out in the MPEP § 1002.02(f) (8th ed., Aug., 2006).

Bd.R. 41.3(b) is amended to define the scope of petitions which can be filed pursuant to the rules. Under Bd.R. 41.3(b), a petition could not be filed to seek review of issues committed by statute to a panel. *See, e.g., In re Dickinson*, 299 F.2d 954, 958 (CCPA 1962).”

This proposed change would seemingly impair efficiency at the BPAI, as it would place additional petition duties on the Chief APJ. With the current large backlog of Appeals at the BPAI, in the interests of efficiency it would be desirable for the Chief APJ to do as much work as possible on hearing these appeals instead of addressing petitions.

Also, it is not in my client’s interest to have fewer issues on which he may obtain review by petition. I don’t see any reason to change the existing scope of available petitions.

Further, with respect to proposed rule 41.37(o):

“Bd.R. 41.37(o) requires that an appeal brief contain an argument comprising an analysis explaining, as to each rejection to be reviewed, why the appellant believes the examiner erred.”

This proposed change misapprehends the standard of review by the BPAI. As I understand it, review by the BPAI asks whether an examiner has met her burden of making a prima facie case of unpatentability, or where this burden has been met, whether the applicant has adequately rebutted a prima facie case of unpatentability. To my knowledge there is no BPAI review standard requiring an applicant to identify examiner error. The Federal Register further states regarding this rule that “Bd.R. 41.37(o) provides that any finding made or conclusion reached by the examiner that is not challenged would be presumed to be correct.” This rule placing blind acceptance on uncontested examiner actions seems contrary to a conscientious appeal process. Is the BPAI primarily concerned with affirming examiners or with providing quality PTO examination of applications? Sadly, this proposed rule suggests that the former is the case.

Further, with respect to proposed rules 41.37(r) and 41.37(s):

“Bd.R. 41.37(r) requires an appeal brief to contain a ‘claim support and drawing analysis section.’”

And

“Bd.R. 41.37(s) requires an appeal brief to contain a ‘means or step plus function analysis section.’”

These proposed changes would force applicants to do the work of the PTO for it. Applicants pay the PTO to evaluate applications. For a patent attorney to evaluate a filed application in an appeal proceeding is potential malpractice. To do so is to potentially waive arguments or take positions that create estoppels or disclaimers. To do so when the PTO is charged with doing so under the patent act and its own rules (see, e.g., 35 USC § 112) is tantamount to malpractice. The PTO has been evaluating “claim support” and doing “drawing analysis” for hundreds of years. There is no reason why applicants should be forced to do that job now, BPAI backlog notwithstanding.

Further, with respect to proposed rule 41.37(t):

“Bd.R. 41.37(t) would require an

appeal brief to contain an “evidence section” in the appendix.”

This proposed change requires an applicant to list the various forms of evidence in support of his application. This proposed rule should contain a reciprocal provision requiring the PTO (preferably the examiner) to also list the evidence relied on in making a prima facie case for unpatentability, particularly for art-based rejections.

Further, with respect to proposed rule 41.50(b):

“Bd.R. 41.50(b) provides that the Chief Administrative Patent Judge may remand an application to the examiner.”

It is unclear to me why the BPAI wants to limit remand authority to the Chief APJ. Why introduce an additional layer of bureaucracy to the process? The notice suggests that this is a matter of “administrative efficiency,” however it seems more efficient to allow the Board or the panel of APJ’s that decided the remand to directly order the remand. Why make them send it up to the Chief APJ for an extra level of review?

Further, with respect to proposed rule 41.56:

“Bd.R. 41.56 is new and provides for sanctions. The rule is designed to put the public on notice of actions which the Office believes are detrimental to the efficient handling of ex parte appeals. Bd.R. 41.56(a) provides that the Director may impose a sanction against an appellant for misconduct. Misconduct would include (1) failure to comply with an order entered in the appeal or an applicable rule, (2) advancing or maintaining a misleading or frivolous request for relief or argument, or (3) engaging in dilatory tactics. A sanction would be entered by the Director. A sanction would be applied against the appellant, not against a registered practitioner. Conduct of a registered practitioner could result in a sanction against an appellant. Conduct of a registered practitioner believed to be inappropriate

would be referred to the Office of Enrollment and Discipline for such action as may be appropriate.”

This proposed rule is fraught with the potential for abuse. The terms are ill-defined (e.g., what are dilatory tactics? What is a frivolous argument? What is a misleading request for relief?) This rule apparently gives the BPAI wide latitude to punish applicant behavior that it finds objectionable. There does not appear to be a mechanism by which an applicant can appeal a sanction levied against it. The potential for abuse is frightening.

And what will this sanctions process cost the BPAI in efficiency? Who will conduct sanctions review? Will there need to be a specialized committee at the BPAI to handle sanctions? Will fewer appeals be heard because of the time required to address sanctions-related matters? I would prefer that the BPAI address its backlog to help applicants and not look for additional ways to punish them.

And does the BPAI and the Director have statutory authority to levy these specific sanctions? In the PTO’s notice, it states “in addition to the Director’s explicit authority to establish regulations which shall govern the conduct of proceedings in the Office (35 U.S.C. 2(b)(2)(A)), the Director has, and always has had, inherent authority to enforce the rules and to impose an appropriate sanction.” But what is this “inherent authority”? The PTO states that “[p]otential modifications to final rule 41.56 provide for sanctions against an appellant when appropriate.” But again, this begs the question: what is “appropriate”? and who decides what is “appropriate”?

Sincerely,

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