

Patent Litigation and Counseling Services

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September 28, 2007

Department of Commerce  
Patent and Trademark Office  
BPAI.Rules@uspto.gov

RE: Proposed Rule Making For Practice Before the Board of Patent Appeals  
and Interferences in *Ex Parte* Appeals

Sir:

Please consider the following comments with respect to the proposed rules.

Generally, appeals should be conducted in a manner more similar to appellate proceedings with which attorneys are familiar in both state and Federal courts. Specifically, this would require set time limits for filing briefs, transfer of jurisdiction immediately upon filing of the Notice of Appeal, a pilot program for a solicitor's office within the Patent Office for *ex parte* appeals and less micro-management.

1. Transfer of Jurisdiction

Rule 41.35(a) does not go far enough. It is well known (see statistics on the Patently-O blog) that the delay in *ex parte* appeals occurs during the period after the Notice of Appeal is filed and the matter is finally docketed by the Board. Briefs should be filed with the Board, not with the Examining corps, and served on the opposing party (Examiner or applicant) as in any appellate proceeding. If you think about appellate practice, it will be apparent to you that it is absurd that the Examiner should be allowed to reject a brief filed by an applicant -- he or she is the adversary, not the Board. It is commonly understood by patent practitioners that Examiners, when pressed for time, will simply reject the brief requiring appellant to refile the brief and thus starting the whole process of Examiner response and applicant reply over again - resulting in needless delay. You should visit the statistics of how many appellate briefs are rejected by Examiners. I think you will find that there is game playing in that

regard.

Of course, transferring the responsibility for deciding whether an appellate brief is in compliance with the rules would require a larger BPAI staff, but since it would be their daily fare, they would become much more efficient at determining whether the brief is proper. Moreover, they would be more objective. And please see the comment below regarding the contents of briefs.

2. Proposed Rule 41.39(a)

The above suggestion should be combined with modification to Rule 41.39 such that the Examiner is required to submit a brief in response to the appellant's brief within a fixed period of time. Furthermore, there is no conceivable reason why the Examiner should be allowed to raise a new rejection after a notice of appeal is filed. That just allows Examiners to enter sloppy Final Rejections based on an inadequate search or not setting forth his or her best reasons for rejecting claims. If the Examiner requires more time to file a brief, there should be a motion clerk at the BPAI who would perhaps grant extensions of time of 30 or 60 days but any additional requests for extension of time would be required to be accompanied by good cause and sufficient reasons. Then of course the appellant should be given a fixed period of time in which to file the reply brief.

3. Proposed Rule 41.37

The Patent Office is micro managing, to everyone's disadvantage, the appeal brief requirements. Continuing to set forth detailed requirements as in Rule 41.37 generally, will only result in more briefs being rejected, time wasted, with no real advantage to either the USPTO or the applicant. The attempts in Rules 41.37(n) and 41.37(o) demonstrate that the Patent Office is overly solicitous of the applicant's ability to prosecute an appeal. As set off in the discussion of Rule 41.37(n), many appellate courts will simply dismiss an argument if not properly advanced or if fact-based support is not accompanied by appropriate record references. The Board should certainly caution or encourage appellant to write a good brief, but that is the responsibility of the appellant, not the USPTO. Micro-managing the process in an attempt to develop a template for review by the Board of Appeals is counterproductive. The comment in Rule 41.37(o)(1) is much more appropriate because it makes clear that if the appellant does not properly, in the case of this rule, either explicitly state "stand or fall," the Board would simply consider them as "fall together." In other words, it is the appellant's responsibility to file a brief that can be understood and assimilated by the Board members and a failure to do so would result in a rejection of the appeal. The level of detail in Rule 41.37 is simply a trap for unwary appellants. There are too many details required and it is unlikely that they have any productive effect.

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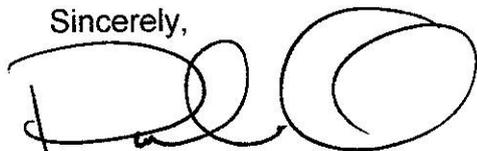
4. In General

Examiner's are not properly trained, do not have the proper disposition, and generally write extremely weak Examiner Answers. The USPTO should seriously consider establishing an interior solicitor's office to handle all *ex parte* appeals on behalf of the Examiners. Of course this would entail a massive reassignment of personnel and thus should properly be approached with a pilot program. And a pilot program should start with all appeals in reexaminations. You surely cannot be unaware that the statement in § 1.550(a) that *ex parte* reexaminations "will be conducted with special dispatch" is a joke. One of my current reexaminations has been in the Patent Office for five years. In another reexamination, the brief was filed in January, lost in the USPTO, refiled in March, and six months later the Examiner filed a form Action that rejected the brief.

A new type of organizational structure would permit the Office to field highly trained appellate practitioners, i.e., filing effective Examiner Answers. Furthermore, as is well known in all litigation circles, the responsibility of an appellate lawyer to write a convincing brief based on the record handed to him or her, generally results in a frank reassessment of the potential success of the appeal because the lower court record is botched. Thus, the internal solicitor when handed a Final Rejection that is simply unsupported could simply turn to the Examiner with a recommendation (completely internal) to either reconsider the Final Rejection or to frame it in a more articulate manner. That would result in much better appeals than the current pilot program for pre-appeal conferences. Such conferences are ineffective because the conferees are not engaged (meaning accepting any responsibility for defending the Final Rejection) as would be the case where an internal solicitor faced with the possibility of defending an inadequate Final Rejection would return the matter to the Examiner and likely result in a more successful appeal on behalf of the USPTO.

Than you for the opportunity to comment on the proposed rules.

Sincerely,

A handwritten signature in black ink, consisting of a series of loops and curves, positioned to the right of the word "Sincerely,".

Paul Adams