

September 27, 2007

By electronic mail to: BPAI.Rules@uspto.gov

The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Mail Stop Interference
P.O. Box 1450
Alexandria, VA 22313-1450

Ex parte Appeal Rules

Dear Under Secretary Dudas:

Eli Lilly and Company appreciates the opportunity to offer comments regarding the proposed changes to the Rules of Practice before the Board of Patent Appeals and Interferences in Ex Parte Appeals, published at 72 Fed. Reg 41472 (July 30, 2007).

Proposed modifications to Bd.R. 41.37 introduce unnecessary exposure to allegations of inequitable conduct.

We understand that the proposed modifications to Bd.R. 41.37 are proposed to provide the examiners and the Board with a clear and complete statement of an appellant's position at the time of filing the appeal brief thereby allowing the Board to handle the increasing number of *ex parte* appeals in a timely manner. Nevertheless, it appears that the Office is shifting responsibilities of the Board to the appellant, making the filing of an appeal brief overly burdensome for the appellant. In particular, with respect to Proposed Bd.R. 41.37(t), the Office should have the entire case file in their possession, including office actions, declarations, affidavits, and appellant responses for easy reference. Requiring the appellant to provide evidence already in the record may result in the introduction of inadvertent errors into the appeal record, unnecessarily exposing the appellant to charges of inequitable conduct in later proceedings. We request that you consider an automatic transfer of the evidence already in the prosecution record for the appeal process.

The 25 page limit for the appeal brief, including prior argument and statement of facts, may not allow proper representation of the case.

The proposed modifications to Bd.R. 41.37 includes a 25 page limit (Proposed Bd.R. 41.37(v)(5)) that would include the jurisdictional statement, the status of claims, the status of amendments, the rejections to be reviewed, the statement of facts, and the argument sections. Currently, there is no page limit for appeal briefs. Placing a 25 page limit on the appeal brief, including the above-noted sections along with the 14 point font (Proposed Bd.R. 41.37(v)(4)) and double line spacing (Proposed Bd.R. 41.37(v)(2)) requirements may prevent an appellant from properly setting forth the relevant arguments. Under the proposed rule, the rejections to be reviewed and statement of facts are included when determining the 25 page limit.

The 25 page limit is particularly problematic for the appellant requiring a restatement of lengthy rejections and statement of the relevant facts. As the length of the rejections and facts section increases, it seems reasonable to

expect that the arguments section will necessarily increase in length to address such issues. Yet, as the rejections to be reviewed and statement of facts increase in length, the argument section will need to be reduced in length due to the overly restrictive 25 page limit, 14 point font, double-line spacing requirements. Thus, the appellant, having no control over the length of the rejection or relevant facts, may be left with the unduly burdensome 25 page restriction.

We appreciate that a request to exceed the page limit may be made under a Bd.R. 41.3 petition filed with the Chief Administrative Patent Judge. However, the requirement for a Bd.R. 41.3 petition appears to hamper efficient decision-making by both the Office and the appellant. The Office will have the added administration process associated with the petition, while the appellant may not properly draft their arguments until the decision regarding the discretionary grant of additional pages pursuant to the Bd.R. 41.3 request is communicated.

We respectfully request that you consider modifying the proposed change to Bd.R. 41.37(v) such that the 25 page limit, at a minimum, does not include the rejections to be reviewed and the statement of facts sections. The appellant has little, if any control over the length of these sections, and should properly be permitted to include the rejections and statement of facts with the statement of the real party in interest, the statement of related cases, the table of contents, the table of authorities, the signature block, and the appendix. We propose that the appellant should be permitted to provide this essential information exclusive from the 25 page limitation.

In addition, we suggest that the font and line spacing requirements for the appeal brief should correspond to the current requirements for patent applications as set forth in 37 C.F.R. § 1.52(b)(2)(i). That is, the line spacing should be 1.5 spaced, rather than double spaced. Further, we suggest that the page limitations should correspond with Rule 32(a)(7)(A) of the Federal Rules of Appellate Procedure, wherein a principal brief may not exceed 30 pages. The 1.5 line spacing and maximum 30 page brief requirements are in accordance with the current requirements for patent applications and the Federal Rules of Appellate Procedure respectively, to provide a consistent and reasonable standard.

Alternatively, we suggest that rather than requiring a Bd.R. 41.3 petition to the Chief Administrative Patent Judge requesting that the page limit of an appeal brief be enlarged, we suggest that a procedure corresponding to a Rule 136(a) extension of time be implemented. For example, an appellant is unlikely to know that additional pages may be needed for a properly drafted brief which satisfies the added requirements under the proposed rules until they are finished drafting the brief. In addition, there may not be sufficient time to file a Bd.R. 41.3 petition and there is no guarantee that the petition will be granted by the Chief Administrative Patent Judge. Therefore, we propose a rule that allows the appellant, who discovers that their brief is over the 25 page limit, to submit a *pro forma* petition with the filing of the brief requesting, for example, a 5, 10, 15, or 20 page extension of brief length and pay a corresponding fee. As with the extension of time fees, the fee would increase depending upon extra pages requested, for example in 5 page increments. This would encourage careful and precise drafting of the brief while allowing the appellant the choice of enlarging the brief length under proper circumstances. The Office would avoid adding yet another administrative process while providing appellants with relief when additional pages are warranted for proper presentation of the case. Moreover, the fee for this petition could be prorated for those appellants satisfying small entity status.

The supplemental examiner's answer may include a new ground of rejection.

We note that current Bd.R. 41.43(2) expressly states that a supplemental examiner's answer responding to a reply brief may not include a new ground of rejection, while Proposed Bd.R. 41.43 is now silent on this issue. In contrast, Proposed Bd.R. 41.39(b) expressly states that the examiner's answer may include a new rejection. We submit that the examiner should set forth relevant rejections as promptly as possible. The examiner should have set forth all relevant rejections before the supplemental examiner's reply. It is suggested that the new rule should conform with the requirements in current Bd.R. 41.43(2), and expressly limit the supplemental examiner's answer to points raised in the appellant's reply brief. We suggest that a new ground of rejection may not be

raised in the supplemental examiner's answer. Furthermore, since Proposed Bd.R. 41.39(b) expressly allows for a new rejection and Proposed Bd.R. 41.43 is silent on the issue, there is an unnecessary ambiguity which can easily be clarified by expressly prohibiting the introduction of a new rejection in the examiner's supplemental answer.

Finally, in contrast to Proposed Bd.R. 41.39, Proposed Bd.R. 41.43 does not provide the appellant with the two options of either filing a request to reopen prosecution or a request to maintain the appeal. This could cause a serious procedural issue for the appellant under the following situation. If the examiner provides a new rejection in the examiner's supplemental answer and the appellant has used all of their continuations and RCE pursuant to the new rules on continuations as provided in 37 C.F.R. § 1.78(d)(1) and 37 C.F.R. § 1.114(f), the appellant would not be permitted to make any amendments necessitated by the new rejection. This is exacerbated by the fact that the appellant cannot file a request to reopen prosecution as is provided in Proposed Bd.R. 41.39(b)(1).

Thus, we request that you consider modifying Proposed Bd.R. 41.43 with regard to new grounds of rejection in the supplemental examiner's answer, to provide the same options provided in Proposed Bd.R. 41.39. That is, the appellant may choose to file a request to reopen prosecution or to maintain the appeal. Alternatively, the Office could state in its comments on the comments that the above circumstances would satisfy the showing under new rules 37 C.F.R. § 1.78(d)(1)(vi) and 37 C.F.R. § 1.114(g) requiring a petition and a showing to allow the appellant to file an additional continuation or request for continued examination.

The 10 page limit on the supplemental reply brief for responding to an examiner's new ground of rejection may unfairly restrict the appellant.

If the examiner is allowed to present new grounds of rejection under Proposed Bd.R. 41.43, then the 10 page limitation on the supplemental reply brief pursuant to Proposed Bd.R. 41.44(d) may unfairly restrict the appellant. If the examiner presents new grounds for rejection, the appellant should be permitted to file an adequate response to the new grounds. It is appreciated that the appellant can petition under Bd.R. 41.3 to exceed the page length. However, as stated above, such petitions will increase the administrative burden on the Office and hamper the appellants' ability to properly draft a response when the grant of a Bd.R. 41.3 petition is uncertain.

As discussed above for Proposed Bd.R. 41.37(v), we suggest that a procedure for a nominal extension of page limitation, corresponding to a Rule 136(a) extension of time, would be efficient and reasonable. We suggest that the appellant could file a *pro forma* petition for a 5, 10, or 15 page extension of the supplemental reply brief length, and pay a corresponding fee. Such a *pro forma* petition would eliminate an administrative process while enabling appellants to plan their arguments without unreasonable constraints. Moreover, the fee could be prorated for those who qualify for small entity status.

The new rules on continuation practice unfairly limit appellant's ability to amend.

We submit that the appellant's ability to amend the application during the appeal process should be reconsidered in light of the new rules on continuation practice. For example, under Proposed Bd.R. 41.39(b)(1), the appellant has the option of filing a request to reopen prosecution if the examiner's answer includes a new rejection. However, the appellant, wishing to expedite prosecution, may be persuaded to concede to an examiner's convincing argument that is not properly considered a new ground of rejection. Such concession by the appellant often requires amendments to the claims. Typically, it requires canceling an independent claim and amending the corresponding dependent claims. We suggest that the proposed rule requiring a continuation or RCE to make such amendments in furtherance of prosecution, is both unduly restrictive, discourages expeditious prosecution, and is unfair to the appellant.

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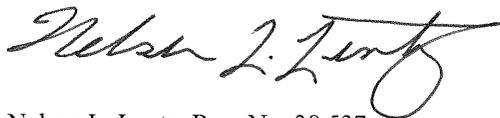
Thus, if the appellant has used their two continuations and single RCE pursuant to the new rules found in 37 C.F.R § 1.78(d)(1) and 37 C.F.R. § 1.114(f), then he/she would be precluded from properly prosecuting the subject patent application. We propose that in view of the new restriction on continuation practice, the appellant should be permitted to reopen prosecution at this time regardless of whether a new rejection has been raised in the examiner's answer or not.

Summary

We request your consideration of our comments and suggestions, in particular regarding the proposed amendments to Bd.R.'s 41.37, 41.37(v), 41.39(b)(1), 41.43, and 41.44(d).

We appreciate the opportunity to provide comments on the proposed rules and request reconsideration in view of the points set forth above.

Respectfully submitted,



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