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Via email BPAI.Rules@uspto.gov

Mail Stop Interference
Director of the United States Patent and Trademark Office
P.O. Box 1430
Alexandria, Virginia 22313-1430

Re: ***Ex Parte Appeal Rules***

Good Morning:

I write to comment on the proposed changes to the *Rules of Practice before the Board of Patent Appeals and Interferences in Ex Parte Appeals*, published in the Federal Register, Volume 72, Number 145 on July 30, 2007 (the "**Proposed Rules**").

The Board of Appeals and Interferences (the "**Board**") has the statutory duty of reviewing adverse decisions of examiners upon applications for patents as provided in 35 U.S.C. § 6(b). The Board is to be commended for its efforts in reviewing *ex parte* appeals, and efforts to expedite its decisions are to be encouraged. However, certain of the Proposed Rules would have effects directly contrary to the stated goal of streamlining the appeal process, by imposing new requirements and mandating the briefing of issues that are not in dispute with regard to the particular patent application that is the subject of the appeal.

The vast majority of appeals present issues concerning whether the claimed subject matter is patentable in view of 35 U.S.C. §102 or §103. Further, the patent examiner will always give the claims the "broadest reasonable interpretation" in accordance with the policy of the Office. In most appeals there is no question that there is support for the claims in the specification and/or the drawings. In cases where there is no disagreement between the examiner and the applicant, there should be no need for the applicant to provide a "claims support section" or a "drawing analysis section" as required in Proposed Rules 41.37(q) and (r) respectively. Further, requiring applicants to submit such information is not consistent with the Board's statutory authority to "review adverse decisions of examiners," because in such situations there has been no decision adverse to the applicant holding that the claims are not supported by the application. It is therefore suggested that these Proposed Rules not be adopted.

Members of the Board are knowledgeable as to the legal issues that commonly arise in *ex parte* appeals; for example, issues related to 35 U.S.C. §102, §103, and §112. Because these

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issues arise so frequently before the Board, the Board is familiar with the applicable legal standards and the commonly cited case law which provides the basis for these standards. The requirement set forth in Proposed Rule 41.37(e)(5) to include a table of authorities is unnecessary, and requires additional effort on behalf of the applicant without any corresponding value to the Board. It is suggested that this Proposed Rule be deleted.

Proposed Rule 41.37(o)(1) would require that each claim be argued separately and under a separate subheading if the applicant wishes to have the patentability of that particular claim separately considered. Further, the Notice of Proposed Rulemaking suggests that the Board prefers a more detailed argument than the applicant indicating that the claim recites specific features and relationships that are not shown or suggested by the cited art. This requirement will add to the length of appeal briefs. The imposition of this requirement for more lengthy argument is inconsistent with Proposed Rule 41.37(v)(5) which limits an appeal brief to 25 pages. Such a limitation is grossly unfair, given that rejections presented by examiners often extend for substantially more pages. Applicants should have an absolute right to present appeal briefs of sufficient length to respond to the rejections that are presented by the examiner. The Proposed Rule which would preclude submitting a brief of an appropriate length to respond to the rejections absent the grant of a petition, is fundamentally unfair to applicants. Similarly, the requirement in Proposed Rule 41.41(d) which limits an applicant's reply brief to 15 pages does not give applicants the absolute right to rebut the arguments presented in an examiner's answer. Again, this is particularly true given that the Proposed Rules impose no limitations on the length and number of rejections, or extent of the arguments that can be presented in an examiner's answer.

There is no statutory or other requirement that the particular argument presented by an applicant in its appeal brief must have previously been presented to the examiner. Further, there are many instances in which an examiner's Office action fails to specify where the features and relationships recited in the applicant's claims are allegedly shown in the cited art. In addition, there is no basis in law for the Board to presume that a decision reached by an examiner concerning an applicant's argument is correct. As a result, the requirements set forth in Proposed Rule 41.37(o) to discuss prior arguments made by the applicant and the examiner, and particularly the examiner's opinion concerning the applicant's arguments, should carry no weight whatsoever in connection with the Board's review. The judges on the Board have an obligation to review adverse decisions to applicants in a fair, impartial, and *de novo* manner, based on the record and the arguments that are presented to the Board by the applicant and the examiner. Proposed Rule 41.37(o) appears to be an attempt to shift the burden to the applicant to show that the examiner's prior holding is incorrect. Such a rule is not consistent with the duties of the Board as provided in 35 U.S.C. §6.

A further provision in the Proposed Rules which is contrary to the stated goal of streamlining the appeal process, is Proposed Rule 41.30 that would require the "record on appeal" to be limited to certain items, rather than the entire administrative record. For example, Proposed Rule 41.37(t) requires that an appeal brief include an evidence section with the examiner's actions, the applicants' submissions and arguments, and the evidence relied on by the examiner and the applicant to date during prosecution. All of this information is already in the file and is readily available to the Board. To require its resubmission by the applicant as part of the applicant's brief would be simply wasteful, and would result in unnecessary effort by the applicant. Further, the suggestion that the "record on appeal" should be something other than the entire administrative record before the Office, has the potential to deny applicants the right to review of improprieties that may have occurred. It is therefore suggested that Proposed Rule 41.30 and Proposed Rule 41.37(t) not be adopted.

Proposed Rule 41.56 would authorize the Board to impose sanctions on applicants for certain misconduct. The statutory authority of the Board does not include any right to impose sanctions. Rather, the authority of the Board in *ex parte* appeals is limited to the review of adverse decisions by examiners. Therefore, this Proposed Rule appears to be in fundamental conflict with the statute. In addition, this Proposed Rule does not specify an applicant's rights of appeal from the imposition of sanctions. As this Proposed Rule fails to grant an applicant a right of appeal from any sanctions, it constitutes a denial of due process rights.

The Proposed Rules fail to address several factors which unduly prolong patent prosecution. These factors include repeated reopening of prosecution by the examiner after an appeal brief is filed, as well as after a decision by the Board in which all of the original rejections presented by the examiner were reversed. Such repetitive reopening of prosecution has the effect of preventing judicial review of agency action. Such repetitive reopening of prosecution is also contrary to fundamental legal principle that an administrative agency cannot avoid review of its actions by continuously keeping open activity which prevents judicial review. *Southern Pacific Terminal Co. v. Interstate Commerce Com.*, 219 U.S. 498, 55 L.Ed. 310, 31 S.C. 279 (1911). For example, Application Serial Number 09/193,787 filed by the undersigned has had prosecution reopened after appeal four times, including three times subsequent to the Board rendering a decision in which all of the rejections presented by the examiner were reversed. Likewise, in the case of Application Serial Number 09/077,337, the Office has reopened prosecution after appeal on three occasions, including after a decision by the Board reversing all of the examiner's rejections. In order to assure more compact prosecution, and to preserve the rights of applicants, it is suggested that a rule be adopted that prevents the reopening of prosecution more than one time after appeal in any application. This will help to speed cases to a final resolution.

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In addition, it is respectfully suggested that the Office impose time limits on how long an application may remain with an examining group before it is transferred to the Board. The undersigned has encountered situations where the examining group has held the file for more than a year after a reply brief was filed, before forwarding the file to the Board. It is suggested that the Office impose a policy that requires the file to be delivered to the Board within three months of submission of the reply brief.

It is also noted that while under the Proposed Rules applicants would be held to strict time limits related to submission of the papers, the new Proposed Rules do not impose any such requirements on the submission of an examiner's answer. To achieve more compact prosecution, the Office should consider a requirement that the examiner's answer be mailed no later than three months from the date of the submission of the applicant's appeal brief. Doing this will help assure more compact prosecution.

In conclusion, many of the Proposed Rules will have effects directly opposite to the Office's goal of streamlining appeals and making patent prosecution more compact. The adoption of the many of the Proposed Rules would result in unnecessary effort and paper work to address matters that are not at issue in the majority of appeals. This unnecessary effort and paper work will unfairly burden applicants without providing any substantial benefit. Therefore, I urge that these Proposed Rules not be adopted.

Very truly yours,



Ralph E. Jocke

REJ/lch