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FROM: Pamela Banner Krupka
Chair, Section of Intellectual Property Law
American Bar Association

RE: Proposed Changes to the Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals

The Intellectual Property Law Section of the American Bar Association represents over 17,000 members concerned with intellectual property issues. On behalf of this Section, we respond to your request for comments on proposed changes to the Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals, as published in the Federal Register of July 30, 2007. (72 Fed. Reg. 145) The views expressed herein are those of the Section of Intellectual Property Law. They have not been submitted to the House of Delegates or Board of Governors of the ABA, and should not be construed as representing policy of the Association.

Comments on USPTO Board Rules Proposal

The proposed rules govern practice before the Board of Patent Appeals and Interferences (Board). As stated by the United States Patent and Trademark Office (USPTO), the proposed rules seek to provide examiners and USPTO reviewers with a clear and complete statement of an appellant's position at the time of filing an appeal brief. The USPTO believes that such a clear and complete statement of an appellant's position will: (1) enhance the likelihood that appealed claims will be allowed without the necessity of further proceeding with the appeal, (2) minimize the pendency of appeals before the USPTO, (3) minimize the need for lengthy patent term adjustments, (4) provide uniform treatment of requests for an extension of time filed after an appeal brief is filed, and (5) make the decision making process more efficient.

A significant portion of the new rules relates to the content of a brief filed with the Board. Under the proposed rules, an appeal brief would require additional sections/statements, such as a jurisdictional statement, table of contents, table of authorities, statement of facts, and expanded argument and appendix sections. The

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proposed rules also limit the size of an appeal brief to 25 pages (excluding certain formal sections of the brief) and require that the brief be submitted in 14 point font.

Also under the proposed rules, the arguments section of the brief must address all points made by the examiner with which appellant disagrees, and must identify where the argument was made in the first instance to the examiner or state that the argument has not previously been made to the examiner. Further, in addressing an examiner's rejections under 35 U.S.C. § 112, first paragraph, the proposed rules require the appellant to specify how the claims comply with the first paragraph of 35 U.S.C. § 112. Similarly, the proposed rules require an appellant to explain how certain limitations of a claim render the claim unobvious over the prior art when the claim is rejected under 35 U.S.C. § 103. The proposed rules also require that a brief include a claim support section and drawing analysis section that pinpoints the support in the specification and drawings for each claim element of each claim being argued.

While the Section generally supports the rules, there are certain requirements of the appeal brief which it opposes in their present form as creating a greater burden than the resulting benefits justify.

In particular the proposed rules appear to impose unnecessary burdens in the rebuttals to rejections under 35 U.S.C. §103. The Section specifically opposes proposed rule§ 41.37 (o)(7). This rule requires appellant to identify the specific limitations in the rejected claims that are not described in the prior art relied upon in support of the rejection, and further to explain how certain limitations of a claim render the claim unobvious over the prior art when the claim is rejected under 35 U.S.C. § 103. It is a fundamental principle that the USPTO has the burden of presenting a prima facie case of unpatentability. See, e.g. 35 U.S.C. § 102; “[a] person shall be entitled to a patent unless” Under the prevailing case law, an applicant need only show either that all of the claim limitations are not found in the applied art or, if some limitations are found in one reference and others in another reference, that the references are not properly combinable to provide a unified teaching of all the claim limitations. Thus, an appropriate traversal of an examiner's rejection should only require pointing out the deficiencies in the examiner's prima facie case. The proposed rules should not require more. An applicant may choose to provide an explanation of patentability but should not be required to do so.

The Section further opposes proposed rules §§ 41.37(q) and (r). These proposed rules require that for each claim argued separately, the appellant is required to show where every claim limitation finds support in the specification and where every claim limitation which is illustrated in the drawings is to be found in the drawings. These requirements appear to apply even where a claim limitation is not at issue. The appropriate burden is to require applicant to show where support is to be found for any limitation challenged in a rejection. If the Examiner has not challenged the support for a

given claim limitation, there is little point in requiring an identification of where in the descriptive portion of the specification a limitation appears.

The requirement of the proposed rule for a drawing analysis section pinpointing the support in the drawings for each claim limitation of each claim being argued is another example of how the burdens of the proposed rules outweigh their benefits. The task of pinpointing support in the drawings can be burdensome, especially in applications disclosing multiple embodiments. However, the benefit of providing this detailed explanation of support will be minimal. For example, if the appealed claims have not been rejected under 35 U.S.C. § 112, first paragraph, this requirement to identify support in the drawings is only minimally relevant to a decision affirming or reversing a rejection. Further, if the appealed claims are rejected under 35 U.S.C. § 112, first paragraph, the support issues will be fully addressed in the arguments section of the appeal brief. Also, in almost all instances, the pinpointing of specification support for a claim limitation via the proposed claim support section will identify where the claim limitation can be found in the drawings. The only benefit provided by this requirement of the proposed rules would be to assist someone unfamiliar with the application in identifying where the claimed subject matter is shown in the drawings. The Section believes this benefit is outweighed by the burden on the applicant.

Sincerely,



Pamela Banner Krupka
Chair
Section of Intellectual Property Law