

The Honorable Jon W. Dudas
Under Secretary of Commerce for Intellectual Property
And Director of the U.S. Patent and Trademark Office
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September 28, 2007

Comments on Proposed Rules: “Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals” (“Ex Parte Appeal Rules”)

Dear Under Secretary Dudas:

Greenblum & Bernstein, P.L.C., the undersigned, is a law firm located in Reston, Virginia, that specializes in all aspects of intellectual property law. The firm currently employs over 35 registered attorneys and agents that engage in prosecuting and litigating in various areas of intellectual property. The firm also files well over 1000 new applications for patents each year and regularly files appeals to the Board of Patent Appeals and Interferences (“Board”). Thus, the firm has an active interest in the proposed rule changes set forth in 72 Fed. Reg. 41472 (July 30, 2007). Starting from the premise expressed in existing 37 CFR § 41.1(b), “The provisions of Part 41 shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding before the Board,” our comments on specific aspects of these proposed rules follow.

A global comment, considering all the changes to the brief as a whole, is that we believe that briefs will require more time and effort to prepare, and consequently, will be more expensive as a result of the requirements proposed. We recognize that some of the changes (e.g., font sizes, page limits, margins, line

numbering requirements, tables of contents and authorities) simply make briefs to the Board more like those required by courts. Others, however, are unique to the Board, requiring that claims be argued in a specific way, or risk that arguments regarding particular claims not be considered. While any one of the changes considered individually may be thought of as a small change, the result of the many changes proposed is significant.

We believe that the requirement to have the Chief Administrative Patent Judge consider, by petition under proposed § 41.3, requests for increased number of pages in the brief (see proposed § 41.37(v)(5)) or for extensions of time to file a reply brief (see proposed § 41.41(c)) may cause unnecessary delays and disruptions, since jurisdiction over the appeal remains with the Patents operation until the Board's issuance of a docketing notice (proposed § 41.35(a)). We recognize that the modern image file wrapper (IFW) makes it possible for different areas of the USPTO to simultaneously access an application file without the need to move a paper file from place to place, but anecdotal accounts suggest that the potential of the IFW has not prevented delays in addressing matters. We also believe that the 25 page limit of proposed § 41.37(v)(5) is too short for an appeal brief that may need to separately address as many as 5 independent claims and 25 total claims, as now permitted under the new continuation and claims rules.

Per proposed § 41.37(k), "The 'status of pending claims' shall include a statement of the status of all pending claims (e.g., rejected, allowed, cancelled, withdrawn from consideration, or objected to)." We note that the language of this

section appears to be internally inconsistent, identifying “cancelled” as one possibility for a “pending” claim. We suggest that the rule clarify whether the Board wants to know the status of all claims that may have been pending during the prosecution of the application (as in the existing rules) or of only those claims presently pending.

Per proposed § 41.37(p), “The ‘claims section’ of the appendix shall consist of an accurate clean copy in numerical order of all claims pending in the application or reexamination proceeding on appeal. The status of each claim shall be set out after the claim number and in parentheses (e.g., 1 (rejected), 2 (withdrawn), 3 (objected to), and 4 (allowed)).” We believe that this proposed rule change provides an opportunity for the Board to say what it means by “clean copy” of claims. On the assumption that “clean copy,” means a copy of the pending claims under rejection that is free from underlining and bracketing and other extraneous information, we suggest that the proposed rule should eliminate from § 41.37(p) the parenthetical “status of each claim.” Proposed § 41.37(k) will provide the desired information (which we understand to be an accounting of each claim to have been pending any time during the prosecution of the application), and the parenthetical expressions of proposed § 41.37(p) will provide an additional possibility for error without adding any useful information.

In this same connection, we believe that these proposed rules, or their accompanying comments, provide an opportunity for the Board to make clear whether it does or does not want status indicators as provided for in 37 CFR § 1.121(c) (e.g., currently amended, cancelled, etc.) in the claims. Examiners sometimes treat the need for

status indicators inconsistently, occasionally objecting to the claims in the brief either for, or for not, including status indicators.

Per proposed § 41.37(q), “For each claim argued separately (see paragraph (o)(1) of this section), the ‘claim support section’ of the appendix shall consist of an annotated copy of the claim indicating in bold face between braces ({ }) the page and line after each limitation where the limitation is described in the specification as filed. Per proposed § 41.37(r), “For each claim argued separately (see paragraph (o)(1) of this section) and having at least one limitation illustrated in a drawing or amino acid or nucleotide material sequence, the ‘drawing analysis section’ of the appendix shall consist of an annotated copy of the claim indicating in bold face between braces ({ }) where each limitation is shown in the drawings or sequence. If there is no drawing or sequence, the drawing analysis section shall state that there is no drawing or sequence.” The requirement for separate claim support and drawing analysis sections appears unnecessarily duplicative. We believe it would be possible and convenient to the Board and practitioners to have the practitioner reference both the specification and the drawings, if any (or nucleotide sequences) in the same appendix.

With further reference to proposed § 41.37(q), while the Board requires reference to the specification by page and line numbers, 37 CFR § 1.52(b)(6) permits (but does not require) the paragraphs of the specification of other than reissue applications and reexamination proceedings to be numbered. Some examiners object to briefs filed using page and line numbers, calling for reference to paragraph numbers, while others insist on the page and line number of the present rules, even though paragraph numbers are provided. We suggest that the Board make clear in the rule and comments whether page

and line numbers or paragraph numbers are desired in order to limit unnecessary confusion for practitioners and examiners.

Per proposed § 41.37(s), the appendix to the brief is required to contain a “Means or step plus function analysis section.” Specifically, § 41.37(s) provides, “For each claim argued separately (see paragraph (o)(1) of this section) and for each limitation that appellant regards as a means or step plus function limitation in the form permitted by the sixth paragraph of 35 U.S.C. 112, the ‘means or step plus function analysis section’ of the appendix shall consist of an annotated copy of the claim indicating in bold face between braces ({ }) the page and line of the specification and the drawing figure and element numeral that describes the structure, material or acts corresponding to each claimed function. If there is no means or step plus function limitation, the means or step plus function analysis section shall state that there are not means or step plus function limitations in the claims to be considered.” We think that the title of this section and the reference to “paragraph (o)(1) of this section” may indicate that only those claims containing “means plus function” recitations which are argued separately from another claim need be analyzed in this section. Nonetheless, we believe that the rule can also be read to require analysis of all claims containing “means plus function” recitations. We believe that the language of this section needs to be more explicit as to which “means or step plus function” provisions require analysis in this portion of the Appendix, in order to avoid unnecessary objections by the examiners.

The undersigned appreciates the opportunity to submit the above comments and suggestions, and would be pleased to work with officials at the USPTO to help achieve

the goal of efficiently handling an increased number of ex parte appeals in a timely manner.

Sincerely,

William E. Lyddane,
Bruce H. Stoner, Jr., for the law firm of
Greenblum & Bernstein, P.L.C.