

September 28, 2007

VIA EMAIL ONLY *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 Comments
P.O. Box 1450
Alexandria, VA 22313-1450

Re: *Ex Parte* Appeals

Dear Sir:

These comments relate to proposed rules of practice before the Board of Patent Appeals and Interferences in *ex parte* appeals that were published in the *Federal Register* Monday, July 30, 2007 (72 Fed. Reg. 145:41472-41490).

I am a partner at Morrison & Foerster and have been practicing before the Patent and Trademark Office for 27 years. I have filed at least 10 appeals, probably more. I have always regarded the considerations given by the BPAI to be a satisfactory manner of resolving what I and my clients have considered incorrect rejections made at the Examiner level. The requirements set forth in the proposed rules threaten to undermine this level of confidence in the ability of the U.S. PTO to provide just resolution of issues raised during prosecution. They place a burden on the appellant that is, in my view, unacceptable, and designed to discourage, rather than expedite appeals. The specific objections raised are as follows:

Appeal Brief:

The following sections are unfair to appellants:

41.37(n)

A requirement for a "statement of facts" is vague on its face, would take a lot of time to prepare and is essentially useless. It is not even limited to a list of facts that are in dispute. Indeed, the appellant may not even know which facts are in dispute. What kinds of facts? What a document says or does not say? Whether the concentration of mRNA is or is not indicative of the presence of protein? What the size of an epitope is? If an examiner has not

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even questioned facts that are set out in the papers of record, what is the point of listing these facts in the context of an appeal?

41.37(o)

This section is really a problem and unduly handicaps the appellant by insisting on a particular manner of making an argument in response to a rejection. This might be fine if the examiner has provided readily discernible salient points in support of his/her rejection. This is quite often, and in fact quite frequently, not the case in those instances where an appeal is needed. Many Office actions are clear, cogent and concise, but those are typically not the ones that elicit an appeal. When the appellant is faced with a rambling series of paragraphs with little coherence in illogical sequence, it is counterproductive to attempt to follow the format prescribed by the proposed rule. To force the appellant to follow the examiner's defective line of reasoning unduly prejudices appellant's ability to make a convincing case. This is a real detriment to applicants who are relying on the expertise and common sense of an appeals panel to put things right.

Reply Brief

The undue formal requirements with respect to the reply brief reflect the same problem. A reply brief should be simple, to the point, and short, not cluttered with arbitrary requirements for subheadings, argument style, etc..

Expected Effect

In my view, the proposed requirements will increase the cost of appeals 5-10-fold and make them even more difficult for the BPAI. It will undermine the expectation of applicants that they can obtain a fair decision, ultimately, from the U.S. PTO.

Request for Additional Time for Comments and Hearing

In view of the timing of the proposed changes to these rules, and their publication as of 30 July 2007, when the attention of the patent bar was focused on the impending promulgation of the rules on continuations and examination of claims, it is unfair to terminate the comment period when most practitioners are scrambling to figure out how to comply with the rules published on 21 August 2007. Respectfully, the U.S. PTO should provide additional time and additional publicity for these proposed changes, as well as an

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opportunity for hearings. These proposed changes are essentially flying under the radar of the patent bar in view of the rules promulgated 21 August 2007.

Respectfully submitted,

Morrison & Foerster

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KHM/cs/gss