

The Honorable Jon Dudas  
Under Secretary of Commerce for Intellectual Property  
and Director of United States Patent and Trademark Office

Re: Comments of Proposed “Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals” 72 Fed. Reg. 145 (July 30, 2007)

Dear Under Secretary Dudas:

I am an associate with the firm of Price, Heneveld, Cooper, DeWitt & Litton, LLP and a former Examiner. This letter is written on my own behalf and not on behalf of Price, Heneveld, Cooper, DeWitt & Litton, LLP or on behalf of any of its clients. Thus, this letter does not represent the views of my firm or its clients, but solely are the views of the undersigned.

I. Appeal Briefs

According to the Summary and Explanation of Proposed Changes of the proposed “Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals” (hereinafter, the “Proposed Rules”), the Proposed Rules are being offered to “enhance the likelihood that appealed claims will be allowed without the necessity of further proceeding with appeal, minimize the pendency of appeals before the Office, . . . make the decision-making process more efficient” and “to allow the Board to continue to resolve ex parte appeals in a timely fashion.” The undersigned believes that the proposed changes will help with all of the above goals. However, the undersigned does not believe that the rules go far enough for accomplishing the purported goals of the Proposed Rules.

The undersigned believes that the proposed rules should also address the substance of Examiner’s Answers to be able to accomplish any of the stated goals of the Proposed Rules. Namely, the Examiner should be required to submit in an Examiner’s Answer to the Board all of the items that the Appellant is required to submit in an Appeal Brief. Such a requirement will greatly assist the Board in minimizing the pendency of appeals before the Office, making the decision-making process more

efficient, and allowing the Board to continue to resolve ex parte appeals in a timely fashion. Furthermore, with a clear and complete statement of the Examiner's position in the Examiner's Answer, the Appellant will be able to determine the likelihood that the rejection of appealed claims would be sustained such that the Appellant would be able to withdraw the application from appeal without the necessity of further proceeding with the appeal and to preserve the Board's time for applications that merit their time.

The separate sections of the Appeal Brief according to the Proposed Rules and the undersigned's proposed additions to the Examiner's Answer are discussed directly below.

A. Statement of Real Party in Interest

The Examiner's Answer should state if the Examiner knows of any information not set forth in the Appeal Brief as to a real party in interest.

B. Statement of Related Cases

The Examiner's Answer should state if the Examiner knows of any related cases not set forth in the Appeal Brief.

C. Jurisdictional Statement

The Examiner's Answer should state if the Jurisdictional Statement set forth in the Appeal Brief is correct, and if not, should state the proper corrections.

Furthermore, the undersigned requests that this portion of the Appeal Brief not comprise part of the 25 page limit (similar to the exception for the Statement of Real Party in Interest, Statement of Related Cases, Table of Authorities and Table of Contents). The statement made in this section is irrelevant to the merits of the appeal and should not count against the page limit of the Appeal Brief. Moreover, the length of this section does not create any burden on the Examiner or Board in the appeal process.

Additionally, the undersigned submits that Appellant should not be required to recite to the Board their Laws and Rules, especially if this section would count against

the 25 page limit. According to the Proposed Rules, this section is needed to “minimize the chance that the Board would consider an appeal when the application on appeal is abandoned or a reexamination proceeding on appeal has terminated.” Therefore, all requirements in this section should be drawn to accomplishing that goal. However, reciting to the Board their Laws and Rules does not help accomplish the stated goal. For example, the sample “jurisdictional statement” in the Proposed Rules includes the following statements: “The Board has jurisdiction under 35 U.S.C. §134(a)” and “[t]he time for filing an appeal brief is two months after the filing of a notice of appeal. Bd. R. 41.37(c).” Since all appeals to the Board find their authority in 35 U.S.C. §134, Appellants should not be required to state this fact to the Board and such a statement would not help in accomplishing the stated goal of this section. As to the deadline for filing an appeal brief, the undersigned assumes that the Board is aware of this rule and the undersigned sees no purpose in including such a statement.

D. Table of Contents

The Examiner’s Answer should be required to include a Table of Contents. Such a Table of Contents in both the Appeal Brief and the Examiner’s Answer will allow the Board to continue to resolve ex parte appeals in a timely fashion.

E. Table of Authorities

The Examiner’s Answer should be required to include a Table of Authorities. Such a Table of Authorities in both the Appeal Brief and the Examiner’s Answer will allow the Board to continue to resolve ex parte appeals in a timely fashion.

F. Status of Claims

The Examiner’s Answer should state if the status of claims set forth in the Appeal Brief is correct for each claim.

G. Status of Amendments

The Examiner's Answer should include a status of amendments along with reasons and/or authority for not entering any amendments, if applicable.

H. Rejections to be Reviewed

The Examiner's Answer should state the rejections to be reviewed.

I. Statement of Facts

The Examiner's Answer should include a statement of facts as set forth in the Proposed Rules. All of the reasons for setting forth this requirement in the Proposed Rules apply equally to the Examiner as to the Appellant. According to the Proposed Rules, "[a] clear, concise and complete statement of relevant facts will clarify the position of an appellant on dispositive issues and assist the Examiner in reconsidering the patentability of the rejected claim." Likewise, a clear, concise and complete statement of relevant facts made by the Examiner in the Examiner's Answer will clarify the position of an Examiner on dispositive issues and assist the Appellant in reconsidering the patentability of the rejected claim, such that the Appellant may withdraw the application from Appeal to allow the Board to continue to resolve ex parte appeals in a timely fashion.

Furthermore, according to the Proposed Rules:

The panel members do not know anything about the appellant's invention or the prosecution history of the application on appeal. Likewise, too often an appellant will not support a statement of fact in an appeal brief by an explicit reference to the evidence.

However, both of these points also apply to the Examiner. For example, too often an Examiner will not support a statement of fact in an Examiner's Answer by an explicit reference to the evidence.

Therefore, the Examiner's Answer should be required to include facts to be supported by a reference to the page number of the record on appeal, and, where

appropriate, the citation should be to a specific line and to a drawing figure and element number of the record on appeal.

Moreover, as an additional reason for requiring this section, the Proposed Rules state that the Appellant is required to make these statements “because an appellant should not expect the Examiner or the Board to search the record to determine whether a statement of fact is supported by the evidence.” Likewise, the Examiner should be required to make these statements because an Examiner should not expect the Appellant or the Board to search the record to determine whether a statement of fact is supported by the evidence.

According to the Proposed Rules, “in the case of a rejection for obviousness under §103, the facts should address at least the scope and content of the prior art, any differences between the claim on appeal and the prior art, and the level of skill in the art.” Furthermore, according to the Proposed Rules, “[i]n the past, some appellants have provided minimal factual development in an appeal brief, apparently believing that the Board will scour the record to divine the facts.” However, the undersigned reminds Under Secretary Dudas that the burden is on the Examiner to create a prima facie case of obviousness, not on the Applicant to provide reasons for patentability. See *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Accordingly, it is the Examiner’s duty, not the Appellants duty, to supply such statement of facts. Appellant should only be required to supply such “facts” (if not in dispute) when the Examiner has supplied such information in a final rejection. The undersigned notes that “[p]atent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case.” M.P.E.P. §2141.35 (emphasis in original). The undersigned notes that in over 10 years of practice as an Examiner and as a Patent Attorney, the undersigned has never encountered a rejection made by an Examiner under §103 that addressed the level of skill in the art. The undersigned is unsure why Appellants are now required to assist the Examiner in making the prima facie case of obviousness when it appears that Examiners have, at least in the undersigned’s cases, never done so in the past.

Finally, as noted in the Proposed Rules, such requirements are consistent with the approaches taken by federal courts concerning appeal brief practice and other briefing practice. However, the undersigned notes that federal courts apply the rules equally to both sides of an issue briefed, and not solely to the plaintiff, movant or petitioner. Therefore, extending the federal courts' practice to this case, both the Appellant and the Examiner should provide a statement of facts.

#### J. Argument

In the Argument section of the Examiner's Answer, the Examiner should be required to address all points made by the Appellant with which the Examiner disagrees. According to the Proposed Rules, "[t]he presentation of a concise, but comprehensive, argument in response to the final rejection will efficiently frame any dispute between the appellant and the examiner." Likewise, the presentation by the Examiner of a concise, but comprehensive, argument responding to Appellant's response to the final rejection will efficiently frame any dispute between the Appellant and the Examiner. Without such a requirement, any dispute between the Examiner and the Appellant would not be efficiently framed.

In the Proposed Rules, it is stated that "[w]here an argument has previously been presented to the Examiner, the analysis would have to identify where any argument being made to the Board was made in the first instance to the examiner." The undersigned is unsure of the purpose of this requirement, as it would not assist the Examiner or the Board.

In the Proposed Rules, the Appellant is required to identify any arguments not previously made "so that the examiner would know that the argument is new." Likewise, the Examiner should be required to identify where any argument being made to the Board was made in the first instance to the Appellant so that the Appellant would know that the rejection is not a new rejection.

Furthermore, the Proposed Rules "would provide that any finding made or conclusion reached by the examiner that is not challenged would be presumed to be correct." However, since the Appellant is limited on the number of pages in the

Appeal Brief, Appellant should not be burdened with the presumption that a finding made or conclusion reached by the Examiner that is not challenged is correct. Appellant may not challenge a finding or conclusion merely because of a strategic decision to maintain the Appeal Brief under the 25 page limit. The Proposed Rules should state that any finding made or conclusion reached by the Examiner that is not challenged would only be waived for the present appeal (but not for any subsequent appeal, prosecution or litigation). Likewise, the Proposed Rules should state that any finding made or conclusion reached by the Appellant that is not challenged by the Examiner would only be waived for the present appeal. If the change to waiver instead of presumption of being correct is not changed, the Proposed Rules should be revised to state that any finding made or conclusion reached by the Appellant that is not challenged by the Examiner would be presumed to be correct.

For each claim rejected, the Examiner's Answer should include a heading for that claim or group of claims rejected under a single statutory requirement.

The Examiner should be required to waive all arguments which could have been made, but were not, addressed in the argument section of the Examiner's Answer.

When responding to points made in the Appeal Brief, the Examiner's Answer should be required to (1) identify each point made in the Appeal Brief and (2) indicate where the Examiner previously responded to each point made in the Appeal Brief in the first instance or state that the argument has not previously been addressed by the Examiner. Furthermore, in supporting any argument, the Examiner should be required to refer to a page and, where appropriate, a line, in the evidence section of the appendix, specification, drawings (if any), U.S. patents, and published U.S. applications. According to the Proposed Rules, the Appellant is required to abide by the above requirements as they are "intended to be efficient protocols for assisting the Board in focusing on any differences between the examiner's and appellant's positions." Without requiring the Examiner's Answer to have the above required portions, the Board will not be able to focus on any differences between the Examiner's and Appellant's positions.

According to the Proposed Rules, for each rejection under 35 U.S.C. §103:

The argument section shall (1) specify the errors in the rejection, (2) if appropriate, specify the specific limitations in the rejected claims that are not described in the prior art relied upon in support of the rejection, and (3) explain how those limitations render the claimed subject matter nonobvious over the prior art. (emphasis added).

However, 35 U.S.C. §102 and §103 state that “a person shall be entitled to a patent” unless any of the subsections of 35 U.S.C. §102 or 35 U.S.C. §103 are met.

Therefore, the burden is on the Examiner to create a prima facie case of obviousness, not on the Applicant to provide reasons for patentability. See *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Accordingly, if the Appeal Brief successfully argues that there are errors in the rejection and/or specifies that the specific limitations in the rejected claims are not described in the prior art relied upon in support of the rejection, the Appellant will have overcome the prima facie rejection of the claims under 35 U.S.C. §103. Therefore, the Appellant should not be required to make the further step of proving patentability, which would be contrary to the statute and decision of the Federal Circuit.

#### K. Appendix

The Examiner’s Answer should include each and every section that the Appeal Brief is required to include.

First, the Appendix of the Examiner’s Answer should include an annotated copy of the claims indicating in bold face between braces ({} ) after each limitation where, by page and line numbers, the limitation is described in the references. According to the Proposed Rules, “[a] significant objective of the ‘claim support section’ would be to provide the examiner and the Board with appellant’s perspective on where language of the claims . . . finds support in the specification. Finding support for language in the claims can help the examiner and the Board construe claimed terminology and limitations when applying prior art.” Furthermore, according to the Proposed Rules,



“[o]ne significant problem faced by the Board under the current practice occurs when the language of a claim does not have direct antecedent language in the specification.” Moreover, according to the Proposed Rules, when the language of the claim does not find correspondence in the specification, as filed, often it is difficult to determine the meaning of a particular word in a claim or to give the claim its broadest reasonable interpretation.”

However, the undersigned submits that it is more important that the Examiner’s Answer include such a section as the language of a claim will never find correspondence in a cited reference. Furthermore, a significant objective of the “claim support section” of the Examiner’s Answer would be to provide the Appellant and the Board with the Examiner’s perspective on where language of the claims finds support in the cited references. Finding support for language in the claims can help the Board construe claimed terminology and limitations as applied to the prior art, thereby expediting the Appeal process.

Second, the Appendix of the Examiner’s Answer should include an annotated copy of the claims indicating in bold face between braces ({} ) after each limitation where, by reference or sequence reside number, the limitation is shown in the drawing or sequence. Once again, since the cited references do not use the same language as the claims upon appeal, a drawing analysis section (when drawings are relied upon in the cited reference) in the Examiner’s Answer would be essential to understanding the Examiner’s rejection of the claims.

Third, the Appendix of the Examiner’s Answer should include an annotated copy of the claims indicating in bold face between braces ({} ) after each means plus function limitation where the specific portions of the cited references (specification and drawings) that disclose the structure material or acts corresponding to each claimed function. Once again, since the cited references do not use the same language as the claims upon appeal, a means plus function analysis section in the Examiner’s Answer would be essential to understanding the Examiner’s rejection of the claims.

Fourth, the Appellant should only be required to submit in the Evidence section of the Appendix evidence that Appellant refers to in the Appeal Brief. Furthermore,

the undersigned is unsure the point of submitting “the relevant portions of papers filed by the appellant during prosecution before the examiner which show that an argument being made on appeal was made in the first instance to the examiner.” Since the Appellant apparently does not receive any benefit from showing an Examiner where an argument was made previously to an Examiner, the undersigned does not see any point in supplying any such evidence.

L. Format of Appeal Briefs

According to the Proposed Rules, an Appeal Brief must be double spaced, must have a font equivalent to 14 point Times New Roman and must not be longer than 25 pages. The undersigned submits that the 25 page limit goes too far at this point as all of the issues with efficiency may be addressed by all of the requirements in an Appeal Brief in the proposed rules and such a requirement may unduly burden, prejudice and restrict the Appellant in making their appeal. If the Appellant would be successful in their Appeal, they should not be artificially limited on any arguments needed to be successful. Nevertheless, if the Under Secretary believes that the 25 page limit is reasonable in Appeal Briefs as litigants in the Federal Courts have page limits in papers that they file, the 25 page limit is only reasonable if all Final Rejections and Examiner’s Answers are limited to being double spaced, having a font equivalent to 14 point Times New Roman and being no longer than 25 pages. In the Federal Courts, both parties are limited to certain page limits, not only one party. Accordingly, the undersigned strongly requests that all Final Rejections and Examiner’s Answers be limited as outlined above.

Furthermore, the undersigned requests that the page limit restriction only apply to applications that have not received a first Office Action before November 1, 2007 (i.e., those not subject to the 5/25 Rule). Notably, the undersigned’s firm recently received a 63 page final office action that was single spaced and in 12 point font. It would be impossible for the Appeal Brief to fit the proposed requirements and be responsive. Accordingly, there must be some limits on Office Actions and Examiner’s Answers.

## II. Reply Briefs

According to the Proposed Rules, the Appellant is very limited in entering amendments. The justification for such a limitation is that “[if] an appellant, after reviewing the examiner’s answer, believes that an amendment is appropriate, the appellant may file a request for continued examination.” However, as the undersigned is sure that the Under Secretary is aware, an Appellant may not be able to file a request for continued examination, as the Appellant may not be able to file any further request for continued examination in an application after one request for continued examination has already been filed without approval of a petition to do so. Therefore, the rules at the Patent Office have changed since the publication of the proposed rules such that the basis for limiting amendments during appeal is no longer valid.

## II. Supplemental Examiner’s Answers

The undersigned submits that all Supplemental Examiner’s Answers should be limited as discussed above in regard to Examiner’s Answers. Furthermore, an argument that could have been made, but was not, in an Examiner’s Answers cannot be made in a Supplemental Examiner’s Answer. Adding arguments in Supplemental Examiner’s Answer “does not contribute to the efficient handling of appeals.” Furthermore, the Supplemental Examiner’s Answer should be required to state where in the Reply Brief the Appellant made an argument which the Examiner is responding to in the Supplemental Examiner’s Answer.

## III. Maintaining Appeal After a New Rejection

The undersigned submits that at least one rejection must be maintained for an Examiner to proceed with an appeal instead of proceeding with the appeal with all new grounds of rejections. For example, the undersigned was subjected to an Examiner’s Answer that only included a new ground of rejection (i.e., none of the previous rejections were maintained). Since the Appellant’s opportunity to respond and amend are limited if an appeal is maintained (along with the timing to do so), the Examiner

should be required to re-open prosecution if no existing ground of rejection is maintained.

#### IV. Request for Rehearing

According to the Proposed Rules, the Request for Rehearing is limited to 10 pages and requires (1) a table of contents, (2) a table of authorities, (3) statement of timeliness, and (4) argument. The undersigned request that at least the table of contents and the table of authorities not count towards the 10 page limit (as is the case in the Appeal Brief). Furthermore, the undersigned requests that the statement of timeliness not count towards the 10 page limit as for the same reasons that the Jurisdictional Statement of the Appeal Brief should not count towards the 25 page limit of the Appeal Brief, as discussed above.

#### V. References to Page Numbers in the Specification

In several places in the Proposed Rules, the Proposed Rules state that the Appellant must provide support by listing the line number and page in the specification. The undersigned suggests that the requirement for line number be changed to paragraph number or at least line number of a paragraph. Since amendments are made to the specification by removing and inserting entire paragraphs during prosecution, a line number on a page may become meaningless. For example, if a particular paragraph is replaced and the replacement paragraph results in additional lines, what is the line or page number of the particular paragraph? Since the paragraph is longer than originally filed, it will not have a line and page number. Therefore, the line number of a page may be impossible to cite.

#### VI. Summary

The undersigned appreciates the Board goal of improving efficiency and understanding of Appellant's stance in Appeals. However, the undersigned submits that such goal cannot be accomplished without placing equal requirements on an Examiner's Answer. Furthermore, according to the Proposed Rules:

The effect of such rules, however, will be to enhance the likelihood that the appealed claims will be allowed without the necessity of further proceeding with the appeal and improve the efficiency of the decision making process at the board. Any additional time burden that is imposed by the proposed rules relating to briefs is believed to be *de minimus* in comparison to the reduction in pendency that appellant gains as a result of early identification of allowable claims or a more efficient decision-making process.

However, in order for this to be more than just lip service such that the Proposed Rules are only made to discourage Appellants from appealing, the Proposed Rules must apply the same requirements to the Examiner's Answer. Such a requirement will be to enhance the likelihood that the appealed claims will be allowed without the necessity of a further proceeding with the appeal and improve the efficiency of the decision making process at the Board. Furthermore, any additional time burden that is imposed on the Examiner by the proposed rules changes as set forth herein relating to Examiner's Answers is believed to be *de minimus* in comparison to the reduction in pendency that Appellant gains as a result of early identification of properly rejected claims (such that the Appellant can file a request for continued examination without wasting the Board's time and resources) or a more efficient decision-making process.

Respectfully submitted,

September 28, 2007  
Date

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