

February 25, 2010

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Response to Request for Comments on Potential Modifications to Final
Rules of Practice Before the Board of Patent Appeals and Interferences in Ex
Parte Appeals
74 Federal Register 67987 (December 22, 2009)

Dear Under Secretary Kappos:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments on the Advance Notice of Proposed Rulemaking Regarding Potential Modifications of the Rules of Practice Before the Board of Patent Appeals and Interferences (Board) in Ex Parte Appeals. AIPLA has made a separate submission regarding the topics raised at the Roundtable regarding ex parte appeal practice, and has tried to avoid any duplication to the remarks already made.

AIPLA is a national bar association whose more than 16,000 members are primarily lawyers and other patent practitioners in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

AIPLA appreciates the opportunity to comment on proposed modifications to the final rules directed to practice before the Board in ex parte appeals. AIPLA supports each of the possible changes under consideration that include:

- (1) deleting certain provisions requiring a petition to the Chief Administrative Patent Judge;
- (2) deleting certain briefing requirements like a jurisdictional statement and tables of contents and authorities;
- (3) deleting provisions requiring identification of arguments previously presented;
- (4) deleting certain formatting requirements and page limits; and
- (5) deleting a requirement for a list of technical terms or other unusual words for an oral hearing.

We commend the Patent and Trademark Office (PTO) for taking the initiative to reconsider the final rules, and particularly the provisions noted above, considered very controversial by most practitioners. Many of the provisions being considered for deletion were of questionable benefit and would have imposed substantial, unjustified burdens on appellants. AIPLA supports the PTO in seeking ways and procedures that will make ex parte appellate practice efficient and effective, but this effort needs to strike an appropriate balance between improving the Board's efficiency and the burdens placed on appellants in achieving this goal.

AIPLA supports the overall direction of the proposed modifications. We are providing comments below on specific changes proposed in the Advance Notice that should be either clarified and/or reconsidered.

Comments on Specific Sections

§ 41.12 Citation of Authority

The change being proposed is to delete the requirement for parallel citations, and to permit citation to a single source, in the priority order set out in the rule. It is not understood whether this means that the citation must be to the first occurring citation in the priority order specified or whether the PTO is expressing a preference for a particular citation that is not required. For example, if there is both a Federal Reporter and a United States Patents Quarterly citation for a case,

is the Federal Reporter citation necessary, or can either be cited? Will the Board ignore a case citation that does not follow the designated priority if that is required? Clarification is requested.

§ 41.31 Appeal to Board

It is proposed to amend paragraph (b) to delete the provision that a notice of appeal need not be signed, meaning that a notice of appeal would need to be signed in accordance with § 1.33. No reason has been provided for this change, and none is apparent. While it is not an item of major concern, removing a flexibility afforded practitioners can lead to mistakes and more work for both the PTO and appellant in correcting those mistakes. Perhaps the proposed change would be better understood if the PTO identified the purpose or reason for the change.

§ 41.33 Amendments and Evidence After Appeal

In our comments filed September 28, 2007, AIPLA addressed concerns with the provisions in this section as unnecessarily limiting the discretion of the PTO to enter amendments or evidence. Specifically, proposed § 41.33(b) would give an examiner discretion to enter an amendment filed with or after an appeal brief only if filed under limited circumstances. Proposed § 41.33(c) provides that “No other amendments . . . will be admitted.” The PTO appeared to agree that examiners should have this flexibility when it remarked: . . . nothing in the rule should be construed as precluding an examiner from suggesting an amendment or evidence if timely filed. 73 Fed. Reg. 32957, answer to Comment 22. However, both the final rule and the rule proposed in the Advance Notice states that any amendment made after the appeal brief is filed is untimely. This does not appear to give examiners any discretion to enter amendments they have suggested. The PTO is requested to reconsider amending paragraph (b) to include a third possibility that amendments approved by the examiner be entered.

Similarly, proposed § 41.33(e) adopts a very restrictive policy that any evidence that does not meet the standards of § 41.33(d) would not be admitted except in very limited circumstances. We question the wisdom of precluding an examiner, at his or her discretion, from entering evidence that would clarify or remove issues that will be placed before the Board for review. This need not create a new opportunity for appellants to submit unauthorized papers to the PTO, but could be limited to evidence suggested by the examiner.

§ 41.37(g) Statement of Related Cases

This proposed section requires a continuing obligation to identify “all prior or pending appeals, interferences or judicial proceedings, known to any inventors, any attorneys or agents who prepared or prosecuted the application on appeal . . . and that are related to, directly affect, or would be directly affected by, or have a bearing on the Board’s decision in the appeal.” Although this language is substantially similar to the current provision, it is considered overly broad to satisfy any apparent need of the Board. First, it is not clear whether the language includes only applications of the assignee, or other known applications as well.

The Advance Notice indicates that a related case would include any continuing application (continuation, divisional, CIP). This collection of cases is likely to include applications containing no prosecution, or possibly directed to subject matter not related to the issues on appeal. It would not seem to be in the best interests of the efficiency of the Board to sift through unrelated cases. On the other hand, the omission of reexamination proceedings from the list of potentially related cases is not understood. Clarification is requested.

§ 41.37(p) Claims Section

The claims section in the appendix would require a clean copy of all claims pending in the application or reexamination proceeding on appeal. Our understanding is that a “clean copy” means a copy of the claim without any markings that would suggest an addition or deletion in the claim. This proposal would also require that the status of each claim be set out, but it is not clear why the proposed status of “4 (cancelled)” would be applicable to a “pending” claim. Clarification is requested.

§ 41.37(r) Claim Support and Drawing Analysis Section

This proposed section would require an annotated copy of each claim argued separately indicating where each limitation is described in the specification. It is not clear whether this is a requirement to cite every instance of support, or simply those citations that are sufficient to understand the scope and meaning of the claim limitations. We think this requirement should be clarified to avoid requiring all support and avoid any possible implication that no other claim support exists.

§ 41.37(t) Evidence Section

This proposed section essentially continues present practice by requiring copies of affidavits, declarations, or other evidence relied on by appellant. This apparently would include copies of U.S. patents and U.S. application publications that are not required to be supplied to the PTO in an information disclosure statement. There are additional burdens and costs associated with assembling these materials that are already of record in the appealed case, and the driving force behind this duplication of effort is not understood. We can appreciate that having this package already assembled may reduce such work for the Board or facilitate working at home, but we are not aware

whether this proposal is considered to be an opportunity for improving efficiency at the Board. Clarification is required.

§ 41.52 Rehearing

The proposed section would preclude raising any new argument in a request for rehearing except where (1) it was in response to a new ground of rejection made by the Board, or (2) it identifies a recent legal development. It is respectfully submitted that this restriction is too limited as the Board often attempts to justify an examiner's rejection/decision with a rationale or argument of its own that was not previously made on the record. When this occurs, appellant should be able to point out why the new rationale/argument is erroneous, even though the argument was not previously made, and at least request the Board to designate the affirmed rejection as a new ground of rejection.

§ 41.56 Sanctions

The need for sanctions in the conduct of ex parte appeals has not been justified by the PTO. The proposed transfer of authority to the Director to impose a sanction is an appropriate step for such an extraordinary penalty, if it is adopted. The PTO indicates that a sanction would be applied against an appellant, not against the registered practitioner (74 Fed. Reg. 67997, Sanctions), yet states that the rule is "meant to be employed for egregious cases of attorney misconduct." 74 Fed. Reg. 67998, comment 2. It does not appear that the PTO focus is clear, but to the extent that the rule is meant to address misconduct of the practitioner, it is not clear why the Office of Enrollment and Discipline cannot address any problem, which must be rare.

We appreciate the opportunity to provide these comments on the Advance Notice, and would be pleased to answer any questions our comments may raise. We look forward to participation in the continuing development of rules appropriate for ex parte practice.

Sincerely,

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Q. Todd Dickinson
Executive Director
AIPLA