

**RESPONSE TO THE USPTO REQUEST FOR COMMENTS ON PROPOSED
CHANGES TO RULES REGARDING “RULES OF PRACTICE BEFORE THE BOARD
OF PATENT APPEALS AND INTERFERENCES IN EX PARTE APPEALS”**

The following comment is submitted in response to the Request for Comments on USPTO's proposed “Rules of Practice before the BPAI in Ex Parte Appeals” [Federal Register / Vol. 72, No. 145 / July 30, 2007 / Page 41472]. This comment is submitted by the undersigned on behalf of himself.

The stated goals of providing for more efficient appeals and higher patent quality are a worthy goals. However, the goals are one sided – namely, improving efficiency at the USPTO, and defining quality as “issuing no bad patents” without consideration “for failure to issue good patents”. They do so in the pattern that is becoming all too common of recent rulemaking proposals and rulemaking. That is, they do so at the expense of the inventor and applicant. I as a practitioner of 25 years, I strenuously object to the new rulemaking.

The appeal process is currently time consuming and expensive, with costs being often inflated by bureaucratic regulations (e.g., minor failures such as failure to provide an appendix with no content rather than simply omitting the appendix). The process is too expensive for many small companies and independent inventors, and even larger companies. I have personally experienced all categories of applicants choosing to abandon an application with value rather than incur the expense of appeal, even under the current rules. I have also seen my appeal practice increase dramatically over the last several years and expect it to increase further in light of the claims and continuation rules package.

The cost of choosing not to appeal go unreported in the USPTO's evaluations on the cost to small entities who are already priced out of the patent market and further priced out of any possibility of appeal. The cost of justice should be within reach, and there is no good reason to believe that the requirements being imposed by the proposed new rules have this effect. I submit the opposite is true, and roughly estimate that the cost of an appeal brief will increase by 25% in my practice.

The calculations provided in the proposed rulemaking are flawed to the extreme. The bottom line number of appeals filed by small entities being only 0.9% of all applications filed is absolutely no indication that the new rules would not be a substantial burden. The fact is that the old rules are a substantial burden. Thus, rules that increase cost would even further increase that burden. In the extreme, if all small entities are ultimately priced out of the market, is it fair to then say that later proposed rules have no impact? The answer is yes only if you choose to ignore those who have already been priced out of the process.

A more appropriate comparison is the proportion of appeal briefs filed by small entities compared to the number of appeal briefs in total. That figure appears to be 21.6%, while the total number of small-entity filings is around 29.3%. This is a more telling statistic that indicates that while small entities are currently already being priced out of the appeal process at a rate 26% higher than large entities. It further indicates that even at that rate, 21.6% of appellants will be affected by the new rule. There is simply no way this can be considered to be insignificant. I

invite the rulemakers to consider a practitioner's meeting with an inventor who is contemplating selling or mortgaging his home to finance the process in pursuit of his dream. I have been in such meetings and can attest that the impact is far more significant to such an entrepreneur than portrayed by the USPTO.

Proposed Rule 41.37 on Appeal Briefs would impose a substantially increased burden when preparing an Appeal Brief. The requirements for separate sections for claims support, drawing analysis, and means or step plus function analysis is a tedious and time consuming function. The information should be derived as needed from the application specification itself. If problems exist, objections or rejections should be made by the examiner before appeal is ever begun. The current rules already require a summary of the claimed subject matter with references to the specification and drawings, which is already tedious and time consuming. Moreover, it places the applicant in the position of potentially unduly limiting the invention if not done carefully. Additionally, the burden would appear to reach beyond the information necessary for the board to decide the issues at hand. A more appropriate rule would require only a brief and explicitly non-limiting example of an embodiment of the invention to aid the Board in getting quickly up to speed. More than this is unnecessary.

The proposed rules further specifies a 25 page limitation on certain portions of the Appeal Brief along with margin, line spacing and font requirements that severely abridge the Appellant's right to have his say. The limits are arbitrary and unrelated to the issues to be decided. Moreover, the rules provide no similar limits on examiners. In other words, as is the recent trend, the deck is stacked against the Appellant in the asserted name of quality or efficiency.

The proposed rules also are devoid of checks and balances to assure that the Appellant's view is properly heard. There are no rules as to what would justify exceeding the page limits and short time limits to comply with the rules.

The above remarks regarding the Appeal Brief are equally applicable to the reply brief. And the undersigned submits that changing the length permitted is not the answer – 35 pages or 50 pages is equally arbitrary and not in keeping with giving the Appellant his fair hearing. The USPTO should bear in mind that few cases are worthy of the extreme expense of litigation, so appeal to the Board is a last resort for most Appellants. They should have the opportunity to be heard and this should be the foremost consideration in making rules for appeals.

It is further submitted that the misconduct and sanctions enumerated in the proposed rules will only further exacerbate a system wherein malpractice premiums are sky high and a practitioner's livelihood is at stake. If new sanctions are to be proposed, they must be for extremely well defined circumstances. This portion of the rules indirectly further increases costs since the increased possibility of sanctions must be factored in.

In conclusion, it is noted that the newly enacted claims and continuations rules are no doubt going to increase the number of appeals filed leading to backlog at the Board. However, this problem is of the USPTO's own doing. I objected to the originally proposed rules and find the revised rules to be even worse. It is respectfully submitted that the proposed appeals rules are in fact an attempted answer to this problem of the USPTO's own creation. Moreover, the answer is

not an answer at all. It will not make the appeal process more efficient, only more difficult and costly. This, in turn, will discourage appeals and deny otherwise worthy applicants of their statutory right to a patent by elevating the price of justice at the Board to a price that is further out of reach.

For these reasons, I object to the new rulemaking.

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On behalf of himself