

September 28, 2007

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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 published in the *Federal Register* Monday, July 30, 2007 (72 Fed. Reg. 145:41472-41490).

I am an Of Counsel at Morrison & Foerster, although I write today on my on behalf. I have been practicing before the Patent and Trademark Office for 10 years. I have filed at least 3 appeals in the last 12 months and, unfortunately I will need to file many more, given the recent changes imposed by the Patent Office regarding continuation practice. Even before the change in the rules, I have regarded the opportunity to seek review by the Board of Patent Appeals and Interferences (BPAI) of Examiner's erroneous actions as an invaluable tool. Unfortunately, the new requirements set forth in the proposed rules threaten to make preparing an appeal prohibitively expensive. Moreover, the new rules place an unacceptable burden on the appellants which is clearly and cynically designed to discourage the filing of appeals.

These proposed rule changes are unnecessary and will cause more harm than good if adopted. They are unnecessary in view of the recently achieved reduction in the BPAI's backlog for patent appeals. Clearly the present system is working; why fix what is not broken? More to the point, the alleged "fix" proposed by the Patent Office serves only to create unnecessary barriers for appellants seeking review by the BPAI.

The Patent Office's strategy to provide various disincentives to potential appellants is clear from the imposition of a twenty-five (25) page limit for the brief at 14 point Times New Roman, the additional "statement of facts" requirement in 41.37(n), and the various argumentation requirements set out in 41.37(o).

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The imposition of a page limitation on appeal briefs is clearly arbitrary and capricious. The proposed rules provide no support for why such a page limit is necessary for the efficient resolution of patent appeals. At best, this requirement serves to prevent appellants from addressing all the relevant issues to their case. The page limit may even amount to a denial of due process to appellants.

Requiring a “statement of facts” does nothing to increase the efficiency of appellate practice. Any relevant facts to the appeal are cited to in the argument section of the document where their import can be clearly seen. Requiring a separate statement of facts has only one purpose, it serves as a means to consume the finite pages of the appeal brief and raise the cost of preparing the document.

Even more disturbing are the requirements set out in 41.37(o). It is frequently the worst of the Examining Corps that prompt the most appeals. This minority of examiners frequently draft incomprehensible rejections based on questionable logic. Section 41.37(o) requires, amongst other things, that appellants reply to every argument raised by the examiner, no matter how illogical those arguments may be. Failure to address each argument results in a presumption that the examiner’s positions were correct. If this rule is adopted, appellants will be forced to spend time and resources on ancillary and frequently irrelevant points that have nothing to do with providing adequate grounds for overturning an erroneous rejection.

Another disturbing feature of this section is the requirement that a response to a rejection covering multiple claims must address each claim under a separate heading. This requirement is just another move by the Patent Office to require appellants to use their 25 pages of brief on unnecessary formal issues.

These proposed rule changes are unnecessary to the efficient resolution of patent appeals. As such, the Patent Office should not adopt them. Adoption of these rules will increase the cost of appeals for patent applicants and require the BPAI to expend more energy on procedural matters rather than correcting misguided examiners. In short, adoption of these rule on the heels of the various other rules recently promulgated by the Patent Office will only serve to weaken our patent system, the incentives to innovate in the United States, and ultimately the nation’s economy.

Respectfully submitted,

/James J. Mullen, III/

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JJM/gy