

MICHAEL HAYNES

25 September 2007

VIA E-MAIL: BPAL.Rules@uspto.gov
Subject: "Ex parte Appeal Rules"

The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Mail Stop Interference
P.O. Box 1450
Alexandria, VA 22313-1450

RE: Comments on Proposed: "Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals", 72 Fed. Reg. 41472 (30 July 2007).

Dear Under Secretary Dudas:

As an individual inventor, currently pending US patent applicant, and US patent owner, I appreciate the opportunity to provide comments regarding the U.S. Patent and Trademark Office ("USPTO") proposed rules directed to changes to practice (the "proposed Rules") before the Board of Patent Appeals and Interferences (the "Board") in ex parte appeals, as published at 72 Fed. Reg. 41472 (30 July 2007).

General Comments

Without addressing numerous areas truly in need of easily-implemented improvements, and without providing specific justification or explanation, the USPTO has again proposed many highly burdensome changes to ex parte practice, in this case ostensibly "to permit the Board to handle an increasing number of ex parte appeals in a timely manner", with the verb "handle" apparently meaning "discourage", "punish", or "reject".

To be crystal clear, several aspects of these proposed Rules are exceptionally troubling. Via the supreme example, proposed Rule 41.37(v), the Office seeks to severely limit the acceptable page count for an appeal brief, regardless of whether, within that page count, any space would remain for presenting appellant's argument after fulfillment of the Rules' other detailed and potentially spacious requirements for that brief. I believe that this requirement alone will substantially limit the ability of appellants to be reasonably heard by the Board, thereby effectively nullifying their procedural due process rights.

As another very important example, the proposed Rules and their discussion make numerous mentions and allusions to "entry" (or "entered"), such as into the "record" (e.g., proposed Rule 41.37 (t) states "The 'evidence section' shall contain only papers which [sic] have been entered by the examiner", and its explanation states that "The word 'evidence' would be construed broadly and would include amendments, affidavits or declaration, non-patent literature, foreign patents and publications, published PCT documents, and any other material admitted into the record by the examiner."

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Yet the precise process and meaning of “entry” (or “entered”), such as into the “record”, has been exceptionally poorly developed and defined by the USPTO, and creates the potential to further hinder review of arguably improper claim rejections. Thus, to avoid numerous confounding issues for the Board and the USPTO generally, the proper process and meaning for any form of “entry” of anything, such as into the “record”, must be explicitly, clearly, and thoroughly described and defined in the proposed Rules or in other contemporaneously-implemented revised Rules.

For example, the USPTO uses various forms of the term “entry” to refer to the following:

- a) anything filed with the USPTO (see e.g., 37 CFR 10.18 (b)(1));
- b) to file a National Stage application (see e.g., 37 CFR 1.491);
- c) to input and/or place data, information, and/or a document into a document (see, e.g., 37 CFR 1.10(d)(1)), a log (see e.g., MPEP 513), a paper file (see e.g., MPEP 707.10), or an electronic system, such as the IFW (see MPEP 103);
- d) to approve, and/or the approval of, any portion of a filing, such as an Examiner’s approval of a filed amendment (see, e.g., 37 CFR 1.62(b), 1.312, and 41.43); and/or
- e) to assert or provide the USPTO’s position on an issue (see e.g., MPEP 1207.03 and 37 CFR 41.64(c))

In some sections of the MPEP, multiple meanings for “entry” are presented essentially simultaneously. Compare MPEP 706.07(k), section 2D first paragraph to second paragraph.

Likewise, regarding the term “record”, the USPTO manifests similar imprecision and unclarity. For example, MPEP 103, section I, states that:

“The USPTO adopted an electronic data processing system for the storage and maintenance of all **records** associated with patent applications. All new applications filed on or after June 30, 2003 are stored in this system as an Image File Wrapper (IFW), and **the IFW is the official record** of the application. Similarly, as earlier filed pending applications are loaded into the IFW system, **the electronic record will be the official record** of the application.”

For each application available via the Image File Wrapper (IFW) portion of the USPTO’s Public PAIR website, the following statement is provided:

“This application is officially maintained in electronic form. To View: Click the desired Document Description. To Download and Print: Check the desired document(s) and click Start Download.”

Likewise, MPEP 1730 states that:

“[f]or patent applications in the IFW system, **the IFW file is the Official file**.”

Yet MPEP 2733 states that:

“Applicants should routinely use PAIR to check the accuracy of the **data entered** in the PALM system for their applications (i.e., the type of the paper and date of receipt in the Office) throughout prosecution. If any errors are detected, they should be brought to the

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Office's attention (e.g., the examiner or the Technology Center's customer service representative) as soon as possible to ensure that they are corrected before allowance of the application and the initial determination of the patent term adjustment. In checking Office **records**, applicants should keep in mind that the date that should be **recorded** in the Office computer **records** is the date of receipt of the paper, not the date that it was mailed under 37 CFR 1.8".

Thus, although its use of various forms of "entry" and "record" are somewhat sloppy, it does seem that the USPTO strongly insists that any information available via the Image File Wrapper for a given application has been "entered" into the "official record" and/or "Official file". Whether the proposed Rules intend a different interpretation of the concept of "entry" into the "record" or not, the USPTO's current interpretation of "entry" into the "record", should be explicitly, clearly, and thoroughly defined and described in the proposed Rules or in other contemporaneously-implemented revised Rules.

Comments on Specific Proposed Rules

I will now detail several issues and questions of substantial concern regarding other specific proposed Rules.

Proposed Rule 41.37(o): Appeal Brief

This proposed Rule states that "Each rejection shall be separately argued under a separate heading" and that "Any claim argued separately shall be placed under a subheading identifying the claim by number." Yet the meaning of these requirements have proven to be elusive to the USPTO. For example, at least 2 interpretations are reasonable, yet frequently, the USPTO refuses to accept one or the other. Specifically, one can reasonably interpret 41.37(o) to require, for example, an argument structured as follows:

Arguments:

Rejection A:

Claim 1:

Claim 2:

Rejection B:

Claim 1:

Alternatively, one can reasonably interpret 41.37(o) to require, for example, an argument structured as follows:

Arguments:

Claim 1:

Rejection A:

Rejection B:

Claim 2:

Rejection A:

At various times in the past year, the USPTO has rejected Appeal Briefs that follow the first approach. At other times in the past year, the USPTO has rejected Appeal Briefs that follow the second approach. Obviously, proposed Rule 41.37(o) can be worded to remove the ambiguity by

clearly stating that both approaches are acceptable, or by clearly stating which of the approaches is required.

Proposed Rule 41.37(q): Claim Support Section

a) The case law on “limitation” is all over the map. What specifically does the proposed rule mean by “limitation” (e.g., word, phrase, or indented chunk of text, etc.)?

b) Must all specification support for the claim limitation be cited, or is merely adequate support sufficient? If all specification support for the claim limitation must be cited, what is the specific basis and purpose for that requirement?

c) Must specification support for every claim limitation be cited, or is specification support for merely contested claim limitations sufficient? If specification support for every claim limitation must be cited, what is the specific basis and purpose for that requirement?

Proposed Rule 41.37(r): Drawing Analysis Section

a) The case law on “limitation” is all over the map. What specifically does the proposed rule mean by “limitation”?

b) Must all drawing support for the claim limitation be cited, or is merely adequate support sufficient? If all drawing support for the claim limitation must be cited, what is the specific basis and purpose for that requirement?

c) Must drawing support for every claim limitation be cited, or is drawing support for merely contested claim limitations sufficient? If drawing support for every claim limitation must be cited, what is the specific basis and purpose for that requirement? What about those claim limitations for which no drawing is “necessary for understanding of the subject matter sought to be patented” (see 35 USC 113 and 37 CFR 1.81(a))?

d) Is there any particular format desired for how drawing support is indicated between the braces? For example, is merely pointing out the figure number sufficient? [Note difference with corresponding requirement of Proposed 41.37(s)]

Proposed Rule 41.37(s): Means or Step plus Function Analysis Section

a) The case law on “limitation” is all over the map. What specifically does the proposed rule mean by “limitation”?

b) Must all specification and drawing support for the claim limitation be cited, or is merely adequate support sufficient? If all specification and drawing support for the claim limitation must be cited, what is the specific basis and purpose for that requirement?

c) Must specification and drawing support for every “function limitation” be cited, or is specification and drawing support for merely contested “function limitations” sufficient? If specification and drawing support for every claim limitation must be cited, what is the specific basis and purpose for that requirement?

Proposed Rule 41.37(v): Appeal Brief Format Requirements

(1) Page and Line Numbering

a) Is the desired page numbering of the form “1” or “Page 1”?

b) Would page numbering of the form “Page 1 of 36” be acceptable?

c) May the line numbering start below any header on the page rather than “at the top of each page”?

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(2) Double Spacing

- a) May greater than double-spacing be used at any location in the brief?

(3) Margins

- a) May a header appear within the top margin?

(4) Font

- a) What specifically is meant by a font that is “clean”? How does it differ from a font that is “readable”?

(5) Length of Appeal Brief

- a) What is the specific basis and purpose for limiting the appeal brief to 25 pages? How was the number 25 determined?

b) Given that the only stated way “to give meaning to the 25-page limitation” relates to arguments, what is the specific basis and purpose for not applying the page limitation to only the Argument section? This is of substantial concern recognizing that across different applications on appeal, there will likely exist a very wide range in:

1. the numbers of appealed claims;
2. the amount of text needed to describe the status of those claims;
3. the amount of text needed to describe the status of the amendments to those claims;
4. the number of rejections appealed;
5. the amount of text needed to describe those rejections;
6. the number of facts that are relevant to properly understanding applicant’s traversal of those rejections; AND/OR

7. the amount of text needed to describe those relevant facts.

c) One can easily imagine situations where, after fulfilling the requirements for each of the above, there would simply be no room left for any content in the Argument section. Thus, why not defer implementing any page limitation until after the Board has had ample opportunity to gather sufficient appeal briefs under the proposed rules to determine the extent of each of the above-described wide ranges? That is, to avoid being arbitrary, any page limitation should be based on a thorough and proper statistical analysis of the content of the pages being limited. Such an analysis has not yet been presented.

d) Must any request to exceed the page limit be submitted 10 days prior to the original brief due date or may it be submitted 10 days prior to the brief’s properly extended due date? That is, what precisely is intended by the phrase “the date the appeal brief is due”?

e) Note that each of these questions and comments is correspondingly applicable to proposed Rule 41.41.

(6) Signature block:

a) If the “correspondence address” provided differs from that “of record”, which will the Board use?

b) Must appellant or appellant’s representative correspond with the Office via fax? If not, why is a fax number required?

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c) Must appellant or appellant's representative correspond with the Office via e-mail? If not, why is an e-mail address required?

Proposed Rule 41.39: Examiner's Answer

Generally: must the Examiner's Answer conform to the formatting requirements of Proposed 41.37(v)? If not, what is the specific basis and purpose for those formatting requirements?

Proposed Rule 41.43: Examiner's Response to Reply Brief

Generally: must the Examiner's Response conform to the formatting requirements of Proposed 41.41 and 41.37(v)? If not, what is the specific basis and purpose for those formatting requirements?

Proposed Rule 41.47: Oral Hearing

(c) Time for Filing Request for Oral Hearing

a) From which date, the date of the examiner's answer or the date of the supplemental examiner's answer, must the request be filed? That is, does the mailing date of any supplemental examiner's answer re-start the 2 month deadline for filing the request?

(g) List of Terms

a) What specifically is meant by "technical terms"? What degree of technical competence may be presumed to the individual transcribing the oral hearing?

b) What specifically is meant by "unusual words"? "Unusual" to whom?

(h) Length of Argument

a) May the appellant or its representative "reserve" time for rebuttal?

Proposed Rule 41.50: Decisions and Other Actions by the Board

(c) Remand not Final Action

a) How should an applicant signal to the Board that proceedings on remand before the examiner have been concluded?

b) Assuming conclusion of proceedings before the examiner, when must the Board, if ever, enter an order making its decision final so that applicant may exercise its further appeal rights?

Proposed Rule 41.52: Rehearing

(f) Argument

a) If applicant believes that the Board's opinion includes, in support of a previously-made rejection, an incorrect finding of fact, an incorrect legal standard (not withstanding any recent legal development), or an improper application of law to fact, what is the specific basis and purpose for not allowing the applicant to make an argument explaining that belief? To have any potential legal effect, must applicant seek judicial review to argue any such belief?

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Proposed Rule 41.56: Sanctions

(a) Imposition of Sanctions

a) Does FRCP 11 and its relevant case law define the meaning of a “misleading” request for relief or argument? If not, what is the precise meaning of “misleading” in this context?

b) Does FRCP 11 and its relevant case law define the meaning of a “frivolous” request for relief or argument? If not, what is the precise meaning of “frivolous” in this context?

I appreciate the opportunity to provide comments on the proposed Rules and I am available to assist the USPTO in further developing patent practice and procedures. Please feel free to contact me. Thank you.

Sincerely,

Michael Haynes