

September 28, 2007

Via Electronic Mail: BPAI.Rules@uspto.gov

Honorable Jon W. Dudas
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Mail Stop Comments—Patents
PO Box 1450
Alexandria, VA 22313-1450

Attn: Fred E. McKelvey, Chief Judge
Board of Patent Appeals and Interferences

Re: Comments on

Notice of Proposed Rulemaking Entitled “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 and Chief Judge McKelvey:

The Patent Prosecution Committee of the Minnesota Intellectual Property Law Association (“MIPLA”)¹ is grateful for the opportunity to comment on the Notice of Proposed Rulemaking Entitled “Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals,” 72 Fed. Reg. 145 (the “Ex Parte Appeals Rules”). The comments submitted herewith reflect the view of the Patent Prosecution Committee as a whole, and do not necessarily reflect the view or opinions of either MIPLA or any of the individual members or firms of the Patent Prosecution Committee, or any of their client.

General Comments

Patent applicants are entitled to a fair opportunity to protect their valuable inventions at a reasonable cost, and—most importantly—preserve the Constitutional mandate to promote the progress of science and the useful arts by providing exclusive rights to patentees that correspond to the scope of their discoveries and inventions. While the proposed Ex Parte Appeals Rules may address important issues that the USPTO and the BPAI in terms of the anticipated increase in the number of appeals in view of the new rules on continuations and claim limits, it is respectfully submitted that the propose Ex Parte

¹ The MIPLA is an independent organization affiliated with the Minnesota State Bar Association (MSBA). The MIPLA has nearly 700 members representing all aspects of private and corporate intellectual property practice, as well as the academic community. The MIPLA Patent Prosecution Committee which submits these comments is doing so on its own authority pursuant to the bylaws of MIPLA. The comments do not necessarily represent the views of either MIPLA or the MSBA.

Appeals Rules are unfairly weighted in favor of the USPTO and against applicants in terms of creating a relatively level and even playing field on which to prepare and present the issues for appeal. While the proposed rules create numerous opportunities whereby an Examiner or the Board may reconsider matters and reopen prosecution, applicants are not provided with any similar opportunities to bring additional evidence into the case in order to better frame the issues for appeal. MIPLA wants the USPTO and the Board to understand the practical realities that it may be only after developing an argument in the context of preparing the Appeal Brief that the advantage or need for certain evidence to be on the record is ascertained by practitioners. It is respectfully submitted that the interests of an efficient appeal and prosecution process, particularly in light of the limits on continuations and RCEs, weigh in favor of permitting submission of such evidence up until the filing the Appeal Brief. While such submissions may not have occurred prior to the issuance of a Final Rejection, the examiner may consider this evidence in the Examiner's Reply as part of a reconsideration of the case in view of the Appeal Brief and, if persuasive, prosecution can be reopened.

Sincerely,

/s/ Brad Pedersen

Brad Pedersen

MIPLA Patent Prosecution Committee

- I. The Proposed Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals (72 Fed. Reg. 145) are Unclear, Incomplete, Ineffective, and/or Inconsistent.
 - A. Section 41.30 – **Definitions**
 1. Preferential status should not be granted as default status to U.S. patents and published U.S. applications cited by the examiner or appellant.¹
 2. Other types of references should not be excluded from the “record on appeal.”²
 - B. Section 41.31(e) – **Appeal to Board/Non-appealable issues**
 1. An appellant should be permitted to appeal an examiner’s refusal to enter a response to a final rejection.³
 - C. Section 41.33(d) – **Amendments and evidence after appeal/Evidence after notice of appeal and prior to appeal brief**

¹ Unpublished U.S. applications, foreign patents, foreign applications (published and unpublished), and patents and applications (published and unpublished) that are not cited by the examiner or appellant are not among the default types of references listed which the “record on appeal” may consist of and must be separately added to the record.

² Prior art that is not in the form of patent or published U.S. application, declarations, references incorporated by reference, office actions, responses to office action, and other documents in the prosecution file history of the application being appealed are not among the default types of references listed which the “record on appeal” may consist of and must be separately added to the record.

³ This is one of several provisions that disproportionately hinder the ability of an appellant to build a record on appeal in favor of enhancing the ability of the examiner to narrow the scope of the record on appeal. In connection with Proposed Bd. R. 41.30, an examiner may be able to prevent the Board from receiving evidence relevant to an applicant’s appeal by refusing to enter any evidence presented by the applicant after a final rejection.

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1. Evidence that is filed after a notice of appeal is filed but before an appeal brief is filed should be admissible as a matter of right.⁴

Applicants should be permitted to submit evidence (but not comments) up to the filing of the Appeal Brief.

D. Section 41.37(o) – **Appeal brief/Argument**

1. There is an unfair presumption that all unchallenged conclusions reached by the examiner are correct.⁵

E. Section 41.37(t) – **Appeal brief/Evidence section**

1. That an examiner may include additional material in the evidence section by attaching it to the examiner's answer is inconsistent with the aforementioned evidentiary limitations placed upon appellants.⁶

⁴ Such evidence may only be admitted if (1) the examiner determines that the evidence overcomes some or all of the rejections; and (2) the appellant shows good cause why the evidence was not presented earlier. As with section 41.31(e), this provision gives too much quasi-judicial record-making power to the examiner. For example, an examiner is permitted to make a new rejection (*i.e.*, rejection on new grounds), while an applicant is unable to submit new evidence. Most importantly, it may be only after developing an argument in the context of preparing the Appeal Brief that the advantage or need for certain evidence to be on the record is ascertained. The interests of an efficient appeal and prosecution process weigh in favor of permitting submission of such evidence, as the examiner may consider this evidence in the Examiner's Reply and, if persuasive, can reopen prosecution.

⁵ This presumption creates an incentive to appeal as many issues as possible, including those which may be duplicative or of only marginal value to the applicant, to avoid a possible waiver of the applicant's ability to later appeal such issues. This requirement will burden, not streamline, the appeal process.

⁶ This provision provides an examiner with yet more discretion and authority in determining the evidence that may be considered by the Board. Based on the proposed rules, after an appeal brief has been filed, an applicant can only submit new evidence in response to a rejection on new grounds. To the extent that an examiner is permitted to

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- F. Section 41.39(a) – **Examiner’s answer**/*Answer*
1. There should be a time limit for when an examiner must submit an answer to an applicant’s appeal brief.⁷

submit new evidence even when issuing a new rejection, however, an applicant should also be permitted to submit new evidence in response. The suggested changes to section 41.33(d) would remedy this problem and put the applicant and the examiner on a more level playing field for appeal.

⁷ Even though the applicant must file an appeal brief within two months from the date of the filing of a notice of appeal, *see* § 41.37(c), there is no corresponding deadline by when the examiner must submit an answer.