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RE: Ex Parte Appeal Rules

Sir:

I am a practicing patent attorney with approximately 10 years experience in prosecuting patent applications before the U.S. Patent & Trademark Office (USPTO). Although I have substantial experience drafting patent applications, my practice has almost been largely focused on patent prosecution. For approximately five years, I was under the tutelage of two former members of the Board of Patent Appeals and Interferences (hereinafter the Board). As such, I gained considerable experience with regard to practice before the Board. In the current calendar year (i.e., the first 9 months of 2007), I have personally written and filed approximately 65 Appeal Briefs and 25 Reply Briefs before the Board.

I applaud the goal of reducing pendency before the Board. It has been my experience that the pendency of Appeals before the Board have grown significantly over the past 12-18 months, and given expected consequences of the new rule package by the USPTO, I also expect that the number of Appeals being filed will increase dramatically.

After careful consideration of this proposed rule packages, I believe that in certain instances, the rules do not go far enough, in other instances, the rules go to far, and other situations, the rules do not address what I consider to be one of the biggest issues driving the filing of Appeal Briefs.

My reaction to these rules are based, in part, upon the following considerations. Changes to the rules should not impinge on the due process rights of my clients to appeal rejections from the USPTO. The rationale to change the rules should be clearly stated, and the rules should be drafted so as to achieve that purpose. The burden imposed on my clients should be justified by the benefit sought to be achieved. The rules should also be unambiguous as to the manner in which these rules will be applied.

Although I occasionally touch on certain of the proposed rules during my discussion, most of my comments will be on the rule package in general. My main comments as to the rule package, as a whole, are as follows:

- 1) The rule package does address how to reduce the number of Appeals being filed.
- 2) The rule package is trying to impose a format on presenting an argument that would be better served by another approach.
- 3) The rule package completely entirely ignores one-half of the parties involved during Appeal (i.e., the Examiner).
- 4) The rule package is turning the tables by (i) forcing Applicant to be the finder of fact in the Application and (ii) not recognizing that the initial burden a prima facie rejection rests with the Examiner by presuming that the Examiner has made a prima facie rejection and forcing Applicant to rebut such a rejection.
- 5) The rule package, by imposing a rule limit (and other formatting requirements) on the filings submitted by Applicant, may force Applicant to forego raising legitimate arguments because of lack space and thereby impinge on the due process rights of Applicant.

Following these main arguments I have also individually addressed other issues.

REDUCING THE NUMBER OF APPEALS FILED

In a recent presentation by the USPTO entitled "Making Effective Use of the Appeals Process & Practice Tips"¹, it was stated that "Appeals are won or lost on:

- Claim interpretation
- Findings of fact
- Application of the correct law"

In my experience, with the exception of addressing issues under 35 U.S.C. § 101, the majority of the applications I take to Appeal involve claim interpretation and findings of fact. However, a vast majority of the applications I take to Appeal are not based solely upon a difference of opinion between myself and the Examiner as to findings of fact and/or claim construction. Instead, almost all the cases I take to Appeal involve some deficiency as to both findings of fact and claim interpretation.

The following language, without omission, is taken from an Office Action² that I recently appealed:

As per claim 1, Bernardo discloses a method for moderating [sic] external access to an electronic document authoring, development and distribution system comprising the steps of: identifying a third party ("i. e, users") requesting access to said electronic document authoring, development and distribution system (note abstract and see column 2 lines 40-65 and column 3 lines 17-42 and column 4 lines 49-67 and column 5-15 lines 1-67 and column 18 lines 3-45) permitting restricted access to said third party to selected functions of said, electronic document authoring, development and distribution system(see column 2 lines 40-65 and column 3 lines 17-42 and column 4 lines 49-67 and column 5-15 lines 1-67 and column 18 lines 3-45) and, eliminating all access restrictions to said selected functions in said electronic document authoring(see column 2 lines 40-65 and column 3 lines 17-42 and column 4 lines 49-67 and column 5-15 lines 1-67 and column 18 lines 3-45) development and distribution system which were imposed in said permitting step when said third party registers as a registered user of said electronic document authoring, development and distribution system.(Note abstract and see column 2 lines 40-65 and column 3 lines 17-42 and column 4 lines 49-67 and column 5-15 lines 1-67 and column 18 lines 3-45 and column 21 lines 1-48).

¹ http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/ca_bar_0607.html.

² This application has not been published, but the client consented to this quote for the express purpose of including this quote within these comments.

I will be referring to this passage, on occasion, throughout these comments. I have reproduced this passage because it has some notable characteristics. For clarity sake, this passage constitutes the Examiner's entire analysis with regard to this claim.

One notable characteristic of this analysis, with the exception of associating the term "users" with the claimed "third party," is that the Examiner's statement of the rejection does not refer to any of the individual elements recited in the claims. Instead, the Examiner only treats each passage, as a whole, without addressing the individual elements. This characteristic is extremely common with the Office Actions I receive from the USPTO. Although the passages in this particular claim are relatively short, this analysis is even more problematic when the passage is longer and contains much more elements and interactions between these elements and elements found in other passages.

In fact, I frequently see Office Actions (with the exception of analysis regarding the obviousness of a particular combination) that only reproduce Applicant's claim language and, at the end of each claim passage, cite one or more sections in the prior art. My experience has also been that if Applicant's claim language was removed from an Office Action as well as any "canned" language, which would only leave the Examiner's analysis, the amount of analysis found in the Office Action will frequently be less than a single page.

Another notable characteristic of this analysis is the lack of specificity in the Examiner's citations. For example, the citation of "column 5-15 lines 1-67" is essentially the citation of 11 whole columns of text. Although this example is less specific than most, I have seen even less specific citations.³ Typically, I see citations such as "column 3 lines 17-42" and "column 4 lines 49-67," which range anywhere between 1/4 to 1/2 the length of a column in a cited patent. Not only do I see these citations that lack specificity with long claim passages but I also see these citations for even a single limitation (i.e., a 2-3 word phrase).

³ In one instance, the Examiner's citation was to all the figures and all the columns in the cited reference.

The problem with these types of rejections can be explained using the following canned argument that I frequently use when address these rejections.

The importance of the specificity requirement of 37 C.F.R. § 1.104(c) is evident in M.P.E.P. § 706.07, which states:

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

A clear issue, however, cannot be developed between Applicant and the Examiner where the basis for the Examiner's rejection of the claims is ambiguous. The Examiner's "analysis" provides little insight as to (i) how the Examiner is interpreting the elements of the claims and (ii) what specific features within Wang the Examiner believes identically discloses the specific elements (and interactions between elements) recited in the claims. By failing to specifically identify those features within the reference being relied upon in the rejection, the Examiner has essentially forced Applicants to engage in mind reading and/or guessing to determine how the Examiner is interpreting the elements of the claims and what specific features within the reference the Examiner believes identically disclose the claimed invention.

In effect, the Examiner is placing the burden on Applicant to establish that the reference does not disclose the claimed elements based upon Applicant's interpretation of the claims and Applicant's comparison of the claims with the applied prior art. However, this shifting of burden, from the Examiner to Applicant, is premature since the Examiner has not discharged the initial burden of providing a *prima facie* case of anticipation. Applicant also notes that any continuing disagreement between Applicant and the Examiner as to whether or not a particular claimed feature is disclosed by the reference is a direct result of a lack of specificity by the Examiner in the statement of the rejection.

In this passage I refer to 37 C.F.R. § 1.104(c), which ostensibly addresses this issue and reads:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

However, after citing this passage in hundreds of patent applications, my experience is that this particular rule is rarely enforced at any level within the USPTO. Instead, my experience has

been that there is an institutional resistance to performing the type of analysis outlined by 37 C.F.R. § 1.104(c). I recall one conversation with a Supervisory Examiner 1 or 2 years ago⁴ during which I was told that the director of the Examiner's group specifically instructed that examiners within the group not "map"⁵ claims until an Examiner's Answer. The purported reason for this directive was that mapping claims takes extra time, which reduces the number of actions being issued by the group.

Notwithstanding my admittedly factually-unsupported description of a conversation that took place some time ago, I have frequently received comments similar to the following in Office Actions:

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

I note a stark contrast between this above-reproduced statement and the comments found in the paragraph spanning columns 1 and 2 on page 41476 of the discussion in the Federal Register concerning the rule package as to specific citations.

The following was written by a Primary Examiner in response to my specificity arguments following a rejection of claims 1-11 of an application (i.e., all the claims) based only on the following analysis "Wang discloses utilizing a PDA device to support the purchase and redemption of an encrypted electronic ticket. See at least column 17, lines 59+ as well as other relevant text."⁶ After my response, the Examiner responded as follows:

It should be noted that the Examiner is not required to map each limitation to a cited passage within the prior art of reference, as is suggested by the Applicant, nor is it the Examiner's responsibility to translate the technology, techniques, and/or methods of the prior art of record, since it is the assumption of the Examiner that the Applicant and the Applicant's representatives are those of at least ordinary skill in the art. Since the Examiner assumes that the Patents used in making the rejections with regard to and in light of the instant claims have complied with the enablement standards at set for the by the United States Patent and Trademark Office, the

⁴ I do not recall either the name of the Examiner or the group.

⁵ The phrase "map" is commonly used by the USPTO to refer to act of identifying claimed features with teachings in the prior art.

⁶ To be perfectly clear, that statement was the only analysis in the Office Action.

Examiner correctly deduces that one of common skill would be able to read, understand, and manufacture the innovation as disclosed by the inventors. Subsequently, since the Applicants and their representatives are considered to be at least fundamentally schooled in the arts of the instant invention, it is also correct for the Examiner to infer that the same are capable of comprehending and appreciating the prior art as disclosed by the inventors and accredited by the USPTO. Ergo, the passages cited by the Examiner are a courtesy meant not only to lay a foundation of rejection of the claim limitations, but also to introduce the prior art of record as a benchmark of knowledge currently employed by artisans of the past and present, and also for establishing a pathway for continued prosecution. It is incumbent upon the Applicant and the Applicant's representative, then, to evaluate the prior art of record, point out misconceptions or other inaccuracies made by the Examiner, assert limitations that have not been properly addressed or that are novel, and, if deemed necessary, amend the claims to overcome the prior art of record, each and all in pursuit of an allowance. (emphasis added)

The reason I have spent several pages discussing patent prosecution leads back to one of my original points, which is that the USPTO recognizes that two of the major determining factors Appeal as to whether an Appeal is won or lost involve claim interpretation and findings of fact. These two factors, I believe, are addressed by 37 C.F.R. § 1.104(c), which discusses designating, "as nearly as practicable" the particular part being relied upon (i.e., findings of fact) and clearly explaining the pertinence of each reference (i.e., claim construction).

During prosecution, one of the most important questions I have to answer is, based upon the cited prior art and the Examiner's analysis, should I: (i) amend the claims to either clarify claim limitations and/or add limitations? (ii) argue that the claims are patentable, as is? or (iii) abandon one or more of the claims. Although there are other factors involved, the answer to this question involves me determining whether the examiner has established that the applied prior art identically discloses and/or makes obvious all of the limitations.

This determination requires that I consider each limitation, the Examiner's analysis, and the applied prior art. This determination is quickly made when an Office Action has been prepared per the requirements of 37 C.F.R. § 1.104(c). However, if an Office Action has been prepared comparable to the two examples I have previously provided, that determination is much harder to make. For simple inventions or for technology that has "etched in stone" terminology, making this determination is possible. However, for complex claims involving limitations having complex interactions or for an invention in which the terminology is very variable,

making this determination can be nearly be impossible based upon the type of analysis found in the two examples.

There are many reasons why myself and an Examiner may disagree as to a particular issue. For example, the Examiner may have overlooked a limitation. The Examiner and myself may be interpreting a particular phrase differently, or the Examiner and myself may agree on a particular claim construction but disagree as to whether a particular teaching identically discloses the limitation. When the Examiner's Office Action meets the requirements of 37 C.F.R. § 1.104(c), I can quickly identify where the Examiner and I disagree, and I can amend the claims and/or traverse accordingly. However, where the Examiner's analysis is ambiguous, it is difficult to direct my arguments to those areas in which the Examiner and I disagree when I do not know the Examiner's position on a particular issue.

If, after making my determination, I am unclear as to whether or not the Examiner has set forth a proper rejection under either of § 102 or § 103, I cannot amend the claims and/or abandon the application. I cannot amend the claims since if the Examiner has not set forth a proper rejection, then to amend the claims would be to potentially give up certain rights that my client is entitled to. Moreover, it is difficult to amend the claims when I am unclear as to how the Examiner is interpreting the claims and/or the reference. For example, if the Examiner is construing a particular claim term more broadly than I think justified, I can amend that claim term. However, if the Examiner's analysis does set forth that claim construction, I cannot make that claim amendment. Thus, to protect the rights of my clients, if I am unsure that the Examiner has set forth a proper rejection, my first inclination is to traverse rather than amend. Moreover, with the new rules that curtail the availability of continuing prosecution through the use of Requests for Continued Examination (RCE), once the Examiner makes the Office Action final, and I am still unclear as to whether or not the Examiner has set forth a proper rejection, my first inclination is to Appeal. To do otherwise, in my opinion, would possibly give up rights to which my client is entitled.

As set forth in the Summary on page 41472 of the Federal Register:

The proposed rules seek to provide examiners and Office reviewers with a clear and complete statement of an appellant's position at the time of filing an appeal brief so as to enhance the likelihood that appealed claims will be allowed without the necessity of further proceeding with the appeal, minimize the pendency of appeals before the Office, minimize the need for lengthy patent term adjustments in cases where claims become allowable as a result of an action by the Board in an appeal, provide uniform treatment of requests for an extension of time filed after an appeal brief is filed, and make the decision-making process more efficient.

This exact same concept applies where the roles are reversed:

Where the Examiner provides "[Applicant] with a clear and complete statement of [the Examiner's] position at the time of [issuing the Office Action] ... the likelihood [is] that the [rejected] claims will be [amended, cancelled, or specifically traversed] without the necessity of further proceeding with the appeal, minimize the pendency of [patent prosecution] before the Office, minimize the need for lengthy patent term adjustments in cases where claims become allowable as a result of an action by the Board in an appeal, ... and make the decision-making process more efficient."

It is my opinion, therefore, that a more rigorous enforcement of the provisions of 37 C.F.R. § 1.104(c) would lead to better and more compact patent prosecution, which in turn will lead to less Appeals, which achieves the exact results desired by the current rule package.

Moreover, notwithstanding the effect of reducing the number of Appeals, a more rigorous enforcement of the provisions of 37 C.F.R. § 1.104(c) will lead to more narrowing focused Appeals, since the number of issues, as a whole, on Appeal should be reduced and that by the Examiner more clearly establishing the rationale for rejecting the claims, a more exhaustive record can be established by the Examiner and Applicant as to the particular issues that remain between the Examiner and Applicant prior to going to Appeal.

REGULATING FORMAT OF ARGUMENT

I understand that one does not have to be an attorney to engage in patent prosecution at USPTO. Moreover, I understand that responses by both patent attorneys and patent agents to the

USPTO and specifically to the Board can be as analysis-deficient as the two examples of Examiner's analysis that I provided above. As such, I recognize that many Appeal Briefs contain analysis that is both difficult to follow and factually unsupported.

However, my opinion is that regulation of the format of argument (e.g., subsections (o)(4)-(o)(8) of § 41.37): (i) will be difficult to enforce; (ii) could, if enforced strictly, produce a substantial amount of rework (i.e., non-compliant Appeal Briefs); (iii) overlooks the nature of writing a persuasive argument; and (iv) places the burden on Applicant to prove patentability.

It has been experience after writing hundred(s) of Appeal Briefs and prosecuting probably well over a thousand patent applications that the approach I take respond to one rejection under, for example, 35 U.S.C. § 102 is probably not the same approach that I took to address the prior rejection, the rejection before that, or even the next rejection I receive under 35 U.S.C. § 102. For example, in one instance, I may be dealing with a reference that just does not disclose the claimed invention, in another instance, the rejection may revolve around claim construction, in another instance, the rejection may stand or fall on an inherency argument, and/or in another rejection, the argument may be that the Examiner is relying on two different elements having two different characteristics to identically disclose a claimed single element having both of these characteristics. These are just of few ways I can address a rejection under 35 U.S.C. § 102.

For example, consider the first example of an rejection by an Examiner that I reproduced above. Although, when I prepared the Appeal Brief that was eventually filed in response to this rejection, I identified certain elements that I had high confidence were not disclosed by the applied prior art. However, there were many more claimed elements that I was not clear on because the Examiner's analysis was essentially absent. I could write that "Appellant recognizes that "users" could disclose the claimed third party, but Appellant is unclear where any of the other elements are identically disclosed by the Applied Prior Art," but his would not meet the requirements of § 41.37(o)(6) although this argument clearly and very accurately explains my position.

The more I read these requirements, the less onerous they become to me. However, my suggestion is that these requirements be transformed into guidelines. Better yet, instead of setting the requirement in stone (i.e., in regulations that are infrequently amended), the USPTO should publish, on the USPTO website, a set of guidelines as to how to prepare arguments before the board. Moreover, these guidelines can be made more explicit and detailed than could ever be achieved through regulation. The guidelines could also be tailored to specific issues. An advantage to have these guidelines posted on the USPTO website is that these guidelines could be easily and quickly amended (e.g., to respond to new case law or to reflect a style of argument that better addresses a particular issue) or added to (e.g., to reflect a particular type of issue that frequently arises and has not yet been addressed).

It is been my experience that patent practitioners respond favorably to guidelines. Uniformity in practice is a desirable goal since time spent worrying about form of an argument could be better spent on the substance of the argument. Moreover, I believe that most patent practitioners would follow published guidelines to the best of their ability since following these guidelines would, presumably, present their arguments to the Board in the best light. Successfully obtaining patents for clients is a powerful motivator for patent practitioners.

However, I believe all patent practitioners recognize that "one size does not fit all" when it comes to making arguments and that there are occasions where one has to deviate from uniformity. My opinion is that the present rule package, instead of permitting flexibility in argument that sometimes is required, will force patent practitioners to try to fit a square peg of an argument into the required round hole described by the present rule package. In such an instance, the patent practitioner will be placed back into a position of spending more time on the form of the argument instead of the substance of the argument to the detriment of Applicant and the Board.

One issue with regard to the proposed rules as to format of argument is that certain of these rules appear to place the burden on Applicant to prove patentability. For example, consider the first full paragraph on column 3 of page 41477 of the Federal Register:

Proposed Bd.R. 41.37(o)(5) would require, for each rejection under 35 U.S.C. 112, second paragraph, that the argument shall also specify how the rejected claims particularly point out and distinctly claim the subject matter which appellant regards as the invention.

It has been my experience that although many rejections are made under the second paragraph of 35 U.S.C. § 112, few of these rejections pass muster based upon the Examiner failing to meet requirements imposed on the Examiner by case law. As such, rarely does an Examiner actually set forth a prima facie case of indefiniteness that I have to rebut. However, this rule would require that I rebut the Examiner's rejection regardless as to whether or not the Examiner has set forth a proper prima facie case. Essentially, I would have to prove that the claims are definite without the Examiner first establishing a prima facie case of indefiniteness. Such a requirement is contrary the long held notion that the Examiner has the initial burden of factually supporting any prima facie conclusion.

Finally, after drafting many Appeals and receiving a number of Notices of Non-Compliant Appeal Briefs for as little as writing "1" instead of "10," my experience is that the more requirements that are placed on Appeal Briefs, the more Notices of Non-Compliant Appeal Briefs will be issued and the more administration burden will be placed on the USPTO to police all these requirements. Moreover, if the USPTO chooses to strictly enforce the format as to argument, I foresee a tremendous amount of rework and argument as to whether or not an Applicant has met these requirements.

IMPROVING THE EXAMINER'S CONTRIBUTION

The most puzzling aspect, to me, of the proposed rules package are the changes (or lack thereof) made to requirements for the Examiner's Answer. Applicant will be required to adhere to page limits in their filings, yet there is no corresponding requirement for the Examiner's Answer. Applicant will be required to adhere to page limits in their filings, yet there is no

corresponding requirement for the Examiner's Answer. Applicant will be required to adhere to specific formatting in their filings, which includes a table of contents, a table of authorities, a claims section, a claim support section, a drawing analysis section, an evidence section which includes a table of contents, prior Office Action(s), all evidence relied upon by the Examiner, (to name a few), yet there is no corresponding requirement for the Examiner's Answer. Applicant will be required to prepare the Appeal Brief using a particular size font and particular formatting, yet there is no corresponding requirement for the Examiner's Answer. Applicant will be required to present arguments to Board using very particular formats, yet there is no corresponding requirement for the Examiner's Answer.

The stated purpose of the rules package, which will impose these requirements on Applicant, is to minimize pendency before the Board and to improve the Board's understanding of issues before the board. However, the question I have is why has the requirements for the Examiner's Answer not been changed to provide, to the Board, the same benefits.

The Board's decision rest on the writings of both Applicant and the Examiner. As such, I am unclear as to the rationale that supports the need to have Applicant's papers be subjected to all these new requirements yet the Examiner's papers be subjected to none of these new requirements. The time-worn expression "what is good for the goose is good for the gander" applies here. Requirements, imposed on papers filed by Applicant, for the efficient disposal of Appeals before the Board should equally apply to the Examiner's Answer. Moreover, where requirements, such as line number, are being imposed upon Applicant for ease of reference, then these same requirements should not only be required in the Examiner's Answer but also in Office Actions and Applicant's response to these Office Actions.

TURNING APPLICANT INTO THE EXAMINER

For time limitations sake, I have addressed this section last, and will not be as extensive as I would like. I have already addressed the point that I believe that certain of these rules are

placing the initial burden on Applicant to rebut a rejection, when case law clearly states that the Examiner first must establish a prima facie case before Applicant is required to respond.

Regarding the finding of facts section for the Appeal Brief, the following is found on page 41475 of the Federal Register:

Proposed Bd.R. 41.37(n) would require a "statement of facts." Appellant would set out in an objective and non-argumentative manner the material facts relevant to the rejections on appeal, preferably in numbered paragraphs. A clear, concise and complete statement of relevant facts will clarify the position of an appellant on dispositive issues and assist the examiner in reconsidering the patentability of the rejected claims. A fact would be required to be supported by a reference to the page number of the record on appeal.

As I noted before, the Examiner is the finder of facts. For reasons I have already discussed, I believe the Examiner should take the lead in setting forth the facts of the application. However, I also recognize that where Applicant is to rebut an argument by the Examiner, then the Applicant should also set forth the basis of the facts Applicant is relying on.

One of the comments I that I particular take exception to is the following:

For example, in the case of a rejection for obviousness under Sec. 103, the facts should address at least the scope and content of the prior art, any differences between the claim on appeal and the prior art, and the level of skill in the art.

These are the facts that should be set forth by the Examiner in the rejection. I am unclear as to why Applicant should steps into the Examiner's shoes and reproduce these factual findings. If Applicant disagrees with the Examiner on certain facts, then I agree that those facts that support the disagreement should be set forth. However, this comments appears to require Applicant to completely reproduce the Examiner's factual findings. If this is important for the making the Board's decision, then Applicant should be able to reference the Examiner's Office Action as to these facts.

FORMATTING REQUIREMENTS HAVING NEBULOUS BENEFITS

It is my understanding that the formatting requirements (e.g., page limits, font size, appendices, etc.) being imposed on Appeal Briefs and other filings are adopted, in part, from the

requirements imposed by the Court of Appeals for the Federal Circuit. On one level, I believe that the comparison with the Federal Circuit is a poor comparison. On another level, I do not believe that sufficient evidence has been submitted to support a need for these rules. On yet another level, I believe that certain of these rules could adversely affect Applicant's due process right to be heard on all grounds.

With regard to patent cases, the Federal Circuit hears Appeals typically from Federal courts and from the Board. Moreover, the Federal Circuit neither takes every Appeal submitted nor addresses every issue submitted. As such, a typical Appeal to the Federal Circuit is limited to just a few issues. Moreover, either through the Federal courts or through the Board, the likelihood that the record will be well-established is high. On the contrary, I can Appeal an application that has less than a couple of pages worth of argument from the Examiner on the record. Moreover, since rejections by the Examiner not traversed are deemed acquiesced to, then I am forced to Appeal every issue.

Depending upon the number of claims, the number of references, and the number of argued claims, and the number and type of rejections, the number of issues that can be addressed can easily exceed double digits and can be much, much higher. As such, the number of issues addressed before the Board can greatly exceed the number of issues ever addressed by the Federal Circuit in a given opinion. Moreover, if the Examiner has set forth a sparse record, I have to essentially create a record of factual findings in order to make my arguments, which is something that one preparing an Appeal Brief before the Federal Circuit rarely is required to do since the record is likely already well-established.

The comments in the Federal Register are unclear as to the particular need for certain of these requirements. For example, no facts have been set forth as to why a page limit of 25 pages (excluding certain sections) is needed for Appeal Briefs (or other filings). There have also been no facts set forth that the briefs being submitted by Applicants that are over long are unjustified.

What I find disconcerting is that even if facts were presented that suggested a page limit was needed, those facts would apply to the old format of Appeal Briefs. The requirements proposed by the rule package to Appeal Briefs are considerable and how these requirements (e.g., the statements of fact section, as well as changes to the other sections) will change how Appeal Briefs are written, and consequently how long they are, cannot be known. Thus, any limit set on the number of pages would be arbitrary. In this regard, I suggest that the limits for all of the filings either be removed completely or doubled until a better understanding as to how the eventual rule package, as promulgated, will change how Appeal Briefs (and other filings) are drafted.

I recognize that a petition can be filed to increase the length of the Appeal Brief. However, the rules are unclear under what basis the petition can be filed and how the petitions will be treated. For example, if the petitions will be granted as a matter of due course, then requiring a petition would be a waste of resources to administer the petition process. However, if there are some factors that are to be involved in determining the petition, these factors have not been described (see proposed § 41.3).

I am puzzled as to the need to require that the Appeal Brief be written in 14 point font. No documents, that I am aware of, produced by the USPTO are in 14 point font. In fact, I can also see two reasons to put a document in 14 point font. One reason could be to make the document easier to read. However, all other documents prepared by the USPTO and by Applicants are in a smaller font (typically 12 point) and the font of printed U.S. Patents is much smaller still. Moreover, since the USPTO uses electronic documents, if there was a need to make the document easier to read, then it is a quick adjustment to increase the size of the document on one's computer. The only other possible reason for 14 point font is to further decrease the amount of space available for argument. Again, the USPTO has not set forth any facts to support the need for less arguments in Appeal Briefs. On the contrary, based upon this rule package, the USPTO is requiring more information/argument from Applicants. As such, I am unclear as to the need for this.

Similarly, the need for double spacing and 14 point font for block quotes and footnotes also appears to be unjustified. Typically, both footnotes and block quotes are single spaced and at a smaller font (e.g., 10 point) since footnotes and block quotes are usually used to support an argument but not detract from the argument. As such, a smaller font size and single spacing achieves that goal.

The issued raise by these seemingly innocuous changes to the formatting of Appeal Briefs is that these changes will severely curtail Applicant's ability to set forth an argument before the board. These changes may not be an issue if only one or two issues are before the Board. However, if the Examiner digs in his or her heels and throws every rejection in the book at an Applicant, for whatever reason (justifiable or not), Applicant is required to address these rejections. However, if Applicant cannot fully address each rejection and a petition for increasing the page limit is denied (on some yet unknown basis), then Applicant's due process right to be heard has been compromised.

This issue also touches on another section that I do not think is justified and appears to be at odds with other sections. Specifically, it is stated that "[a]n appeal brief may not incorporate another paper by reference." In the comment section in the Federal Register, it is stated that one rationale for this is "to prevent an appellant from adding to the length of an appeal brief." The rules, however, are rife with requirements that Applicant cite to the Examiner's Office Action, the applied prior art, and even to Applicant's own responses to support an assertion that an argument was previously made to an Examiner's rejection. However, presumably incorporating, by reference, previous arguments appears to be prohibited.

As aside, I am also entirely unclear as to the need for an "Evidence Section," which presumably requires the submission of all the items listed. I recognize the need for a table of contents since a table of contents is useful to establish what documents need to be before the Board. However, all the evidence, which presumably has to be submitted with the Appeal Brief, has already been submitted to the USPTO. I do not presume to be an expert nor even remotely knowledgeable about the Paperwork Reduction Act beyond its name. However, I

cannot believe that essentially requiring Applicants to submit all this evidence again to the USPTO, when this evidence has already been submitted, would run not afoul of some section of that Act.

For example, I can imagine a non-technical savvy patent practitioner printing out copies of all these documents, sending the package through mail, then having the PTO scan and collate this entire package when all these documents were already in PAIR. In my mind, this requirement is unjustified, wasteful, and just simply a bad idea. An alternative suggestion would be to have documents filed in PAIR have an unchanging HTML address. In this manner, instead of submitting literally hundreds of pages of documents that need to be scanned and stored, a one or two page document that includes the HTML links to these documents could be filed instead.

In the paragraph spanning the second and third columns on page 41476 of the Federal Register, the following is written as to Rule 116 responses:

Where an argument has not previously been made to the examiner, an appellant would be required to say so in the appeal brief so that the examiner would know that the argument is new. An example where an argument might not previously have been made to an examiner might occur under the following fact scenario. A first office action rejects claims over Reference A. Applicant amends the claims to avoid Reference A. The examiner enters a final rejection now relying on References A and B. Applicant elects to appeal without filing a response under Rule 116. While applicants are encouraged to file a response under Rule 116 to possibly avoid an appeal all together, at the present time there is no requirement for an applicant to file a Rule 116 response. Whether such a requirement should be made in the future will be held in abeyance pending experience under the rules as proposed, should they ultimately be promulgated. The Board has found that many arguments made in an appeal brief were never earlier presented to the examiner even though they could have been presented (without filing a Rule 116 response).

My comments on Rule 116 responses are brief. Unless I place the claims in condition for allowance by amending allowable claims are amending claims to include allowable subject matter, I do not file Rule 116 responses. To be very blunt, I believe these types of responses are a waste of Applicant's time and money. The reasons for this is simple. My experience is that when faced with a Rule 116 response that does not unquestionably place the claims in condition for allowance, an Examiner will write "Applicant's remarks have been considered but are found not persuasive" in an Advisory Action. Applicant will either have to file an Appeal, with the same arguments, or file a RCE after typically paying an extension of time fee. In either instance,

prosecution has been delayed and Applicant will pay more money (either via the cost of the typical extension of time or from the unnecessary drafting of the Rule 116 response).

If an Examiner was required to set forth a more detailed explanation as to what "Applicant's remarks have been considered but are found not persuasive," then I believe such a response would provide more color to the record, which could possibly advance prosecution. In such an scenario, I would be more inclined to recommend filing Rule 116 responses. However, until then, I personally believe that these types of responses do not advance prosecution.

Along a similar vein, I noted the following comments made in the third column on page 41474 of the Federal Register with regard to the pre-appeal conference pilot program:

Proposed Bd.R. 41.37(d) would provide the time for filing an appeal brief is extendable under the provisions of Rule 136(a) for applications and Rule 550(c) for ex parte reexamination proceedings. Consideration was given to proposing a requirement for a petition to extend the time for filing an appeal brief. However, in view of the pre-appeal conference pilot program (see Official Gazette of July 12, 2005; <http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm>), and in an effort to encourage continued participation in that pilot program, further consideration on whether to require a petition will be deferred pending further experience by the Office in the pre-appeal conference pilot program.

When the pre-appeal conference pilot program was first introduced, I filed a substantial number of Requests to gauge the effectiveness of this procedure since my previous experience is that many of the prior Appeals I had written never made it past the appeal conference. My initial experience was mixed. However, over time, I found an increasing percentage of Requests I filed were returned with the box entitled "Proceed to Appeal" checked. Similar to the problem I believe is inherent with Rule 116 responses, I believe that for an overworked Examiner, it is too tempting to "check the box" and get this application off the Examiner's docket. As such, I have almost altogether abandoned this program.

As with Rule 116 Response, if the Examiner was required to set forth a more detailed explanation as to the Examiner's position, then I would take advantage more of this program. Moreover, I believe that the pre-appeal conference pilot program could be used as a vehicle for Applicant to request that the Examiner specifically identify within the prior art and set forth

claims constructions for certain claim terms at issue. As noted above, two of the major determining factors as to whether an Appeal is won or lost involve claim interpretation and findings of fact.

For example, during the Request, an Applicant could identify some set number of claim terms that Applicant desires a clarification on as to where this claim term is specifically disclosed in the prior art and the Examiner's claim construction as to that term. Naturally, these claims terms would likely be selected, by Applicant, on the basis that these terms are critical as to the determination of whether or not the Examiner has made a proper rejection. If a decision is made to "Proceed to Appeal," the Examiner's position as to these issues will be clearly set forth in the record.

Regarding § 41.52(f), what happens if the Board upholds a rejection, but on a grounds not originally presented by the Examiner? For example, the Board may present (i) a new claim construction that is different than that argued by the Applicant or the Examiner, (ii) identify a new teaching in the applied prior art to identically disclose a claimed feature, or (iii) set forth a new rationale to combine under 35 U.S.C. § 103, etc. These potential new findings by the Board do not appear to constitute a "New Rejection" per § 41.50(d)(2), and thus, would not fall under § 41.52(f)(1). Thus, Applicant would be precluded from rebutting (or even making an initial argument against) these new findings in the Request for Rehearing. In this instance, my suggestion is to clarify that a new rationale introduced by the Board in sustaining a rejection, and not just a new rejection, can be a basis for filing a Request for Rehearing.

In conclusion, like the USPTO, I understand that the Board will soon be flooded with new Appeals, and that a more efficient manner of disposing of these Appeals is desirable. However, I believe that other approaches can also be employed to not only make the process more efficient but also to reduce the number of Appeals being filed.

Respectfully submitted,

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