



FÉDÉRATION INTERNATIONALE DES CONSEILS EN PROPRIÉTÉ INDUSTRIELLE
THE UNITED STATES SECTION OF THE INTERNATIONAL FEDERATION OF INTELLECTUAL
PROPERTY ATTORNEYS

By email: BPAl.Rules@uspto.gov

14 January 2011

Mr. David J. KAPPOS
Under Secretary of Commerce for Intellectual
Property and Director of the
United States Patent & Trademark Office
Mail Stop Interference
Director of the United States Patent and Trademark
Office
P.O. Box 1450
Alexandria, VA 22313–1450

for the attention of Ms. Linda Horner, BPAl Rules

Re : FICPI Written Comments to USPTO new rules relating to ex parte appeals

Dear Mr. Kappos,

The comments contained in the present letter are respectfully submitted jointly by **FICPI** – the **International Federation of Intellectual Property Attorneys** – and by **FICPI-US** – the US national group of FICPI.

Established in 1906, **FICPI** is a Switzerland-based international and non-political association of approximately 5,000 intellectual property attorneys in private practice from over eighty countries, including the United States. See “About FICPI”, <http://www.ficpi.org/aboutframe.html> (follow “History-Future” hyperlink). FICPI’s members represent their clients in patent, trade mark and design matters, and related forms of IP, at the national, regional and international levels. Clients of FICPI members range from individuals and SMEs to multi-national industries, as well as universities, governmental and non-governmental organisations and other institutions, who are applicants and non-applicants alike. FICPI members have assisted in the drafting of IP laws and treaties. FICPI is therefore able to offer well balanced opinions with regard to newly proposed international, regional or national legislation or practice guidelines on the basis of a wide range of different levels of client knowledge, experience and business needs of the IP system. Because FICPI is largely comprised of patent practitioners representing foreign inventors and corporate entities, FICPI is poised to give the USPTO the perspective of the international patent community.

FICPI-US is comprised of US patent attorneys in private practice as the US national chapter of FICPI, affording US practitioners the vehicle to participate in FICPI’s international work, as well as to afford representation of the views of independent US practitioners domestically.

The comments set forth below have been drawn up jointly by members of FICPI in the United States as well as their colleagues drawn from the international patent community to afford an international

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1/5

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perspective on the proposals.

Thank you for taking the time to consider our comments to an Advanced Notice of Proposed Rulemaking with respect to practice before the Board of Patent Appeals and Interferences (Board) published in the Federal Register on November 15, 2010. We appreciate the opportunity to provide these comments and would like to thank you in advance for your careful consideration.

Summary

We applaud many of the changes in the Proposed Rules. Clearly, as stated in sections 1 and 2 below, many of the proposed changes will significantly reduce the burden on examiners and appellants while also reducing the chance of inadvertent surrender of patentable subject matter. We suggest a more general assumption for the party-in-interest as set forth in section 3 below. While the Board will no longer have independent authority to remand the application to the examiner, we suggest careful monitoring to ensure the Rule has the intended effect (i.e., reducing remands to the examiner) as set forth in section 4 below. Finally, we recommend deleting the summary of the invention section as set forth in section 5 below.

1. Elimination of certain sections from the Appeal Brief

We agree with the proposed elimination of certain sections of the Appeal Brief (Brief). Eliminating these unnecessary sections will likely simplify preparation and review of the Brief. Moreover, the percentage of Briefs rendered “non-compliant” will likely be reduced – thereby expediting prosecution of the applications.

a) Eliminating the “Status of the Claims” section

The Proposed Rules eliminate the requirement that the applicant set forth the status of the claims in a separate section. Rather, Proposed Bd.R. 41.37(c)(1)(iv) would simply require a statement identifying, by date of filing, the last entered amendment of the claims. We believe this change will reduce error in replicating information already found by referring to the current claim set. Eliminating this section will also reduce preparation time by appellants and time to review by the Office.

b) Eliminating the “Grounds of rejection to be reviewed on appeal” section

The Proposed Rules also removes the current required statement regarding grounds of rejection to be reviewed on appeal. Currently, the grounds of rejection simply restates the exact rejection set forth by the examiner in the Office action from which the appeal is taken. As such, removing this section is believed to reduce redundancy while also reducing the time to prepare and review the Brief.

c) Eliminating the “Claims Appendix” section

The Proposed Rules also removes the current required claims appendix section. Currently, this section simply rewrites that current claim set as they would appear if

allowed in current form without renumbering. Eliminating this section would reduce preparation time and review by the examiner and the likelihood that the Office render the Brief non-compliant. Moreover, the current claims can easily be reviewed by reference to the last entered amendment of the claims referenced by the new “Statement of last entered amendment” section. It is noted that last amendment of the claims can provide more information to the Board than the current clean set of claims. Indeed, the Board can easily review the language most recently added and therefore quickly understand the impact of certain claim language on the future scope of the claims.

d) Eliminating the “Evidence Appendix” and Related Proceedings Appendix sections

The Proposed Rules also removes the current required evidence appendix and related proceedings appendix sections. Elimination of these sections would reduce preparation time. Any evidence can be referred to in the body of the argument section and considered by the Board at that time. Moreover, elimination of the related proceedings appendix removes redundant information that would already be provided in the Statement Identifying related appeals and interferences.

2. Reduce unintentional loss of patentable subject matter

Further changes will also simplify the appeal process while reducing the chance of losing patentable subject matter. For example, we are in favor of Proposed Bd.R. 41.31(c) that states an appeal will be presumed to be automatically taken from the rejection of all of the claims. This change will avoid unintended cancellation of claims by the Office due to applicant error in listing the claims when filing the notice of appeal or appeal brief.

3. Real party-in-interest may be assumed

Proposed Bd.R. 41.37(c)(1)(i) sets forth that the real party-in-interest may be assumed if absent from the Brief. More particularly, if the statement of the real party in interest is omitted from the Brief, the proposed rules would allow the Board to assume the inventors are the real party in interest. However, applications are frequently assigned by one or more of the inventors to another individual and these assignments are typically recorded at the United States Patent and Trademark Office (USPTO). The presence of a recorded assignment suggests that the real party in interest may include the assignee. Recorded assignment information is readily available by searching the records at the USPTO. As such, if the real party in interest is omitted from the Brief, we propose that, absent a statement in the Brief to the contrary, the Board assume the real party in interest consists of one or more of the inventors of the application and/or the assignee of the application as recorded at the USPTO.

4. Board will no longer have independent authority to remand

Proposed B.R. 41.50(a) removes the independent authority of the Board to remand an application to an examiner. However, the application may be remanded to the examiner with approval by the Director. The Proposed Rule is intended to force the Board to decide the



appeal in the merits. However, it is unclear whether the Board will still attempt to send the application to the Director for such approval. In practice, the Director may be reluctant to block the request from the Board; thereby actually complicating the process of remanding the application to the Examiner. As such, if this Proposed Rule is implemented, we suggest careful monitoring whether the Rule has the intended effect (i.e., reducing remands to the examiner) and whether Directors are willing to block a remand request by the Board.

5. Summary of claimed subject matter limited to disputed limitations in the independent claims

Proposed Bd.R. 41.37(c)(1)(v) states that the summary of the claimed subject matter section only needs to annotate those limitations of independent claims that are in dispute. While seemingly simplified, it is believed that the Proposed Rule may result in frequent findings of a non-compliant Brief. Examiner may disagree which limitations are in dispute and may therefore object to those limitations not being annotated.

It is our opinion that the summary of the claimed subject matter section should be deleted. This section is believed to be duplicative of information the Board will consequently learn when studying the arguments section of the Brief. Moreover, in a later court proceeding, annotating claim limitations may act to unnecessarily limit the claims scope to only those sections referenced in the annotation. While the Office may desire the annotation to merely aid in the understanding of the claim limitation, the claim limitation should be construed based on the entire disclosure. Pointing the Office to only certain portions of the specification and drawings may be argued as misleading the Office since, arguably, all sections of the specification and drawings relevant to the understanding of the claim limitation are not referenced. Such exhaustive referencing of the limitation is unnecessarily burdensome to the applicant – the Board should arrive at an understanding of the scope of the claim limitation by review of the entire disclosure and prosecution history.

Conclusion

We are grateful to have the opportunity to comment on the Proposed Rules. Many of the changes (e.g., removing certain sections of the appeal brief as set forth in sections 1 and 2 above) are believed to reduce the burden for applicants to prepare the Brief and the burden of the examiners when reviewing the Brief. We suggest a more general assumption for the party-in-interest as set forth in section 3 above. While the Board will no longer have independent authority to remand the application to the examiner, we suggest careful monitoring to ensure the Rule has the intended effect (i.e., reducing remands to the examiner) as set forth in section 4 above. Finally, we recommend deleting the summary of the invention section as set forth in section 5 above.



We welcome the opportunity to discuss any of the provisions of this paper at any time. We again thank you for this opportunity.

Yours sincerely,

A handwritten signature in blue ink, appearing to read 'Julian Crump', is positioned to the left of the typed name.

Julian Crump
Secretary General of FICPI

A handwritten signature in blue ink, appearing to read 'John B. Hardaway III', is positioned to the right of the typed name.

John B. Hardaway III
President of FICPI-US

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