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**IIPSJ Comments on Rules of Practice Before the Board of Patent
Appeals and Interferences in Ex Parte Appeals**

I. Commentator Information

These comments are submitted by the Institute of Intellectual Property and Social Justice at the Howard University School of Law, by its Director, Prof. Lateef Mtima, its Associate Director, Prof. Steven D. Jamar, and its Chair of Institute Development and Advancement, Bryant L. Young, in response to the United States Patent and Trademark Office's Request for Comments on Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals, as published in the Federal Register, Vol. 75, No. 219, p. 69828-69849 Monday, November 15, 2010 (FR Doc. 2010-28493).

The Institute of Intellectual Property and Social Justice (IIPSJ) was founded in 2002 to address the social justice implications of intellectual property law and practice both domestically and globally. IIPSJ's work ranges broadly and includes scholarly examination of intellectual property law from the social justice perspective; advocacy for social-justice aware interpretation, application, and revision of intellectual property law; efforts to increase the diversity of the those who practice IP law; and programs to empower historically and currently disadvantaged and under-included groups to exploit IP effectively.

**II. Comments on Rules of Practice Before the Board of Patent Appeals and
Interferences in Ex Parte Appeals**

The importance of efficient patent practice before the United States Patent and Trademark Office (USPTO) cannot be overstated. In recent years, ex parte appeals have become an indispensable tool for patent practitioners. Thus, the USPTO has recently presented a new rules package for the appeals process, which aims to make the process a more streamlined and less complicated endeavor for appellants and examiners.

Specifically, the USPTO proposes to rescind the stayed 2008 final rule and change the 2004 final rule governing practice before the Board of Patent Appeals and Interferences (Board), in order "to simplify the appellate process in a manner that effects an overall lessening of the burden on appellants and examiners to present an appeal to the Board."¹ This should ease the burden on appellants and examiners in providing information, eliminate time gaps from briefing

¹ Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Proposed Rule, <http://edocket.access.gpo.gov/2010/pdf/2010-28493.pdf> (Nov. 15, 2010).

to jurisdiction of the Board, clarify appellate petitions practice, and reduce confusion as to the claims on appeal.²

Through the following comments, IIPSJ encourages the implementation of and compliance with the new changes to the rules of practice. These necessary changes simplify the appellate process, reduce appellate costs, and ease the burden on appellants and examiners.

These comments, corresponding numerically to the USPTO's proposed changes to the current rule (p. 69829), address topics pertaining to the social justice perspective.

1. *Proposed Bd.R. 41.31(c)*. Under this rule, “the Board would presume that an appeal is taken from the rejection of all claims under rejection unless cancelled by an amendment filed by appellant.”³ No longer will one need to affirmatively state which claims are on appeal, thus avoiding any unintended cancellation of claims.⁴ Thus, the proposed rule should provide an effective and more efficient means for filing appeals. Importantly, potential errors by appellants and any confusion with the examiner's and the Board's interpretation of the claims on appeal should be minimized. In turn, the costs of drafting an appeal brief and the burden of presenting an appeal should be reduced for appellants.

2. *Proposed Bd.R. 41.35(a)*. Under this rule, “the Board would take jurisdiction upon the filing of a reply brief or the expiration of time in which to file such a reply brief, whichever is earlier.”⁵ By comparison, the 2004 rule states “jurisdiction over the proceeding passes to the Board upon transmittal of the file, including all briefs and examiner's answers, to the Board,”⁶ while the 2008 rule states “jurisdiction of the Board begins when a docket notice is mailed by the Board.”⁷ The proposed rule reflects that the majority of patent application files are electronic files, as paper files are no longer transmitted or mailed to the Board.⁸ This change should help expedite the appellate process as files will be received almost as instantaneously as they are sent electronically.

3. *Proposed Bd.R. 41.37(c)*. Under this rule, “the requirements to include statements of the status of claims and grounds of rejection to be reviewed on appeal and the requirements to include a claims appendix would be eliminated from the appeal brief.”⁹ Thus, the proposed rule should decrease the burden on the appellant in drafting the appeal brief. In particular, the status of the claims and other information regarding an

² *Id.*

³ *Id.*

⁴ *Id.*

⁵ *Id.*

⁶ Rules of Practice Before the Board of Patent Appeals and Interferences; Final Rule, <http://www.uspto.gov/ip/boards/bpai/procedures/og/69fr49960.pdf> (Aug. 12, 2004).

⁷ Rules of Practice Before the Board of Patent Appeals and Interferences; Final Rule, <http://www.uspto.gov/web/offices/com/sol/notices/73fr32938.pdf> (June 10, 2008).

⁸ Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Proposed Rule, <http://edocket.access.gpo.gov/2010/pdf/2010-28493.pdf> (Nov. 15, 2010).

⁹ *Id.*

application on appeal are already available to the Board in the Image File Wrapper via the USPTO's website and intranet, which makes it unnecessary and inefficient to provide this easily accessible information to the Board.

4. *Proposed Bd.R. 41.37(c)(1)(i) and (ii)*. Under this rule, "the Board may apply default assumptions if a brief omits a statement of the real party-in-interest or a statement of related cases."¹⁰ If no statement of the real party-in-interest were provided, the named inventors would be considered the real party-in-interest.¹¹ If no statement of related cases were provided, it would be assumed that there are no such related cases.¹² The proposed rule, in accordance with both of these assumptions, should decrease the burden on the appellant in drafting the appeal brief, as the appellant should no longer have to provide as much information. This elimination of briefing requirements will most likely reduce the occurrence of non-compliant briefs, since missing or defective related appeals and interferences as well as missing or defective status of claims are principal reasons why appeal briefs are currently non-compliant.¹³

5. *Proposed Bd.R. 41.39(a)(2)*. Under this rule, "for purposes of the examiner's answer, any rejection that relies upon new evidence shall be designated as a new ground of rejection."¹⁴ The 2004 rule states "an examiner's answer may include a new ground of rejection"¹⁵, which is vague in comparison to the proposed rule. The proposed rule clarifies and expands this existing rule, making mandatory, instead of permissive, the issuance of a new ground of rejection, with new evidence being the new ground. In addition, the discussion of the proposed rule includes examples of what does and does not constitute a new ground of rejection.¹⁶ Some of the new grounds include "changing the statutory basis of rejection from § 102 to § 103", or vice versa, based on a different teaching.¹⁷ These examples provide sufficient guidance as to how the proposed rule can be implemented and help examiners to remain in compliance.

6. *Proposed Bd.R. 41.40*. Under this rule, "the appellant can await a decision on a petition seeking review of an examiner's failure to designate a rejection in the answer as a new ground of rejection prior to filing a reply brief and thereby avoid having to file a request for extension of time in which to file the reply brief."¹⁸ The proposed rule

¹⁰ *Id.*

¹¹ *Id.*

¹² *Id.*

¹³ Top Eight Reasons Appeal Briefs are Non-Compliant,

http://www.uspto.gov/ip/boards/bpai/procedures/top_8_reasons_appeal_brf_dec09.pdf (last visited Jan. 7, 2011).

¹⁴ Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Proposed Rule, <http://edocket.access.gpo.gov/2010/pdf/2010-28493.pdf> (Nov. 15, 2010).

¹⁵ Rules of Practice Before the Board of Patent Appeals and Interferences; Final Rule, <http://www.uspto.gov/ip/boards/bpai/procedures/og/69fr49960.pdf> (Aug. 12, 2004).

¹⁶ Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Proposed Rule, <http://edocket.access.gpo.gov/2010/pdf/2010-28493.pdf> (Nov. 15, 2010).

¹⁷ *Id.*

¹⁸ *Id.*

basically “tolls the time period for filing a reply brief.”¹⁹ This change should help minimize appellants’ costs in drafting reply briefs, as appellants should have a fuller appreciation as to what examiners expect and have adequate time to respond. In addition, it will help to minimize the burden on examiners in acting on time extension requests, as those requests should no longer be needed by appellants in this situation.

7. *Proposed Bd.R. 41.43.* Under this rule, “the examiner’s response to a reply brief would be eliminated.”²⁰ According to the 2004 rule, an examiner is required to acknowledge reply briefs and is allowed to file supplemental answers.²¹ The proposed rule should help expedite the appeal process as the burden on the examiner should be reduced. In particular, the most recent disposal rate for FY 2010, dividing cases disposed (7,133) by cases received (12,380), was approximately 57.6%, with 17,754 cases pending.²² The disposal rate for FY 2009 was approximately 43.9%, with 12,507 cases pending.²³ In effect, with the proposed rule change, this disposal rate should continue to increase as the examiner’s burden is reduced, thereby allocating the examiner more time to alleviate the current patent application backlog.

As reflected in our comments, we support the proposed new rules, since the changes are logical and most importantly, cost effective. In addition, these changes should result in the resolution of certain appeals before they reach the Board, and help foster timely decisions in remaining appeals.

We hope that the above comments are taken into consideration.

Respectfully submitted:

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¹⁹ *Id.*

²⁰ *Id.*

²¹ *Id.*

²² FY 2010 Process Production Report, <http://www.uspto.gov/ip/boards/bpai/stats/process/fy2010sepb.jsp> (last modified Oct. 6, 2010).

²³ *Id.*