

# SCIENCE & TECHNOLOGY LAW GROUP

INTELLECTUAL PROPERTY LAW PRACTICE

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December 19, 2009

Mail Stop Comments—Patents, Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Attn: Kenneth M. Schor and Pinchus M. Laufer.  
[patent\\_quality\\_comments@uspto.gov](mailto:patent_quality_comments@uspto.gov)

Re: Patent Quality: reducing pendency by eliminating unnecessary and wasteful process.

Dear USPTO,

Below are some easily-implemented, practical suggestions for reducing pendency by eliminating unnecessary and wasteful process.

## 1. Ensure same day Responses are correctly entered

With electronic notification of USPTO actions, it is now possible and not uncommon for Applicants to submit responses the same day an action is noticed. This is especially common with diligent applicants, us on the west coast, important cases, expected actions, and simple replies.

However, the USPTO docket system currently more often enters such same-day responses *prior*, and hence not responsive to, the action. Hence, the case is misdocketed as having a reply due, and not charged back to the Examiner. Typically, months are wasted before the error is recognized and the case correctly docketed to the Examiner.

I have attempted to address this problem by telephone, and was repeatedly told that the solution was to defer filing a response by at least one day. To me, that is a cop out. The USPTO should be encouraging, not preventing, promptness. Fix the system so that same-day responses are correctly docketed.

## 2. Eliminate Notice of Appeal

The Notice of Appeal serves no discernable purpose except for encouraging prosecution delay, extending patent terms and facilitating wasteful post-final submissions. It is an easy fix, e.g.:

§ 41.31 Appeal to Board.

(3) Every owner of a patent under *ex parte* reexamination filed under § 1.510 of this title on or after November 29, 1999, any of whose claims has been finally (§ 1.113 of this title) rejected, may appeal from the decision of the examiner to the Board by filing ~~a notice of appeal~~ an appeal brief pursuant to § 41.37 accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

§ 41.37 Appeal brief.

~~(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.~~

### **3. Automatically and instantaneously docket Appeals to Board when Reply Brief submitted.**

The prosecution delay from filing a Reply Brief to appeal docketing is about half a year, and sometimes over a year. After filing over 200 appeals, I have had only two where the Reply Brief was not entered without further ado, and the case forwarded to the Board. In 99% of my cases at least, the 6-12 month delay to Board docketing is just a waste of process, time and expense.

Instead, when an Applicant submits a Reply Brief, either (1) have it clerk-reviewed for form only and quickly (within a week) generate a combined entry/docketing notice; or (2) automatically/instantaneously generated an entry/docketing notice (as is currently done with petitions to make special because of age, or with assignment recordations).

### **4. Prohibit citations of new references in Examiner's Answers without designation of new ground of rejection.**

An applicant is not permitted to enter new evidence in an Appeal Brief nor a Reply Brief, and an Examiner should likewise not be permitted to enter new evidence in an Answer without designating a new ground of rejection.

It seems axiomatic that it is a denial of Due Process to deny applicants a full and fair opportunity to respond to new evidence, yet MPEP 1207.03 indicates just this possibility: in particular, justifying a new reference in an Answer where the evidence is offered to support a prior allegation as to what is "common knowledge."

This limited exception to the general rule ("A new prior art reference applied or cited for the first time in an examiner's answer generally will constitute a new ground of rejection") may not be offensive in principle, but in practice it is an invitation to abuse, and in my experience, is never used except to try to sneak in a new reference to bolster a defective rejection without reopening prosecution. Of course this can be remedied by time- and expense-consuming petitions or judicial recourse, but why bait Examiners with such a temptation? The USPTO would not tolerate a symmetrical rule that gave Applicants a similar right to introduce new evidence with their appeal or reply briefs. In my experience, the problems (administrative costs and delays) of this exception eclipse any perceived benefit it provides.

Sincerely,  
SCIENCE & TECHNOLOGY LAW GROUP  
Richard Aron Osman, JD, PhD