

The Honorable Jon W. Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office

Re: Comments on Proposed Rules: “Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals”
73 Fed. Reg. 145 (July 30, 2007)

Dear Under Secretary Dudas:

In view of an anticipated increase in appeals, and with the goal of resolving these appeals in a timely manner, the United States Patent and Trademark Office (PTO) has proposed changes to the current ex parte appeals process.¹ 3M Innovative Properties Company (“3M IPC”) supports this goal and appreciates the PTO’s efforts to address it.

In general, 3M IPC believes that patent prosecution could be improved if both the PTO and applicants had a better understanding of the issues facing each other throughout the process. The rule changes proposed by the PTO address this very issue in the context of ex parte appeals. As it has in the past, 3M IPC supports the PTO’s ongoing efforts to increase quality, efficiency, and speed of examination. As part of its support, 3M IPC offers the following comments and suggestions for further improving the prosecution process and ensuring that a clear record is prepared by both appellants and the PTO prior to and during the appeals process.

In view the following comments, 3M IPC urges the PTO to consider the following steps:

- (1) continue its practice of engaging the patent community in an interactive and cooperative effort to identify and address common concerns regarding pendency, communication, and patent quality;
- (2) ensure that the responsibility of establishing a complete and accurate record for the Board of Patent Appeals and Interferences is appropriately distributed between appellants and the PTO; and
- (3) provide adequate flexibility in the ex parte appeal rules to accommodate the broad range of prosecution records likely to be encountered.

¹ 72 Fed. Reg. 145 pp. 41472-41490 (July 30, 2007).

1. General Comments Regarding the Need for Flexibility in ex parte Appeals

The problems associated with the communications between applicants and examiners during prosecution were discussed at length in association with the new “Changes To Practice for Continued Examination Filings, Patent Applications Containing Patentably Distinct Claims, and Examination of Claims in Patent Applications.”² Although 3M IPC does not support all of the views set forth in these comments, Comment 53 lists concerns regarding the examiner’s role in providing a clear record for appeal.³ Comment 54 discusses advantages associated with the prior practice of using RCEs to fix the factual record for appeal.⁴

In response to these comments, the PTO stressed that the continued examination practice should not be used “as a substitute for the petition or appeal process.”⁵ The PTO also emphasized that if applicants disagree with the examiner, “applicants should file an appeal rather than filing a continuation application or a request for continued examination.”⁶

This advice is sound when the disagreements between the applicant and examiner are well-established; however, the recently adopted rules may result in less well-developed records. 3M IPC believes the ultimate rules regarding the ex parte appeals process should provide flexibility in view of such records.

2. Comments Regarding Specific Proposed Rules

Proposed Bd.R. 41.31(e)

Proposed Bd.R. 41.31(e) states “Failure to timely file a petition seeking review of a decision of an examiner related to a non-appealable issue may constitute a waiver to have that issue considered.” In the discussion of this rule, the PTO indicated that this waiver provision would be strictly enforced, and that withdrawal of a restriction requirement was an example of such a non-appealable issue.⁷

In 3M IPC’s experience, the withdrawal of a restriction requirement and rejoinder of claims often occurs after an ultimate resolution on the patentability of the elected claims. For example, when a restriction is made between a sub-combination and a combination, the ultimate allowance of the elected sub-combination claims often leads to withdrawal of the restriction requirement, and rejoinder and allowance of the combination claims.

In view of these and similar circumstances, 3M IPC requests clarification as to the scope of waiver encompassed within Proposed Bd.R. 41.31(e). In addition, 3M IPC does not support waiver of the non-appealable issue of withdrawal of a restriction requirement, even when that issue was not the subject of a petition prior to appeal.

² See, e.g., Changes to Practice, Final Rule 72 Fed. Reg. 151 at pp. 46717-46843. (August 21, 2007.)

³ Changes to Practice Final Rule 72 Fed. Reg. 151 at pp. 46762-63, Comment 53.

⁴ Changes to Practice Final Rule 72 Fed. Reg. 151 at pp. 46763, Comment 54.

⁵ Changes to Practice Final Rule 72 Fed. Reg. 151 at pp. 46763, Response to Comment 53.

⁶ Changes to Practice Final Rule 72 Fed. Reg. 151 at 46763, Response to Comment 54.

⁷ 72 Fed. Reg. 145 at. 41473.

Proposed Bd.R. 41.33(d)

“Some” or “All” rejections

Proposed Bd.R. 41.33(d) states that evidence may be entered after the filing of a notice of appeal but prior to the filing of an appeal brief “if the examiner determines that the evidence overcomes **some** or all rejections under appeal.”⁸ In contrast, the comments discussing this rule state “if the evidence does not overcome **all** rejections, the evidence would not be admitted.”⁹

3M IPC supports the plain language of Proposed Bd.R. 41.33(d), which allows an examiner to admit evidence even if it overcomes only some, but not all, of the rejections. 3M IPC requests clarification as to the scope of Proposed Bd.R. 41.33(d) in view of the conflict between the language of the rule, and the explanation of the rule.

Good Cause Standard

Proposed Bd.R. 41.33(d) requires appellants to show “good cause why the evidence was not presented earlier.” In the comments addressing this rule, the PTO stated that it would “strictly apply the good cause standard.”¹⁰

3M IPC notes that, if evidence is sufficient to overcome some or all rejections, the goal of efficiently handling appeals would be met if such evidence were admitted. Specifically, the admission of the evidence and elimination of the now-allowable claims would reduce the burden on the Board. In addition, the removal of such claims may eliminate entire issues from the appeal. In view of the practical limitations on submitting evidence during prosecution, 3M IPC supports a standard that maximizes the value that can be achieved by admitting evidence that eliminates claims and issues from the appeal.

Proposed Bd.R. 41.37

Proposed Bd.R. 41.37 sets forth new requirements for appellant’s appeal brief, in part to “add provisions which are expected to make the decision-making process more focused and efficient.”¹¹ In general, 3M IPC supports the new appeal brief format. However, 3M IPC urges the PTO to provide sufficient flexibility in the content of an appeal brief to account for the variety of prosecution records upon which appeals will be taken. In addition, 3M IPC supports similar requirements for the content of an examiner’s answer to ensure that both appellants and the PTO share responsibility for establishing a clear, consistent record.

Proposed Bd.R. 41.37(n)

A clear, concise and complete statement of the issues, as well as well-defined positions on these issues by both the appellant and the PTO, are beneficial. Also, where possible, it is desirable to require both parties to identify with some specificity where their positions are

⁸ 72 Fed. Reg. 145 at. 41485 (emphasis added).

⁹ 72 Fed. Reg. 145 at. 41473 (emphasis added).

¹⁰ 72 Fed. Reg. 145 at. 41473.

¹¹ 72 Fed. Reg. 145 at. 41474.

supported by the record. Toward this end, Proposed Bd.R. 41.37(n) creates a new requirement for appeal briefs entitled a “statement of facts.”

In view of the detail required by Proposed Bd.R. 41.37(o), including an explanation addressing all points made by the examiner with detailed citations to the record,¹² the purpose of the statement of facts required by Proposed Bd.R. 41.37(n) is unclear. 3M IPC asks whether the statement of facts is intended to contain only the undisputed facts, or whether it must or could include assertions made by either party in the course of prosecution that set forth the points in dispute?

For example, assuming there was a dispute over whether a particular reference taught a required claim element, which of the following statements of fact and citations to the record would be in compliance with Proposed Bd.R. 41.37(n)?

1. *The examiner asserted that Reference A teaches element B. App. page x, lines y-z.*
 - The fact that the examiner made the assertion is undisputed, but the underlying fact asserted is in dispute.
2. *Applicants argued that Reference A fails to teach element B. App. page k, lines m-n.*
 - The fact that the applicants made the argument is undisputed, but the underlying fact argued is in dispute.
3. *The examiner did not specify where Reference A teaches element B. App. pages w-z (e.g., a portion of the First Rejection) and pages y-z (e.g., a portion of the Final Rejection).*
 - The fact that the examiner did not point with specificity to the purported teaching of element B is undisputed.
 - Support for the absence of such specificity may require citation to multiple pages in multiple rejections.
4. *Reference A does not teach element B. App. pages x-y (all of Reference A).*
 - The issue of whether Reference A does or does not teach element B is in dispute.
 - Support for the absence of element B requires citation to Reference A in its entirety.
 - Applicant’s need to cite to Reference A in its entirety may be driven by the examiner’s citation to Reference A in general, without identifying where the reference teaches element B.

¹² 72 Fed. Reg. 145 at 41486 (Proposed Bd.R. 41.37(o).)

Proposed Bd.R. 41.37(v)(5)

Proposed Bd. R. 41.37(v)(5) sets a limit of 25 pages for an appeal brief, excluding certain sections. Appellants may request to exceed this page limit by filing a petition under Proposed Bd.R. 41.3. While page limits certainly contribute to a concise record, they are not always conducive to a clear and complete record.

3M IPC requests an explanation of the factors to be considered in granting a petition to exceed the page limit. Recommended factors include the number of rejections on appeal, the number of references cited by the examiner, and the number of claims independently argued. 3M IPC also recommends that petitions to exceed the page limit should be liberally granted until the PTO has gathered data on the length of typical appeal briefs needed to meet all of the requirements set forth in these proposed rules.

Proposed Bd.R. 41.39

Proposed Bd.R. 41.39 generally relates to, but does not set out any requirements for, the examiner's answer. According to the comments, "The specific requirements of what would be required in an examiner's answer would appear in the Manual of Patent Examining Procedure."¹³ In order to advance the goals of improved communication and timely processing of ex parte appeals, 3M IPC offers the following suggestions regarding the content of the examiner's answer. 3M IPC understands that these suggestions, if accepted, would appear the MPEP rather than in these rules.

First, like appellant's brief, the content of the examiner's answer should further the goals of making the decision-making process more focused and efficient, and providing a clear, concise and complete statement of relevant facts on dispositive issues. Thus, the examiner's answer should address each statement of fact contained in the appellant's appeal brief. For any statement traversed by the examiner, the basis for disagreement should be stated including specific citations to the record applying the same requirements ultimately imposed upon appellants in setting forth its statements of fact. In addition, these requirements should apply to any new statements of fact in the examiner's answer.

Second, the examiner's arguments should follow a format substantially similar to that required of appellants in Proposed Bd.R. 41.37(o). Specifically, the examiner's answer should identify each point made by the appellant in the appeal brief and respond accordingly, with appropriate citations to the record. Also, the examiner's answer should identify which arguments being presented were previously made (with appropriate citations to the record) and which arguments are being presented for the first time in the examiner's answer. As discussed by the PTO with respect to the appeal brief, such documentation aids in drawing appropriate attention to new issues. As noted by the PTO, such requirements "efficiently frame any dispute between the appellant and the examiner."¹⁴

¹³ 72 Fed. Reg. 145 at 41479 (Discussion of Proposed Bd.R. 41.39(a).)

¹⁴ 72 Fed. Reg. 145 at 41479 (Discussion of Proposed Bd.R. 41.37(o).)

Third, the PTO should provide a procedure for reviewing the sufficiency of the examiner's answer. In particular, an examiner's answer that fails to provide specific support for an assertion, or which fails to respond to particular arguments on dispositive issues that have been properly presented in the appeal brief should be returned to the examiner for compliance.

Proposed Bd.R. 41.41(f)

Proposed Bd.R. 41.41 sets forth the required contents and format of appellant's reply brief. Proposed Bd. R. 41.41(f) specifically refers to a statement of additional facts. In view of the apparent conflict between the text of the rule and the comments regarding the rule, 3M IPC requests clarification of the scope of additional facts allowed under this rule.

Proposed Bd. R. 41.41(f)

Statement of additional facts. The "statement of additional facts" shall consist of a statement of the additional facts that appellant believes are necessary to address the points raised in the examiner's answer and, as to each fact, must identify the point raised in the examiner's answer to which the fact relates.¹⁵

PTO Comments Regarding Proposed Bd. R. 41.41(f)

Proposed BD.R. 41.41(f) would require a statement of additional facts, but only when the appellant has elected to file a reply brief in response to a new rejection in an examiner's answer entered pursuant to Proposed Bd.R. 41.39(b)(2) ... If there is no new rejection in the examiner's answer, there would be no statement of additional facts.¹⁶

As written, Proposed Bd. R. 41.41(f) provides appellants some flexibility to present additional facts they believe are necessary. Appellant's ability to present additional facts is limited by the requirement that these facts address only points raised in the examiner's answer. This limitation is reinforced by requiring appellant's to identify the point raised in the examiner's answer to which the additional fact relates. 3M IPC would support Proposed Bd. R. 41.41(f) under such an interpretation. However, the comments regarding this rule suggest a far more restrictive approach to additional facts.

3M IPC requests the PTO to clarify whether a statement of additional facts is required in all reply briefs, or only in reply briefs filed in response to an examiner's answer containing a new rejection. 3M IPC also requests the PTO to clarify whether an appellant will be permitted to file a statement of additional facts that appellant believes are necessary to address the points raised in the examiner's answer, absent a new rejection.

¹⁵ 72 Fed. Reg. 145 at 41488 (Proposed Bd.R. 41.41(f).)

¹⁶ 72 Fed. Reg. 145 at 41480 (Comments regarding Proposed Bd.R. 41.41(f).)

Proposed Bd.R. 41.50 (f) and (g)

Proposed Bd.R. 41.50(f) authorizes the Board to enter an order requiring the appellant to brief matters or supply information or both that the board believes would assist in deciding the appeal.¹⁷ As clearly indicated in both Proposed Bd.R. 41.50(f) and (g), this time period is non-extendable, with failure to respond within the time period resulting in the possible dismissal of the appeal in whole or in part.¹⁸

3M IPC appreciates the PTO's need both to request additional information and to complete appeals in a timely and efficient manner. However, neither 3M IPC nor the PTO can foresee all of the circumstances under which appellant's may be unable to reply in the time set by the Board. Therefore, 3M IPC believes that an extension of time to comply with a request under Proposed Bd.R. 41.50(f) should be available under specific circumstances. Such petitions could be included in those authorized under Proposed Bd.R. 41.3, or may include restrictions similar to those contained in Rule 1.136(b). In either case, 3M IPC does not support a rule which could result in dismissal of an appeal based on an appellant's justifiable inability to meet a deadline set by the PTO, particularly where, as here, neither party may appreciate the full scope of appellant's burden in responding to the Board's request for further information.

Summary

3M IPC supports the PTO's ongoing efforts to improve the patent prosecution process, including these proposed changes to the ex parte appeals process. As part of our ongoing commitment to working with the PTO to address our common concerns while optimizing the intellectual property rights of our clients, 3M IPC thanks the PTO for considering our comments and suggestions. As always, 3M IPC would welcome additional opportunities to address the issues impacted by the proposed rule changes.

Sincerely,



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¹⁷ 72 Fed. Reg. 145 at 41489 (Proposed Bd.R. 41.50(f).)

¹⁸ 72 Fed. Reg. 145 at 41489 (Proposed Bd.R. 41.50 (f) and (g).)