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September 28, 2007

The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Mail Stop Comments
P.O. Box 1450
Alexandria, VA 22313-1450

Sent Via E-mail to: BPAI.Rules@USPTO.gov

RE: Ex Parte Appeals

Sir:

The following comments are submitted in response to the United States Patent and Trademark Office proposed rules directed to changes in practice before the Board of Patent Appeals and Interferences in *Ex Parte Appeals* that were published on July 30, 2007.¹

I am a partner in the intellectual property law firm of Birch, Stewart, Kolasch & Birch, LLP. For the last three years the firm has been ranked 3rd or 4th in the nation in terms of the number of patents granted for our clients.² That is relevant here because it means that the attorneys in the firm are extremely experienced with prosecution before the USPTO. I personally have 25 years of experience as a patent agent/patent attorney during which time I have been involved in the prosecution of thousands of applications, including appeals particularly in the chemical, pharmaceutical and biotechnology fields. The following comments, therefore, are based on a large amount of experience with precisely the issues addressed by the proposed new rules. These comments should be considered my personal comments, and not those of the firm.

1. Summary of Comments

The main concern with the proposed rules is that they place a vastly increased burden on Appellants, without any apparent gain in efficiency on the part of the USPTO. Instead, the proposals seem to be a classic case of "exalting form over substance".

2. Comments on Proposed Rule 41.37(n) – Statement of Facts

The requirements for a statement of facts will place a greatly increased burden on every Appellant. The proposal will require Appellants to provide a long and detailed list of every fact necessary to support the Appellant's position. That listing will further be required to include a reference to a specific page number and, where applicable, a specific line or drawing numerals of

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

² Source – Intellectual Property Today

reference to a specific page number and, where applicable, a specific line or drawing numerals of the record. This requirement is apparently without limit and without definition, meaning that Appellants would be required to list all possible facts required to support Appellant's position, even facts that are not in dispute. Many appeals can essentially be narrowed down to a few numbers of contested legal issues and/or a few number of contested issues of fact. There seems to be no good reason to burden Appellants with a new requirement that could easily double the cost of any appeal.

Interferences are now characterized by a requirement for opposing parties to submit a statement of facts. This requirement makes sense in an *inter partes* format because it permits the reviewing panel to identify the facts which are in agreement between the parties as compared to the facts which are in dispute. This can enable the reviewing panel to focus attention on only those issues and facts that are in dispute, thereby adding efficiency to the process.

But in *ex parte* appeals, no comparable burden is being placed on the Examiner to establish the USPTO's statement of facts. So requiring Appellants to provide a statement of facts will not at all aide the board in understanding the specific facts that are in dispute. Rather, placing such a burden on only the Appellant seems designed to simply lay a trap for the unwary, namely provide a basis for the board to reject an appeal because the Appellant failed to list some fact which the board considers necessary to support Appellant's position, even if that fact has never been in dispute and even if the fact is actually established by the record. Such a process clearly exalts form over substance, and is not truly designed to improve the appeal process.

3. Comments on Proposed Rule 41.37(q) – Claim Support Section

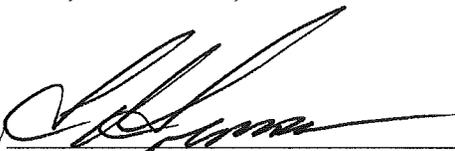
The new proposal for a "claim support section" is another example of placing a significant increased burden on every Appellant, without any apparent good reason. The proposal requires, for each claim argued separately, an appendix that consists of "an annotated copy of the claim" indicating the page and line where the limitation is described in the specification as filed. The requirement is not limited to claims that have been rejected for reasons under 35 U.S.C. 112. A requirement limited to those claims that involve an issue of support in the specification would make sense. But the proposed rule would relate to any claims argued separately on appeal, whether those claims have ever been rejected for reasons relating to section 112. This also will create a substantial new burden on Appellants and it is not seen why such a new burden is necessary or will improve the appeal process.

4. Conclusion

For the above reasons, the proposals relating to a "statement of facts" and a "claim section" in appeal briefs should be deleted, or narrowly tailored to focus on issues that are actually contested on appeal.

Respectfully submitted,

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By 
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