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February 10, 2011

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

Attn: Linda Horner, BPAI Rules

Re: *Comments on Rules of Practice Before the Board of Patent Appeals  
and Interferences in Ex Parte Appeals*, 75 Fed. Reg. 69828  
(November 15, 2010).

Dear Under Secretary Kappos:

On behalf of the American Bar Association Section of Intellectual Property Law (the “Section”), I am writing to provide our comments in response to the request the United States Patent and Trademark Office (the “Office”) published in the Federal Register on November 15, 2010 (PTO-P-2009-0021). In particular, the Section submits the following comments on the *Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals*, 75 Fed. Reg. 69828 (the “Proposed BPAI Rules”). These comments have not been approved by the American Bar Association’s House of Delegates or Board of Governors and should not be considered to be views of the American Bar Association.

The Section is generally supportive of several aspects of the Proposed BPAI Rules. In particular, the Section supports:

- (1) proposed Bd.R. 41.12, or a similar rule, to the extent the citation requirements are minimized or eliminated;
- (2) proposed Bd.R. 41.35(a), or a similar rule, to the extent the delay in any Board jurisdictional requirements is reduced;
- (3) proposed Bd.R. 41.35(d), or a similar rule, to the extent information disclosure statements and petitions filed with the Board are held in abeyance while the Board maintains jurisdiction over the appeal;
- (4) proposed Bd.R. 41.37, or a similar rule, to the extent certain unnecessary procedural requirements and statements required for submitting a compliant appeal brief are reduced or eliminated;

- (5) proposed Bd.R. 41.43, or a similar rule, to the extent certain unnecessary procedural requirements of the examiner are reduced or eliminated;
- (6) proposed Bd.R. 41.39(a)(2), or a similar rule, to the extent that it makes more clear when a new ground of rejection is being made in an examiner's answer;
- (7) proposed Bd.R. 41.40, or a similar rule, to the extent that it does not interfere with the special dispatch under which ex parte reexaminations are otherwise conducted; and
- (8) proposed Bd.R. 41.37(c)(1)(v), or a similar rule, to the extent that it is clear that appellant makes no waiver of arguments, estoppel or disclaimer with respect to any unmapped claim elements.

The Section nevertheless cautions the Office to carefully review certain rules so as to avoid unintended consequences. Specifically, the Section is concerned that mapping only certain claim limitations in compliance with proposed Bd.R. 41.37(c)(1)(v) would amount to an implied or explicit admission or waiver regarding the unmapped elements. The Section is also concerned that proposed Bd.R. 41.40 may be used by patent owners to intentionally delay ex parte reexamination proceedings.

In addition, the Section is currently reviewing parts of the proposed rules that would eliminate the Board's authority, absent the Director's approval, to remand an application to the examiner. The Section may comment on this aspect of the Proposed BPAI Rules at a future date.

### **I. Proposed BPAI Rules that the Section Supports**

The Section recognizes and fully supports the purposes set forth in the Proposed BPAI Rules of avoiding undue burden on appellants or examiners to provide information from the record to the Board, eliminating any gap in time from the end of briefing to the commencement of the Board's jurisdiction, and clarifying and simplifying petition practice in appeals. Proposed Board Rules 41.12, 41.35(a), 41.35(d), 41.37 and 41.43 all support one important goal of both the Office and the appellants, which is to simplify and expedite the appeal process and reduce or eliminate certain unnecessary requirements (or burdens) that lead to a delayed Board decision. By reducing the burden on both appellants and the examiner, and by clarifying and simplifying certain procedural and practice requirements, the focus will shift from the procedural aspects of the appeal process to the substantive considerations surrounding the appeal itself. This should not only reduce the pendency of an appeal, but lead to a concise and efficient appeal process. Further, this will provide the appellant, the examiner, and the Board with more time to focus on the substance of the appeal, and reduce the possibility that the appeal process will be further delayed through accidental non-compliance with all of the procedural and practice minutiae of the current Rules. In addition, by expediting the Board's jurisdiction in the appeal process and removing unnecessary procedural hurdles, the overall appeal process will be shortened, which is a benefit to both the Office and the appellant. Still further, by clarifying and simplifying the petition practice during the appeal, the Board can focus its attention to resolving the appeal in a fair and expeditious manner.

The Section also supports Proposed Bd.R. 41.39(a)(2) and appreciates the efforts of the Office to provide greater clarity during the appeal process. Proposed Bd.R. 41.39(a)(2) provides that an examiner's answer may include a new ground of rejection and further states

that “for purposes of the examiner’s answer, any rejection that relies upon any new evidence not relied upon in the Office action ... shall be designated by the primary examiner as a new ground of rejection.” This addition to the rule helps clarify when a new ground of rejection is being made in an examiner’s answer. Providing more clarity is favorable for both the Office and applicants because it reduces the likelihood of an error being made and thus reduces the time and expense needed for an applicant to petition the Office to challenge an improper lack of designation of a new ground for rejection. The discussion in the Notice providing examples is particularly helpful in this regard.

## **II. Proposed BPAI Rules that the Section Recommends that the Office Should Carefully Review.**

The Section recognizes the efforts of the Office to address concerns raised in the comments in response to their 2009 proposed Bd.R. 41.37(c)(1)(v). Generally, the public comments expressed concerns that the proposed requirement to map every claim element would unnecessarily create or imply a waiver of arguments or unnecessary estoppel or disclaimers. Practitioners expressed concerns that these, arguably, unnecessary waivers, estoppels or disclaimers could lead to increased malpractice allegations. The Office responded to the comments with the new proposed Bd.R. 41.37(c)(1)(v). However, the proposed Bd.R. 41.37(c)(1)(v) states that only claims actually in dispute must be mapped. Several members of the Section have expressed their concern that proposed Bd.R. 41.37(c)(1)(v) does not clarify that the mapped claim elements are in no way an implied or explicit admission or waiver regarding the unmapped elements. Therefore, although the Section generally supports Bd.R. 41.37(c)(1)(v) in principle, we believe the rule should go further to clarify that appellant makes no waiver of arguments, estoppels or disclaimer with respect to unmapped claim elements.

Proposed new Bd.R. 41.40 delineates the process by which an appellant can seek review of the primary examiner’s failure to designate a rejection as a new ground of rejection should appellant feel that the examiner’s answer contains a new ground of rejection that has not been designated as such. As part of this procedure, “[t]he proposed rule also now tolls the time period for filing a reply brief, so appellants can avoid the cost of preparing and filing a reply brief prior to the petition being decided, and can avoid the cost altogether if the petition is granted and prosecution is reopened.” 75 Fed. Reg. 69840 (November 15, 2010). The Section recognizes the efforts of the Office to afford appellants due process by granting a fair opportunity to respond to all aspects of a rejection prior to appeal.

However, the Section cautions the Office that such a rule may have unintended consequences on ex parte reexaminations and may be inconsistent with current statutory requirements under 35 U.S.C. § 305 that all reexamination proceedings, including any appeal to the Board of Patent Appeals and Interferences, be conducted with special dispatch within the Office. In particular, several members of the Section have expressed their concerns that, in some cases, patent owners may use the proposed petition procedure as delay tactic that frustrates the requirement. Accordingly, the Section generally proposed Bd.R. 41.40 to the extent that it does not interfere with the special dispatch under which ex parte reexaminations are otherwise conducted

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In closing, the Section appreciates the Office asking for input on the proposed new changes to the current rules governing practice before the Board of Patent Appeals and Interferences.

If you have any questions or wish for us to provide further explanation of any of our comments, please feel free to contact me. Either I or another member of the leadership of the Section will respond to your inquiry.

Very truly yours,

A handwritten signature in black ink, appearing to read "Marylee Jenkins", with a long horizontal line extending to the right.

Marylee Jenkins  
Section Chairperson  
American Bar Association  
Section of Intellectual Property Law