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By Email Nicholas\_A.\_Fraser@omb.eop.gov

Mr. Nicholas A. Fraser  
Desk Officer for Patent and Trademark Office  
Office of Information and Regulatory Affairs  
Office of Management and Budget  
725 17th St. NW  
Washington DC 20503

Re: Information Collection Request, Comment Request 0651-00xx, 73 Fed. Reg.  
58943 (Oct. 8 2008)

Letter 3: Falsified certifications of economic effect and burden

Dear Mr. Fraser:

This is my third of several letters on Information Collection Request 0651-00xx ICR. This letter addresses the PTO's pattern of obviously falsified certifications.

In the preamble to the 2007 proposed rule,<sup>1</sup> the PTO certified to OMB and the Small Business Administration Office of Advocacy that the rule would have negligible economic effects and no new paperwork burdens (72 Fed. Reg. at 41483 col. 3 to 41484, col. 2):

**Regulatory Flexibility Act**

...

Accordingly, these proposed rules do  
not have significant economic impact on  
a substantial number of small entities.

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<sup>1</sup> RIN 0651-AC12, Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals, 73 Fed. Reg. 32938 (Jun. 10, 2008).

### **Executive Order 12866**

This rule making has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

### **Paperwork Reduction Act**

This proposed rule involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collection of information involved in this proposed rule has been reviewed and previously approved by OMB under control number 0651-0031. The United States Patent and Trademark Office is not resubmitting an information collection package to OMB for its review and approval because the changes in this proposed rule would not affect the information collection requirements associated with the information collection under OMB control number 0651-0031.

Yet, on the very same page, the PTO provided a catalog of changes in the proposed rule. Here is an excerpt from the list, focusing only on those elements that add new paperwork burdens (72 Fed. Reg. at 41483, col. 2-3). Note that this list does not include changes that have non-paperwork economic effects (e.g., changes in the burden of proof to the disadvantage of applicants with meritorious claims, the loss of patent property rights abandoned simply because the procedures are too expensive, and businesses that cannot be formed because of the reduced availability of patent protection):

The notable changes in the proposed rules are: (1) Providing additional delegated authority from the Director to the Chief Administrative Patent Judge to decide certain petitions authorized by Part 41 as proposed, including requests for extension of time to file certain papers after the appeal brief and requests to enlarge the page limit on certain appeal papers; (2) defining the record on appeal to clarify what documents the Board will consider in resolving the appeal; (3) requiring the notice of appeal to be signed; (4) providing a definition of non-appealable issues; (5) transferring jurisdiction of an appeal to the Board upon entry of a docket notice by the Board; (6) relinquishing the Board's jurisdiction in an appeal when the Board orders a remand or enters a final decision and judicial review is sought or the time for seeking judicial review expires; (7) changing the format and content of the appeal brief to require the following additional sections: (a) Jurisdictional statement, (b) table of contents, (c) table of authorities, and (d) statement of facts; (8) changing the format and content of the appeal brief appendix to include the following additional sections: (a) claim support section, (b) drawing analysis section, (c) means or step plus function analysis section, and (d) an expanded evidence section to include, inter alia, relevant Office action(s) and portions of papers filed by appellant during prosecution; (9) providing page limits for all briefs; (10) prohibiting incorporation by reference in briefs; (11) establishing a format for a reply brief to include: (a) Table of contents, (b) table of authorities, (c) statement of timeliness, (d) statement of facts in response to a new ground of rejection in examiner's answer, (e) argument, and where appropriate, (f) supplemental appendix; (12) providing for a supplemental reply brief, if a supplemental examiner's answer is furnished by the examiner; (13) establishing a format for a supplemental reply brief to include: (a) Table of contents, (b) table of authorities, (c) statement of timeliness, and (d) argument; (14) requiring appellant to supply a list of technical terms and other unusual words at the time of confirmation of the oral hearing to aid in transcription at the oral hearing; (15)

(16) establishing a format for a request for rehearing to include: (a) Table of contents, (b) table of authorities, (c) statement of timeliness, and (d) argument; and (17) providing sanctions to be imposed on the appellant for misconduct during prosecution of the appeal.

It is inconceivable that anyone – whether a patent attorney, a PTO Commissioner, the PTO’s § 1320.7 “Senior Official” responsible for making submissions to OMB, or an OMB Desk Officer – could look at this list of “new,” “additional,” “expanded” and newly “established” requirements and seriously believe that there is no new burden.

Then, in the preamble to the 2008 Final Rule, the PTO again stated to OMB, and certified to SBA-Advocacy, that the rule would have negligible economic effects and no new paperwork burdens (73 Fed. Reg. 32969 col. 1 and 32972 col. 2):

*Regulatory Flexibility Act*

The Deputy General Counsel for General Law of the United States Patent and Trademark Office certifies to the Chief Counsel for Advocacy of the Small Business Administration that this final rulemaking, Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals (RIN 0651–AC12), will not have a significant economic impact on a substantial number of small entities. *See* 5 U.S.C. 605(b).

*Executive Order 12866*

This rulemaking has been determined to be not significant for the purpose of Executive Order 12866 (Sept. 30, 1993).

In contrast, in the preamble, the PTO lists some of these changes (73 Fed. Reg. 32969, col. 2):

The primary changes in this rule are:  
(1) The requirements for an appeal brief include new sections for jurisdictional statement, table of contents, table of authorities, statement of facts, new format for arguments in the appeal brief and for claim support and drawing analysis section and means or step plus function analysis section in the appendix of the appeal brief, new section for table of contents in the evidence section of the appendix, new format in 14-point font, and 30-page limit for the grounds of rejection, statement of facts, and argument sections, (2) the requirements for a reply brief include new sections for table of contents, table of authorities, statement of additional facts, new format for arguments in the reply brief, new format in 14-point font, and 20-page limit for the statement of additional facts and argument sections, (3) the requirements for a request for rehearing include new sections for table of contents, table of authorities, new format for arguments in the request for rehearing, new format in 14-point font, and 10-page limit for the argument section, (4) new grounds of rejection are no longer permitted in an examiner's answer, (5) the examiner's response to a reply brief is eliminated, (6) petitions to exceed the page limit for an appeal brief, reply brief or request for rehearing are made under Rule 41.3 which requires a \$400 fee, (7) petitions for an extension of time to file a reply brief, request for oral hearing, or request for rehearing are made under Rule 41.3 which requires a \$400 fee, and (8) a list of technical terms or unusual words to be provided to the transcriber at the oral hearing. The rules described in (1)

Again, no person with the slightest experience with patent law, or regulatory policy of any form, could possibly believe that this list involves no new paperwork burdens.

Further, it is astoundingly naïve to believe that changes like these would have no material economic effects.

Anyone who also read the so-called “60-day notice” the PTO published on June 9, 2008<sup>2</sup> would know that the certifications in the June 10 notice were obviously and knowingly false. The “60-day notice” admitted to paperwork burdens exceeding \$250 million per year. The PTO has never had to publicly explain how it is that \$250 million in annual paperwork burden is the same as “no burden,” or how \$250 million in annual paperwork burden is “not significant” for purposes of Executive Order 12,866.

With all due respect, one can only conclude that PTO purposefully deceived OMB about the contents of this rule. The primary means of the deception was PTO’s assurance to OMB that the rule was a minor administrative exercise, and thus it deserved no OMB oversight. The question posed by ICR 0651-00xx is whether OMB will reward the PTO for its deceitful conduct or hold it accountable in accordance with its longstanding statutory authority under the Paperwork Reduction Act.

Sincerely,

/s/ David E. Boundy

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<sup>2</sup> Board of Patent Appeals and Interferences Actions, New collection; comment request, 72 Fed. Reg. 32559 (June 9, 2008).