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VIA E-MAIL

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Mr. Nicholas A. Fraser  
Desk Officer for Patent  
And Trademark Office  
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Re: Information Collection Request  
Comment request 0651-00xx  
73 Fed. Reg. 58943 (Oct. 8, 2008)

Dear Mr. Fraser:

I am writing to comment on the Patent and Trademark Office's appeal rule and the paperwork implications of that rule.

I am a patent attorney with 28 years experience, including more than 50 appeals. Prior to becoming a patent attorney, I worked at the U.S. Patent and Trademark Office for eight years as an examiner. When I left in 1980, I was a Primary Examiner.

Recently, as an experiment, I wrote an Appeal Brief which conformed to the new rules propounded by the U.S. Patent and Trademark Office. I found the new rules to be extremely burdensome. Much of this was due to having to review the file history of the application to ascertain at what point in time certain arguments were made to the Examiner. In the past, I could have written the same brief in about two-thirds that time.

The new appeal brief rules require appellants to provide a jurisdictional statement, a table of contents, and a table of authorities and cases - all of which are unnecessary in my opinion. For my entire career, I have written appeal briefs without a jurisdictional statement (somehow the Board of Appeals knew that it had jurisdiction over appeals from the Examining Corps.), without a table of contents (which is duplicative of the required headings), and without a table of authorities. Further, the new rules require that appellants provide a marked up copy of the claims with reference numerals and annotations to the written description and the drawings, for all claim limitations, even those that are totally irrelevant to the appeal. In my opinion, this too is unnecessary. This information can be easily ascertained by merely reading the specification of the case on appeal (something which I hope the Board of Appeals is doing).

I find the new appeal rules to be onerous and unnecessary. It is not unusual to receive final rejections containing multiple rejections of the same claims. Some examiner's final rejections have run 30 to 40 pages and contained as many as 5 or 6 different grounds of rejection for the same claim. The new rules have now set a page limit of 30 pages for the grounds of rejection, statement of facts, and arguments section. The new rules requires that briefs be double spaced and use 14-point font, including block quotations and footnotes. The combination of a small page limit and large font size will sharply cut into my ability to make the arguments I need to make in order to respond to 30 - 40 page examiner's papers, and increase the burden of preparing a brief.

If one wants to exceed 30 pages, double spaced, 14 point font, to properly argue all of the rejections, one must file a petition at least ten days prior to the date the appeal brief is due. In the past, there were no page limits and thus, no need to file such a petition. While the filing of petitions will be a windfall to the Patent and Trademark Office since it collects fees with each petition, it will severely increase the paperwork and expense involved with an appeal.

Still further, the new rules for the first time require that appellants identify where an argument was made in the first instance to the examiner or state that the argument has not previously been made to the Examiner. This information has no relevance to the outcome of an appeal, but is extraordinarily burdensome to collect.

Still further, the new rules say that any conclusion reached by the Examiner that is not challenged will be presumed to be correct. Challenging every error by the examiner will be very burdensome and is clearly designed to eat into the 30 page limit and thus force the

filing of a petition. A well-focused brief focuses on one or two errors that result in reversal - requiring a full catalog of every error is both burdensome and forces "clutter" into a brief that will reduce its usefulness to the Board. Still further, this rule will greatly increase the amount of time required to write an appeal brief and thus, increase the costs to the client.

On this point, our firm does a lot of work for foreign firms. The instructions which we receive for responding to an office action are not always comprehensive. While there may be arguments I would like to present, clients do not always authorize them during the prosecution phase. It is not unusual for more comprehensive arguments to be presented in an appeal brief. Given the new rules, I am compelled to go back to the client and tell them that we need to file a more comprehensive set of arguments during the prosecution phase. This is going to add significant cost to the clients.

The Patent and Trademark Office's enforcement of current appeal rules is totally arbitrary and capricious. On numerous occasions, I have had appeal briefs ruled non-compliant by the Examiner because the arguments did not parallel the way the rejections were presented in the final rejection or because of some minor transgression of form over substance, such as failing to place reference numerals in the summary of the invention for claim elements totally irrelevant to the appeal or failing to mention all claims which were cancelled and not on appeal. I expect the enforcement situation to be equally as bad, or even worse, under the new appeal rules, particularly since the proposed rules have many more pointless "technicalities" than the old rules.

A good example of what has occurred with regard to appeal briefs can be seen in the prosecution history of U.S. Patent No. 7,413,149. During the prosecution of the application which led to this patent, I had to file three appeal briefs. After the first appeal brief, the Examiner acknowledged that his position was wrong and the appeal did not go forward, but the examiner raised new rejections the application for totally new reasons. I filed a second appeal brief. That one was refused for the form-over-substance reasons that exist in no rule that I mentioned in the previous paragraph. After I filed a third appeal brief, the examiner again acknowledged that his position was wrong, and allowed the application. As you can see, two of the appeal briefs arose out of examiner error and one because of excessively zealous enforcement of unwritten rules by the clerical staff.

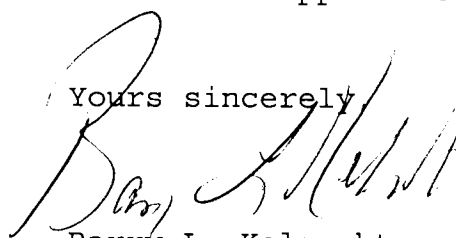
In pending U.S. patent application serial no 10/687,228, I took an appeal to the Board of Appeals and won. Following the decision

reversing the rejections, the U.S. Patent and Trademark Office re-opened prosecution, applying new prior art, instead of issuing the application. The examiner attempted to reinstitute the grounds of rejection which were reversed on appeal - something that is clearly forbidden by the Manual of Patent Examining Procedure. I had to request a new office action. The application has progressed since then, but the costs here arose entirely out of PTO error, and I question the fairness or efficiency of the PTO giving itself more rules by which to delay giving real consideration to substantive issues.

In the last five years, there have been far too many instances where I have written an appeal brief and had prosecution re-opened in the face of the brief. It seems to me that if the Patent and Trademark Office is going to force an appeal, it should certify prior to the filing of the appeal (such as at the time of final rejection) that it has conducted a complete search of the prior art and that the final rejection(s) are the best rejections known to the Examiner. A great deal of expense and effort goes into these appeal briefs. Such a simple measure would work as a cost saving to appellants and prevent re-openings of the prosecution after an appeal brief has been prepared and filed. Re-opening of prosecution after the filing of an appeal and/or a Board decision should only happen in rare instances. Sadly, I note that no such measure is part of the new appeal rules.

Given my experiences to date, I am extremely skeptical of the Patent and Trademark Office's statement that it expects the new rules to simplify anything. I suggest that the Patent and Trademark Office's appeal problem is driven by examiners who over-reject, not by anything appellants do. The burdens of the new rule are totally out of proportion to the practical utility to the Patent and Trademark Office - duplicative statements of claims, jurisdictional statement, etc. For more than 150 years now, the Patent and Trademark Office has been able to decide appeals efficiently without these requirements.

Yours sincerely,

A handwritten signature in dark ink, appearing to read "Barry L. Kelmachter", written over the typed name.

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