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November 14, 2008

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

E-MAIL ONLY: Nicholas_A._Fraser@omb.eop.gov

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

Dear Mr. Fraser:

I am writing to provide you with information that may be useful in your evaluation of the Patent Office's appeal rule and the paperwork implications. I am a patent attorney with 33 years' experience prosecuting patent applications before the USPTO, including innumerable appeals. In my experience, the PTO's enforcement of the current appeal rules is arbitrary and capricious and requires a burden of compliance with no practical utility to the PTO, as well as arbitrary enforcement of unwritten rules.

The current burden of compliance is much greater than it was only a few years ago. This includes added appeal brief sections which provide information which is obvious, redundant or unnecessary for the appeal decision. For example, there is currently a requirement for a duplication of claims both in the body of an appeal brief and in an appendix section. There is a requirement for a concise explanation of the invention for each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawings, if any, by reference characters. This line and page requirement adds a great amount of time in appeal brief preparation. This furthermore adds a layer of compliance review by a USPTO paralegal who often rejects an appeal brief for a triviality, thus requiring a re-filing of a brief for a reason unrelated or insignificant to the merits of the case.

The proposed rules would require an appeal brief format change requiring the following additional sections: (a) Jurisdictional statement, (b) table of contents, (c) table of authorities, and (d) statement of facts.

The jurisdictional statement would be obvious – either an appeal or an interference. A Table of Contents is already a part of the appeal brief. A table of authorities is unnecessary since authorities would already be in the brief in the arguments section. A Statement of Facts is unnecessary. What facts need be recited? A patent application was filed, an office action was issued, an amendment was filed, a final rejection was issued, a response was filed, an Advisory action was issued and an appeal taken. These facts are in almost every case, and do not advance an ultimate decision. Other than a 37 CFR 1.131 or a 37 CFR 1.132 Declaration, a specification and office actions/amendments set forth positions and arguments, not facts.

One must then define the record on appeal to clarify what documents the Board will consider in resolving the appeal. Clearly the documents will be the entire record, with emphasis on those specifically mentioned in the argument section.

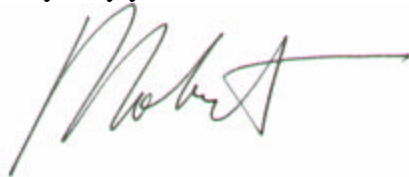
The format and content of the appeal brief appendix is to be changed to include the following additional sections: (a) claim support section, (b) drawing analysis section, (c) means or step plus function analysis section, and (d) an expanded evidence section to include, inter alia, relevant Office action(s) and portions of papers filed by appellant during prosecution. These are all unnecessary for a brief, or already in the record file before the Board. A “claims support” section is unnecessary unless a “new matter” rejection is an issue. A drawing analysis section is unnecessary unless a drawing analysis is an issue. A “means or step plus function analysis section” is unnecessary unless these are issues forming part of a rejection. The “expanded evidence” section is merely a duplication of papers filed by the appellant during prosecution. A “statement of timeliness” only evokes an unnecessary Appellant allegation.

The new requirements establish of format for a supplemental reply brief and a request for rehearing to include including: (a) Table of contents, (b) table of authorities, (c) statement of timeliness, and (d) argument. Currently only an argument is necessary. New sections (a), (b) and (c) are unnecessary, costly and burdensome to the Appellant and do not add to ease of decision.

Again, all of these issues will require an increase layer of consideration, expense and interpretation by a USPTO paralegal, inevitably generating frustration and requiring excess compliance work by an Applicant for reasons unrelated to a BOPAI decision.

Rather than expanding on appeal brief requirements, the USPTO should revert to the prior rules which merely requirement a statement of the current claims and arguments against the rejections. Thank you for your consideration.

Very truly yours,

A handwritten signature in black ink, appearing to read 'Roberts', with a long horizontal flourish extending to the right.

Richard S. Roberts

RSR/la