BOYLE FREDRICKSON
INTELLECTUAL PROPERTY LAW
840 North Plankinton Avenue, Milwaukee, WI 53203 P: 414-225-9755 F: 414-225-9753 www.boylefred.com

DAVID D. STEIN
DIRECT DIAL: 414-225-1664
dds@boylefred.com

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Mr. Nicholas A. Fraser
Desk Officer for Patent & Trademark Office
Office of Information and Regulatory Affairs
Office of Management and Budget
725 17th St. NW
Washington D.C. 20502

Via E-mail
Nicholas_A._Fraser@omb.eop.gov

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

Dear Mr. Fraser:

I am forwarding you information to estimate paperwork burdens of the United States Patent Office's new appeal rule that goes into effect on December 10, 2008. I currently have a couple of appeals in progress. I drafted one under the new rules, as I will not be able to file it before December 10.

I estimate that, even after I am fully up the "learning curve" of the new rules, a brief under the new rules will take at least twice the time as under the current rules. This brief, which included time reading and re-reading the rules (new rule 41.37 governing appeal briefs is twice as long as the current version), took about 4X the time of a similar brief under the current rules.

In this particular appeal, which involved 12 claims and a relatively brief and straightforward prosecution file history, I spent at least about 18 hours on actual drafting of the appeal brief, excluding time reviewing the new rules. Under the existing appeal brief rules, I estimate that I would have spent somewhere around 5-8 hours.

There are several things that I felt increased the burdensomeness of preparing an appeal under the new rules.

One of the most burdensome new requirements is the requirement to identify where issues were first raised. I cannot imagine how this information could conceivably be relevant to the issues that the Board decides. In addition, where the prosecution file history is more voluminous and complex, the process of identifying where issues were first raised will be even more time consuming and prone to error, and will thus increase the likelihood of denial of entry/rejection of the brief.

Another burdensome new requirement is the requirement for a Statement of Facts. The requested format – as a separate section, instead of presenting the information in the body of the brief integrated in with the argument, as in current practice – makes this requirement surprisingly inefficient and error-prone. The rule's format makes it very difficult to meaningfully organize the information to be useful to the Board and persuasive for my client. Further, the rule is ambiguous – I have considerable uncertainty as to what the Board is looking for in terms of a logical order of fact citation, or the types of facts that should be included. The rather short example provided in the Federal Register at 73 FR 32938 et seq. is rather unhelpful. It appears the PTO developed this example in a vacuum, without ever preparing an internal evaluation sample. If the PTO re-proposes this appeal rule, the PTO should be required to run a pilot, to determine whether this rule is practical for appellants and useful to the Board. Based on my experience, I am extremely skeptical that it is either.

Additionally, the new rules as published in the Federal Register at 73 FR 32938 et seq. are written in an unhelpful manner – I spent at least 3-4 hours repeatedly slogging through them trying to figure out how to implement the new rules. They could have been organized better, and a model example brief could have been done to help eliminate confusion so that everyone would know what the Board expected.

Finally, I cannot imagine how the average brief will be kept under 30 pages. As I mentioned above, the appeal brief that I drafted was on the simple end of the spectrum. In this simple case, my appeal brief was 26 pages long. I would expect to have to petition the Board for enlargement of the page limit perhaps over 50% of the time (or more).

I hope this information is useful to you. Please contact me if you have any questions.

Very truly yours,

David D. Stein

DDS:dmo