

From: pasinger@comcast.net

Sent: Thursday, February 25, 2010 1:13 PM

To: BPAI Rules

Subject: Comments on Proposed Rules 37 CFR Part 41; Fed Reg Vol 74, No. 244, page 67987

Dear Commissioner,

After reviewing the proposed modification to rules of practice before the Board of Patent Appeals and Interferences in Ex Parte Appeals, I am opposed to all proposed modifications of the rules 37 CFR Part 41 as currently written in the Federal Register, Vol 74, No. 244, page 67987. I request that you withdraw the proposed rule modifications from consideration.

In particular the proposed modification to rule 41.50, "Decisions and other actions by the Board" is unnecessary and is detrimental to the patent rights of my clients. The U.S. Patent and Trademark Office has cited no statutory authority for the proposed modification to the rules. The Board of Patent Appeals and Interferences has consistently not supported the rights of applicants by failing to rule on cases before the Board and then remanding cases to the examiner for further examination.

Proposed rule 41.50 and other rules interfere with my ability as a patent attorney to zealously represent my client before the U.S. Patent and Trademark Office. The proposed rules changes will have a significant negative economic impact on my clients.

Proposed § 41.50:

§ 41.50 Decisions and other actions by the Board.

(a) Affirmance and reversal. The Board may affirm or reverse an examiner's rejection in whole or in part. Affirmance of a rejection of a claim constitutes a general affirmance of the decision of the examiner on that claim, except as to any rejection specifically reversed.

(b) Remand. The Chief Administrative Patent Judge may remand an application to the examiner. If in response to a remand for further consideration of a rejection, the examiner enters an examiner's answer, within two months the appellant shall exercise one of the following two options to avoid abandonment of the application or termination of a reexamination proceeding:

(1) Request to reopen prosecution. Request that prosecution be reopened before the examiner by filing a reply under § 1.111 of this title with or without amendment or submission of evidence. Any amendment or evidence must be responsive to the remand or issues discussed in the examiner's answer. A request that complies with this paragraph will be entered and the application or patent under reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. A request under this paragraph will be treated as a request to dismiss the appeal.

(2) Request to re-docket the appeal. The appellant may request that the Board re-docket the appeal (see § 41.35(a) of this subpart) and file a reply brief as set forth in § 41.41 of this subpart. A reply brief may not be accompanied by any amendment or evidence. A reply brief which is accompanied by an amendment or evidence will be treated as a request to reopen prosecution pursuant to paragraph (b)(1) of this section.

(c) Remand not final action. Whenever a decision of the Board includes a remand, the decision shall not be considered a final decision of the Board. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order making its decision final.

(d) New ground of rejection. Should the Board have a basis not involved in the appeal for rejecting any pending claim, it may enter a new ground of rejection. A new ground of rejection shall be considered an interlocutory order and shall not be considered a final decision. If the Board enters a new ground of rejection, within two months appellant must exercise one of the following two options with respect to the new ground of rejection to avoid dismissal of the appeal as to any claim subject to the new ground of rejection:

(1) Reopen prosecution. Submit an amendment of the claims subject to a new ground of rejection or new evidence relating to the new ground of rejection or both, and request that the matter be reconsidered by the examiner. The application or reexamination proceeding on appeal will be remanded to the examiner. A new ground of rejection by the Board is binding on the examiner unless, in the opinion of the examiner, the amendment or new evidence overcomes the new ground of rejection. In the event the examiner maintains the new ground of rejection, appellant may again appeal to the Board.

(2) Request for rehearing. Submit a request for rehearing pursuant to § 41.52 of this subpart relying on the Record.

(e) Recommendation. In its opinion in support of its decision, the Board may include a recommendation, explicitly designated as such, of how a claim on appeal may be amended to overcome a specific rejection. When the Board makes a recommendation, appellant may file an amendment or take other action consistent with the recommendation. An amendment or other action, otherwise complying with statutory patentability requirements, will overcome the specific rejection. An examiner, however, upon return of the application or reexamination proceeding to the jurisdiction of the examiner, may enter a new ground of rejection of a claim amended in conformity with a recommendation, when appropriate.

(f) Request for briefing and information. The Board may enter an order requiring appellant to brief matters or supply information or both that the Board believes would assist in deciding the appeal. Appellant will be given a non-extendable time period within which to respond to the order. Failure of appellant to timely respond to the order may result in dismissal of the appeal in whole or in part.

(g) Extension of time to take action. A request for an extension of time to respond to a request for briefing and information under paragraph (f) of this section is not authorized. A request for an extension of time to respond to Board action under paragraphs (b) and (d) of this section shall be presented under the provisions of § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

After reviewing the proposed modification to rules, I am opposed to all proposed modifications of the rules of practice before the Board of Patent Appeals and Interferences in Ex Parte Appeals. I earnestly request that you withdraw from consideration the proposed modifications of the rules. Thank you for your consideration.

Sincerely yours,

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