

COMMENTS OF THE SECTION OF PATENT, TRADEMARK AND COPYRIGHT LAW
OF THE DISTRICT OF COLUMBIA BAR ON MISCELLANEOUS AMENDMENTS
OF PATENT RULES PUBLISHED BY U.S. PATENT AND TRADEMARK
OFFICE IN FEDERAL REGISTER OF SEPTEMBER 30, 1987.

The Section of Patent, Trademark and Copyright Law of the District of Columbia Bar submits these comments in response to the request for public comments published by the Patent and Trademark Office in the Federal Register at 52 Fed. Reg. 36736.

We commend the Patent and Trademark Office for proposing to clarify and improve the patent rules. Our comments on the Federal Register notice are limited to portions of the rules relating to briefs and reply briefs in ex parte patent appeals.

First, we recommend amending proposed rules 1.192(a) and 1.193(b) to make clear the consequences of failing to comply with the 30 page and 15 page limits for main briefs and reply briefs. We recommend amending the rule to state that in the event a brief is timely filed but exceeds the requisite number of pages, the appellant will be afforded a period of time of one month to modify the brief to make it comply with the rule.

Rule 1.192(a) as proposed merely indicates that a brief exceeding 30 pages, not counting the appendix, will "be returned to the appellant." Similarly, proposed rule 1.193(b) states that if a reply brief exceeds 15 pages it will be returned to the appellant.

We assume the Office does not intend to dismiss an appeal for inadvertent failure to comply with the page limit for main briefs, without notifying the attorney and giving an opportunity to shorten the brief. The proposed rules, however, do not foreclose this possibility, nor do they foreclose the interpretation that an appellant whose brief is not limited to the requisite number pages may be required to pay fees for extensions of time pursuant to 37 CFR 1.136(a). We believe an appellant should not be required to pay a fee for an extension of time for inadvertent failure to comply with the 30 page and 15 page limits.

We note that the page limits in the proposed rules have to be read together with the provisions of 37 CFR 1.52 relating to typewriting and paper size. Rule 1.52 permits either letter or legal size paper and permits double spacing or one and one-half spacing. It is easy to imagine that an attorney could inadvertently exceed the page limit in the final copy of a brief, for example, by reformatting to different paper size or line spacing. We believe affording a one month period of time to submit a brief complying with the page limit requirements would achieve the announced objective of eliminating lengthy briefs and reply briefs.

Second, we recommend clarifying paragraph 1.192(d), which as published for comment indicates that failure to comply with any of the requirements of paragraph (c) "may result in dismissal of the appeal." We recognize that the use of the word "may" indicates a degree of discretion on the part of the Office. Nevertheless, we believe the rule or the Manual of Patent Examining Procedure should make clear that it is mandatory for the Office to notify the

appellant of a failure to comply with the requirements for briefs set forth in rule 1.192(c), and to allow the appellant one month to correct defects by filing a supplemental brief. This would prevent unnecessary dismissal of appeals and alleviate concern of patent counsel that inadvertent errors will cost the loss of valuable rights.

Third, we recommend clarifying proposed rule 1.192(c), paragraph 4, which would require the appellant to provide "a concise statement of the issues presented for review." We recommend changing "issues presented for review" to "rejections presented for review."

The term "issues" is susceptible of various interpretations. The explanatory material in the Federal Register notice at page 36738 suggests that the Office intends for each stated issue to be a "ground of rejection". The examples of issue statements given in the Federal Register are statements of rejections made by patent examiners under specific sections of the patent code. The term "rejections" has a better understood meaning to practitioners than "issues". If paragraph 4 of rule 1.192(c) is amended as we suggest, conforming changes will be needed in paragraph 6.

Thank you for your consideration of our comments.

November 23, 1987