

November 17, 2008

# Comments submitted to OMB under the Paperwork Reduction Act on US Patent Office appeal rules

Ron D Katznelson, *Bi-Level Technologies*

By Email:

November 17, 2008

**TO:** Nicholas A. Fraser, [Nicholas\\_A\\_Fraser@omb.eop.gov](mailto:Nicholas_A_Fraser@omb.eop.gov)  
U.S. Patent and Trademark Desk Officer  
Office of Information and Regulatory Affairs  
Office of Management and Budget  
725 17<sup>th</sup> St., NW  
Washington, DC 20503

**CC:** Suzanne Hilding, [SHilding@doc.gov](mailto:SHilding@doc.gov)  
Chief Information Officer,  
U.S. Department of Commerce  
1401 Constitution Ave., NW  
Washington, DC 20230

**RE:** *ICR Reference No: [200809-0651-003](#), Comment on PTO Information Collection Request related to Board of Patent Appeals and Interferences Actions under the Paperwork Reduction Act.*<sup>1</sup>

Dear Mr. Fraser,

I am an inventor, entrepreneur and an independent scholar of the U.S. patent system. As a user of the U.S. patent system for a quarter of a century, I am writing to express my concerns regarding the above captioned proposed Information Collection Request (“ICR”) associated with *Ex Parte* appeals at the U.S. Patent and Trademark Office (“PTO”).

The PTO promulgated rules and sought extensive information collection in a manner that contravened the law and OMB’s regulations at essentially every step of the rulemaking process. Many members of the public offered PTO constructive suggestions for estimating and reducing the burdens imposed by its rules. Despite these efforts of the public, for inexplicable reasons, the PTO has ignored comments, refused to address issues brought before it, and refused to follow the law and OMB’s implementing regulations. In so doing, the PTO violated Executive Order 12,866, the Paperwork Reduction Act (“PRA”) and the Information Quality Act (“IQA”).

The PTO repeatedly evaded its legal responsibilities. OMB’s role is to stop PTO from doing so. OMB was delegated authority and ***obligation*** to ensure that government agencies comply with the law. Both the 2004 and the 2008 Appeal Rules have been promulgated illegally without proper PRA clearance. OMB should disapprove the ICR, temporarily allow the PTO to continue operating under the existing 2004 rule and disallow enforcement of PTO’s 2008 Final Appeal Rule (as defined below) without amendment. In forming your response and best course of action, I urge you to consider the real causes and nature for the appeals pressures the PTO is experiencing, as I present them below.

In what follows, I refer to the following defined terms:

---

<sup>1</sup> PTO, *Board of Patent Appeals and Interferences Actions, New collection; comment request*. [73 Fed. Reg. 32559](#), (June 9, 2008), hereinafter referred to as the “ICR Notice”.

- (a) The “2003 Appeal NPRM” means the Notice of Proposed Rulemaking published at 68 Fed. Reg. 66648 on November 26, 2003.<sup>2</sup>
- (b) The “2004 Final Appeal Rule” means the final rule published at 69 Fed. Reg. 49960 on August 12, 2004, and the rules that came into effect as a result of that notice.<sup>3</sup>
- (c) The “2007 Appeal NPRM” means the Notice of Proposed Rulemaking published at 72 Fed. Reg. 41472 on July 30, 2007.<sup>4</sup>
- (d) The “2008 Final Appeal Rule” means the final rule published at 73 Fed. Reg. 32938 on June 10, 2008 and the rules that came into effect as a result of that notice.<sup>5</sup>
- (e) The “ICR” means the Information Collection Request under the Paperwork Reduction Act having an ICR reference number 200809-0651-003<sup>6</sup> that the PTO filed with the OMB on October 9, 2008.
- (f) The “ICR Notice” means the notice published in 73 Fed. Reg. 32559 on June 9, 2008<sup>7</sup> regarding PTO’s information collection clearance request from OMB.
- (g) The “ICR Statement” means the supporting statement often referred to as OMB 83-I statement, as submitted with the ICR to OMB<sup>8</sup>.
- (h) The “September ‘07 ICR” means the Information Collection Request under the Paperwork Reduction Act having an ICR reference number No. 200707-0651-005<sup>9</sup> that the PTO filed with the OMB under control number 0651-0031 on September 26, 2007.

## 1 BACKGROUND

Patent appeals become necessary when applicants believe that their patent application should have been allowed rather than wrongly rejected by the examiner. The PTO has been describing its falling application “allowance” rate (Figure 1) as an indicator of improved “patent quality” and success. PTO’s underlying implication is that a lower allowance rate means that more “lower quality” patents – patents of dubious validity, are rejected. But when all statistics available are considered, Figure 1 becomes a damning showing of PTO error. PTO’s measure of “quality” is mostly an illusion, as I have recently demonstrated elsewhere.<sup>10</sup> It appears that the PTO one-sidedly considers only false negatives (an error failing to reject invalid claims), and refuses to even acknowledge, let alone publish statistics on false positives (errors failing to allow valid claims). A proper measure of quality, and the only rational performance goal for the PTO, is to minimize the *weighted* sum of **both** errors, wherein the weights are proportional to the

<sup>2</sup> PTO, *Rules of Practice Before the Board of Patent Appeals and Interferences*, Proposed Rule. [68 Fed. Reg. 66648](#) (November 26, 2003).

<sup>3</sup> PTO, *Rules of Practice Before the Board of Patent Appeals and Interferences*, Final Rule [69 Fed. Reg. 49960](#) (August 12, 2004).

<sup>4</sup> PTO, *Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals*, Proposed Rule, [72 Fed. Reg. 41472](#), (July 30, 2007).

<sup>5</sup> PTO, *Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals*, Final Rule, [73 Fed. Reg. 32938](#), (June 10, 2008).

<sup>6</sup> PTO, *Board of Patent Appeals and Interferences (BPAI) Actions*. Type of Information Collection: New collection (Request for a new OMB Control Number).

At [http://www.reginfo.gov/public/do/PRAViewICR?ref\\_nbr=200809-0651-003#section0\\_anchor](http://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=200809-0651-003#section0_anchor)

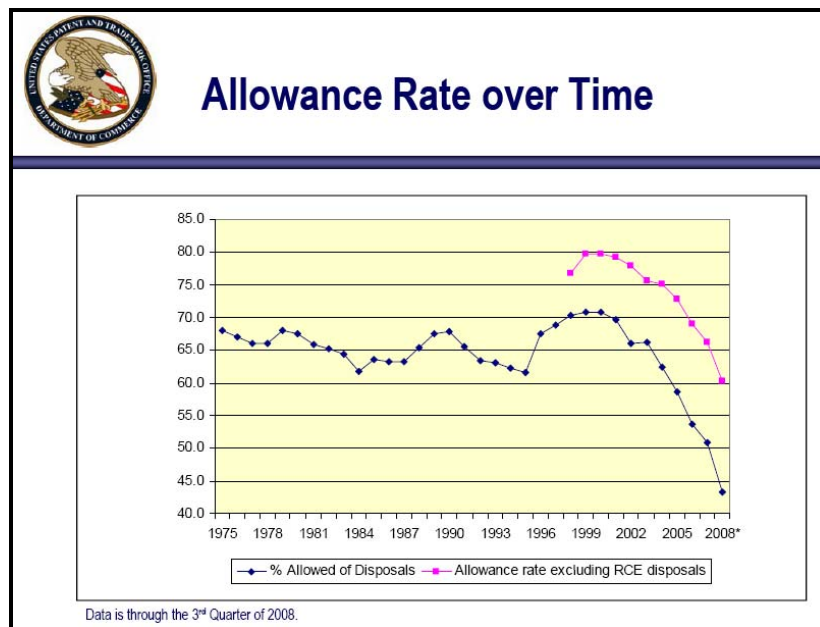
<sup>7</sup> PTO, *Board of Patent Appeals and Interferences Actions*, New collection; comment request, [73 Fed. Reg. 32559](#), (June 9, 2008).

<sup>8</sup> At <http://www.reginfo.gov/public/do/DownloadDocument?documentID=89627&version=0>.

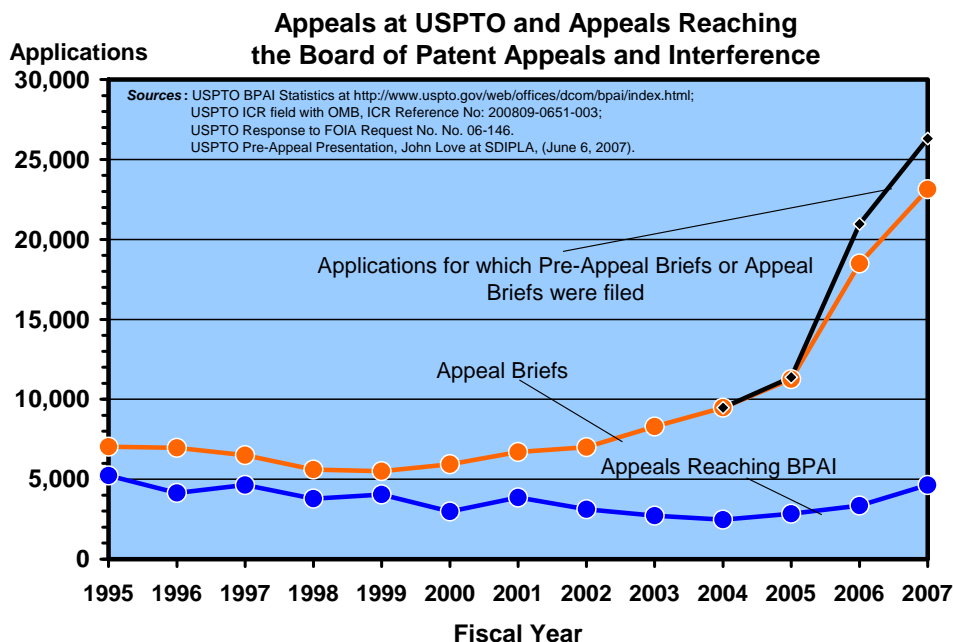
<sup>9</sup> [http://www.reginfo.gov/public/do/PRAViewICR?ref\\_nbr=200707-0651-005](http://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=200707-0651-005)

<sup>10</sup> Ron D. Katznelson, PTO panel, “*The Perfect Storm of Patent Reform?*” Fenwick & West Lecture Series Inaugural Symposium, UC Davis School of Law, (November 7, 2008). At <http://works.bepress.com/rkatznelson/54/>

public welfare costs of each error type. It appears that the PTO is assigning essentially zero-weight (thus assuming zero cost to the public and itself) for errors that fail to allow valid claims.



**Figure 1** PTO’s chart showing patent applications allowance rate. As defined by the PTO, “Allowance Rate” in a period is the ratio between the number of allowed application disposals in the period and all application disposals in that period. An application that is continued via the RCE process is counted as a disallowed disposal, even if the application is allowed during the RCE process. *Source:* Presentation of James A. Toupin, IPO Annual meeting, San Diego, September 21-23, 2008



**Figure 2** The number of appeal briefs filed with PTO and the number of appeals that were actually received for appeal adjudication at the Board of Patent Appeals. Note that in the last few years, the number of appeal briefs has grown sharply, while the number reaching the BPAI has been roughly flat. This means that an Appeal Conference with other examiners finds that the examiner’s rejection lack any merit in *nearly four out of every five appeals*.

PTO management has structured incentives for examiners to preferentially reject applications, essentially irrespective of quality. Unfortunately, it also appears that other incentives exist for PTO's management to ensure that while appeals are queued up for appeal conferences they receive the minimum patent term extension ("PTE") credit due to PTO delay. Appellants do not get the "PTO delay Clock" started for PTE credit until their brief is found compliant. *See* 37 C.F.R. § 1.703 (a)(4). Erecting a mass of new procedural, bureaucratic and formatting barriers via new appeal rules can significantly delay their "compliance" date or otherwise suppress their willingness to file an appeal to begin with. Both results appear in line with PTO's management's incentives based on distorted metrics.

An increasing number of applicants who have patentable applications are forced to go over the heads of examiners and file appeals. Thus, the number of appeals has skyrocketed, as shown in Figure 2. These statistics clearly show that the errors leading to appeals are the PTO's, not applicants'. The increase in appeal briefs *filed* is due to a dramatic rise in rejections that are later shown to be wrong: While the number of appeal briefs *filed* has quadrupled, the number of appeals *reaching the Board of Patent Appeals* and Interference ("BPAI") has not changed much. The PTO's own data in Figure 2 show that the early stages of the appeals process (Pre-Appeal and Appeal Conference reviews) find examiner error in four out of five appeals. In these reviews, two other examiners determine that the examiner's rejection lacks even the minimal merit to warrant allowing the appeal to go forward to the BPAI.

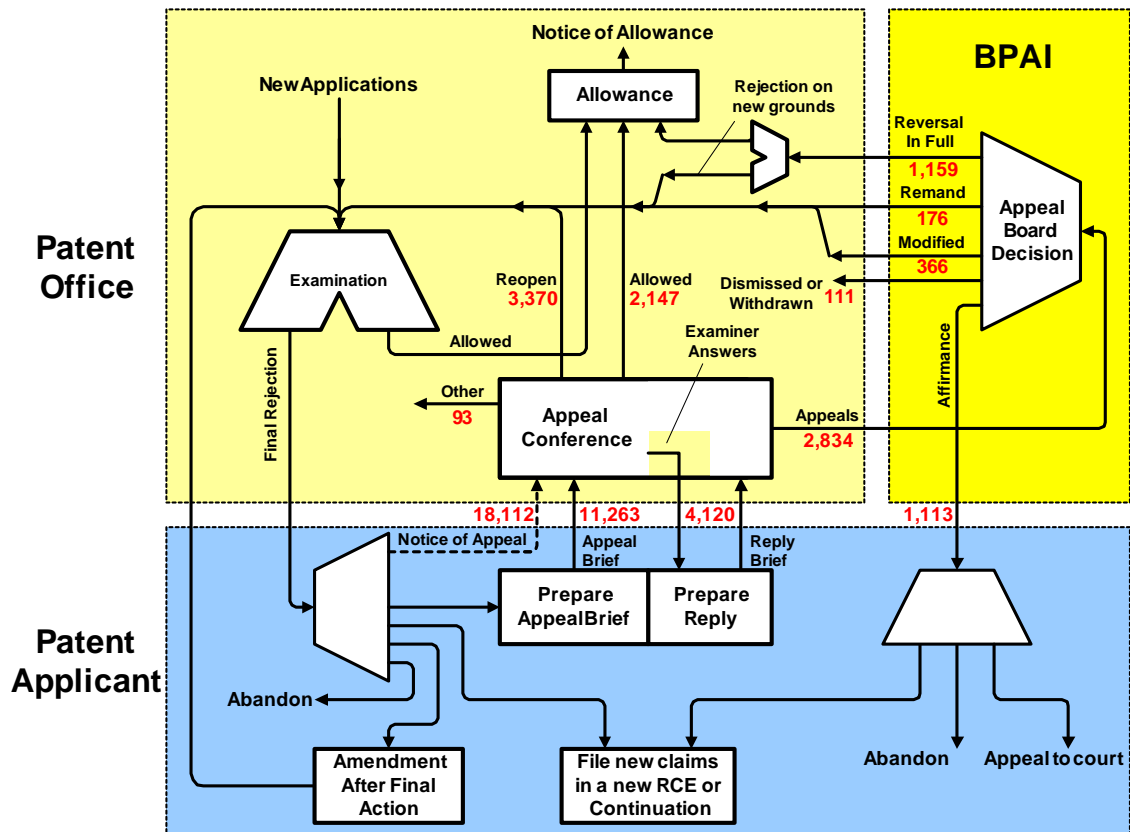
There is no doubt that the PTO is struggling under the pressure of pending applications backlog and examiner corps attrition. As seen in Figure 2, the PTO must know that its rejections under appeal are mostly in error. Otherwise, it would have kept sending more appeals to the BPAI. Thus, PTO recognized the fact that better examination is required and, to its credit, it has adopted certain quality initiatives directed at improving examination quality. These are the pre-appeal brief conference program to permit an applicant to request that a panel of examiners review the rejections in his or her application prior to the filing of an appeal brief. *See* New Pre-Appeal Brief Conference Program<sup>11</sup> and its Extension.<sup>12</sup> The PTO also began examination quality improvement activities in Interviews before First Action<sup>13</sup>, "Second Pair of Eyes", "In Process Reviews", Appeal Specialists, new Certification Exam, Primary Examiner Recertification, New Patent Examiner Training Academy, and other initiatives. While these measures are all positive measures for dealing with PTO's challenges, the Appeal Rules as written are not.

---

<sup>11</sup> USPTO Off. Gaz. Pat. Office (July 12, 2005)

<sup>12</sup> USPTO Off. Gaz. Pat. Office (Feb. 7, 2006)

<sup>13</sup> USPTO Off. Gaz. Pat. Office (27 April 2004). *See also* <http://www.uspto.gov/web/offices/com/speeches/08-17.htm>



**Figure 3** Ex Parte Appeal Process flow at the PTO. The unit flow numbers in red indicate the number of cases in each flow category during FY 2005 and are not necessarily the same cases, due to accumulation and delays. The cases that the BPAI affirmed-in-part or reversed-in-part are aggregated under the unit flow labeled “Modified”. Sources: PTO Board of Patent Appeal statistics<sup>14</sup> and PTO response to a FOIA Request<sup>15</sup>.

Even under the current rules, an appeal is a costly proposition for applicants. In support of its 2008 Final Appeal Rules and the burdens they impose, the PTO focused exclusively on what it characterized as improvements in “judicial economy” of the BPAI – that is, mere convenience to a government body. But the BPAI only receives one in five of the briefs on which these burdens are imposed. PTO practices are causing a growing fraction of applications to unnecessarily shift to a remarkably expensive process to correct clear PTO errors that can be (and are) decided without the expertise of the BPAI. The 2008 Final Appeal Rules impose predominantly unwarranted burdens imposed because of PTO errors. The 2008 Final Appeal Rules make it even more burdensome to correct the PTO’s own errors. The errors arise chiefly because the PTO management has improper performance metrics and has failed to implement common sense reforms that have been requested by the public. These include OMB’s Good Guidance Practices and tailoring of examiners’ performance metrics and incentives to align them with the patent statute and quality examination.

This is a classic case in need of OMB supervision, as it involves massive agency process failure that collaterally imposes paperwork burdens on the public - responses that grow by more than 35% per year. PTO’s argument that the gratuitous new burdens in its 2008 Final Appeal Rule

<sup>14</sup> PTO, “Board Statistics” at <http://www.uspto.gov/web/offices/dcom/bpai/index.html>

<sup>15</sup> PTO, *Appeal Conference Effects - Examiner Actions in Response to Appeal Brief*. FOIA Request No. 06-146 (March 14, 2006).

are aimed at BPAI “judicial economy” is simply not credible. This is because the PTO could have easily crafted rules that impose the significant burdens associated with the ancillary tables, appendices and contiguous pagination obligations only on briefs that *actually go to the BPAI* by requiring these elements only at the time that a reply brief is filed. Rather, PTO appears quite content with imposing collateral burdens on *every* appellant and thereby erecting barriers for filing *any* appeal in an attempt to control the appeal flood due to a problem of PTO’s own making. If, as the PTO contends, these provisions were indeed directed at “judicial economy” at the BPAI, they would have been so in 2004, when the PTO adopted its current appeal rules. But these provisions were not proposed then. As Figure 2 shows, the major pertinent difference between now and then is not in the appeal flow to the BPAI, but rather in the rising flow of appeals that never reach the BPAI. Hence, the timing of these rules suggests that they are directed primarily at suppressing the appeal flow and much less at “judicial economy”.

## **2 OMB SHOULD COMPEL PTO’S COMPLIANCE WITH OMB’S REGULATIONS**

### **2.1 OMB should require PTO’s compliance with the Paperwork Reduction Act**

#### *2.1.1 The 2004 (current) Appeal Rule*

Five years ago, in its 2003 Appeal NPRM, the PTO proposed changes in its appeal rules that involved an increase in information collection from appellants. The proposed rules included new requirements for submitting an affidavit or other evidence that can be satisfied by submitting a document showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented, (68 FR 66648, Col. 3). Rule 41.37 added requirements for an appeal brief, requiring a more detailed summary of claimed subject matter for each of the independent claims involved in the appeal; and a requirement that every means plus function and step plus function be identified (68 FR 66676, Col. 3). A new requirement for an “Evidence Appendix” with copies of any evidence entered and relied upon in the appeal was added. A new requirement for a “Related Proceedings Appendix” containing copies of decisions rendered by a court or the Board in any proceeding identified in the related appeals and interferences section was also added. (68 FR 66677, Col. 1). Clearly, information collection of the material reproduced in the Evidence Appendix is essentially duplicative.

For information collection contained in a proposed rule, 44 U.S.C. § 3507(d)(1)(A) requires that an agency submit an ICR to OMB “as soon as practicable, but no later than the date of publication of a notice of proposed rulemaking in the Federal Register.” An agency is also required, by 44 U.S.C. § 3507(a)(1)(D)(ii)(V), to publish a notice in the Federal Register “setting forth ... an estimate of the burden that shall result from the collection of information.” § 3506(c)(1)(A)(iv) requires that any burden estimate submitted to the OMB Director, including those under § 3507(d)(1)(A), be “objectively supported.” The PTO has complied with none of these statutory provisions when it promulgated the 2004 Final Appeal Rule.

In a manner that demonstrates a total misapprehension of the PRA, the PTO admitted in the 2003 Appeal NPRM that “[t]his proposed rule involves information collection requirements which are subject to review by the [OMB under the PRA]” (68 FR 66667, Col.3), but made no statements



as to paperwork burdens, made no solicitation, and provided no opportunity or instructions for submitting public comments on paperwork burdens. No notice of an ICR seeking clearance for the new information collection was published. An identical PRA statement was made in the 2004 Final Appeal Rule. No OMB clearance for any information collection was ever sought, let alone received. These two rulemaking publications were remarkable in their PRA violations, as they did not even attempt the pro-forma statements required under OMB's PRA rules.

### 2.1.2 The 2008 Final Appeal Rule

After the publication of the 2007 Appeal NPRM, I have provided details on PTO's incremental paperwork burdens associated with of these proposed rules. Others in this proceeding have demonstrated how the PTO and the CIO of the Department of Commerce as the certifying "Senior Official", failed to seek PRA clearance during the rulemaking for a massive new information collection, which they admitted to in the ICR.<sup>16</sup> In the PRA section of the 2007 Appeal NPRM, the PTO states that the collection of information involved in the proposed appeal rule *has been reviewed*. It certified that the PTO was not resubmitting an information collection package to OMB for its review and approval because the proposed rule would not affect information collection requirements (72 FR 41484, Cols. 1-2). Because the PTO represented that the information collection associated with the 2007 Appeal NPRM *has been reviewed* and because the Department of Commerce's CIO is the "Senior Official" responsible for such review, one must conclude that the CIO provided false certification under the PRA. The PTO's PRA violations continued, as PTO attempted to correct its errors in the wrong way.

Under the Paperwork Reduction Act ("PRA"), an agency is required to objectively evaluate and objectively *support* its paperwork burden estimates. 44 U.S.C. § 3506(c)(2)(A)(ii) and § 3506(c)(1)(A)(iv); 5 C.F.R. § 1320.8(a)(4). OMB Rule § 1320.8(a)(4) requires that agency review of its information collection include "[a] specific, objectively supported estimate of burden". The PRA does not merely require that the agency *have in its possession* a record of such objective support and evaluation of burdens, but it requires that the agency "*provide* a record supporting [its] certification" regarding the information collection burdens. § 3506(c)(3). Despite many requests to support its "certification" pertaining to paperwork burden estimates by *providing* the record,<sup>17</sup> the PTO declined to do so in the ICR.

My extensive comments in response to PTO's 2007 Appeal NPRM were also submitted in the OMB control number 0651-0031 docket for the September '07 ICR.<sup>18</sup> I estimated only the *incremental* paperwork burdens due to the proposed appeal rules based on PTO's trends of total applicants' appeal activity and other PTO statements. Unfortunately, in promulgating its 2008 Final Appeal Rule, the PTO failed to respond to many of my comments that were directed at the paperwork burdens imposed by these rules. I projected growth in numbers of appeal briefs and reply briefs based entirely on PTO's own data.<sup>19</sup> My analysis showed that just the *incremental* paperwork burdens of the appeal rules in the 2007 Appeal NPRM would be \$100 million or more

---

<sup>16</sup> David Boundy, ICR Notice Comments, note 23, at 12-15.

<sup>17</sup> See public comments calling for the PTO to provide support for its estimates in the ICR Statement and the 2008 Final Appeal Rule at [http://www.reginfo.gov/public/do/PRAViewDocument?ref\\_nbr=200809-0651-003](http://www.reginfo.gov/public/do/PRAViewDocument?ref_nbr=200809-0651-003)

<sup>18</sup> Ron Katznelson NPRM Comments, *Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals*. October 15, 2007.

At <http://www.reginfo.gov/public/do/DownloadDocument?documentID=51959&version=1>

<sup>19</sup> See Section 3 of Ron Katznelson Comments, note 18 above.



per year. Because the PTO supplied no facts or evidence to contradict the data I compiled, the PTO simply ignored the facts and the obligation of objective support. The PTO did not even acknowledge my detailed reasoned analysis but merely stated, with *no analysis*: “This rulemaking has been determined to be not significant for the purpose of Executive Order 12,866”.<sup>20</sup>

After the PTO solicited comments in the ICR Notice, I submitted my comments and estimates of paperwork burdens again.<sup>21</sup> I specifically pointed out that the PTO had admitted that it projects large year-to-year growth in appeals and I requested that the PTO fully account and provide support for such increasing responses for the three years covered by the ICR.<sup>22</sup> Others have also called on the PTO to do so.<sup>23</sup> Unfortunately, PTO’s ICR Statement submission again ignored these requests and any other requests that PTO provide support for its burden estimates. The PTO now repeats the inadequate accounting of appeals burdens in this ICR. The PTO declined five times to provide objective support for its burden estimates and projections as required, in the 2007 Appeal NPRM, in the September ‘07 ICR, the 2008 Final Appeal Rule, the ICR Notice, and in the ICR Statement. *Five failures* to estimate the burdens for 2009-2011, let alone respond to requests for objectively-supported estimates, leaves little room to avoid concluding that the PTO’s refusal to follow the law and its contempt for OMB oversight is intentional.

I have now requested any objective support the PTO may have in a Freedom of Information Act (“FOIA”) request directed to the PTO and attached hereto for your information as Appendix 1 (“FOIA Req.”). The request also includes relevant items expressly requested by others in public comments. The number of these requested items demonstrates the scope of PTO’s lack of objective support for its assertions and estimates.

The PTO’s refusal to account for a massive year-over-year growth in the number of responses in this ICR, even after repeated requests to do so, is particularly troubling. The ICR Statement provided only FY 2007 data. The PTO expected OMB to approve information collection with paperwork burdens that, according to available evidence (Figure 2), grow by more than 35% per year. At this rate, the number of responses just for the first year of the ICR would be understated by 80%. Actual responses for the third year (2011) would be triple those for which the PTO seeks clearance. It is possible that the PTO can provide a reasonable model that supports a lower growth rate than 35%, but it has refused to disclose it, despite its admission that it has developed such models (see FOIA Req. Nos. 1-4). This ICR seeks clearance for paperwork burdens over the years 2009-2011. But a compliant ICR must properly account for projected year-over-year burden growth when the agency is aware of growth trends and is projecting that the number of responses will grow. Other agencies do so even when projected growth in responses is as small as 5% per year.<sup>24</sup>

---

<sup>20</sup> 73 Fed. Reg. 32972 at Col. 2.

<sup>21</sup> Ron Katznelson, ICR Notice comments, *ICR 0651-00xx, Request for Comment on Board of Patent Appeals and Interferences Actions under the Paperwork Reduction Act*. (August 8, 2008).

At <http://www.reginfo.gov/public/do/DownloadDocument?documentID=87052&version=0>

<sup>22</sup> *Id.* at Paragraph 6.

<sup>23</sup> David Boundy, ICR Notice comments, *Information Collection Comment, ICR 0651-00xx*. (August 17, 2008), at pages 2, 43. At <http://www.reginfo.gov/public/do/DownloadDocument?documentID=87036&version=0>.

<sup>24</sup> C.f. U.S. Environmental Protection Agency, Supporting Statement for the Information Collection Request for NPDES Regulatory Revisions for Concentrated Animal Feeding Operations (Supplemental Notice of Proposed Rulemaking), March 2008, EPA ICR No. 1989.05. See tables at pages 11, 18, 20, 23, 24, A-1, A-2, B-1, B-2, C-1.

At <http://www.regulations.gov/search/redirect.jsp?objectId=09000064803f1cf1&disposition=attachment&contentType=pdf>.

## 2.2 PTO's duplicative information collection violations have been in place at least since 2004 and should be stopped now

A simple concept that leaves no room for any nuance or deference for accepting PTO's violations is the PRA requirement for minimizing duplicative information collection. The PTO's appeal regulations failed to comply with this law since 2004. The duplicative collections have been listed in prior comments<sup>25</sup> and the issue was directly raised in responding to the 2007 Appeal NPRM (See comments by Boundy<sup>26</sup>, Belzer<sup>27</sup> and Katznelson<sup>28</sup>) and the ICR Notice.<sup>29</sup>

44 U.S.C. § 3506(c) provides:

“With respect to the collection of information and the control of paperwork, each agency *shall* -

(3) *certify* (and *provide a record supporting such certification*, including public comments received by the agency) that each collection of information submitted to the Director for review under § 3507--

(A) is *necessary* for the proper performance of the functions of the agency, including that the information has practical utility;

(B) is *not unnecessarily duplicative* of information otherwise reasonably accessible to the agency;” (Emphasis added)

OMB's implementing regulation in C.F.R. § 1320.5(d)(1) provides that in order to comply with this law, “an agency *shall demonstrate* that it has *taken every reasonable step* to ensure that the proposed collection of information:

“(i) Is *the least burdensome necessary* for the proper performance of the agency's functions to comply with legal requirements and achieve program objectives;

(ii) Is *not duplicative* of information otherwise accessible to the agency; “  
(Emphasis added)

While admitting that it proposes to collect duplicative information,<sup>30</sup> the PTO not only failed to “demonstrate that it has taken every reasonable step to ensure that the proposed collection of information is not duplicative” but it ignored comments *specifically suggesting such reasonable steps*. For example, parties have suggested in public comments that the extensive requirement that appellants reproduce papers that are readily available to the examiner and the BPAI by way of the PTO's Image File Wrapper (“IFW”) could be eliminated if the PTO permitted appellants to simply identify and tabulate the location of existing evidence documents in the PTO's IFW document database.<sup>31</sup>

---

<sup>25</sup> David Boundy ICR Notice Comments, note 23 at 8-9.

<sup>26</sup> David Boundy 2007 Appeal NPRM letter at 34-35.

At <http://www.uspto.gov/web/offices/pac/dapp/opla/comments/bpai/boundy.pdf>

<sup>27</sup> Richard Belzer, letter to Susan Dudley re Information Collection Request 0651-0031 (January 16, 2008), at page 17, at <http://www.reginfo.gov/public/do/DownloadDocument?documentID=57744&version=1>

<sup>28</sup> Ron Katznelson NPRM Comments, note 18 at page 18.

<sup>29</sup> David Boundy ICR Notice Comments, note 23 at 8-9; Intellectual Ventures Comments, at 17. At <http://www.reginfo.gov/public/do/DownloadDocument?documentID=87028&version=0>.

<sup>30</sup> ICR Statement at 5 (“This collection does, in part, solicit data already available at the USPTO, in that certain copies of evidence may have been submitted earlier as part of the patent examination process.”); ICR Statement at 13 (“The appendix requirements of rules 41.37(t) and (u) mean that in some instances the applicant will submit duplicate information that is reasonably accessible to the agency.”)

<sup>31</sup> IPO's Comments, page 5, at <http://www.uspto.gov/web/offices/pac/dapp/opla/comments/bpai/ipo.pdf>; IBM's Comments page 6, at <http://www.uspto.gov/web/offices/pac/dapp/opla/comments/bpai/ibm.doc>.

This simple suggestion does not only reduce unnecessary burdens, but it also promotes effective and standardized use of the PTO's electronic information system, as required by E-Government initiatives. (See Section 2.2.1). Appendix 2 shows an example of a patent application's recent prosecution record in the PTO's electronic IFW database available online within the PTO and to the public. As this listing shows, documents are stored and identified using four immediately visible fields. Consequently, a tabulation these four identifying attributes (Date, Document Code, Description and Page Count) along with internal identifiers such as author name, document subject heading or patent number and specific range of page-numbers, can uniquely identify an item that the PTO would otherwise require to be reproduced in an appendix. In contrast, the PTO's rule requires that appellants:

- (a) Print the items from the IFW or their own document system;
- (b) Make photocopies of the printout;
- (c) Apply page numbers in *paper form* in an appendix, and
- (d) Submit them by mail so that the PTO can scan them into electronic form again; and
- (e) Subject them, as third-generation photocopies, to the IFW Indexing & Scanning Operations' readability quality check (see Appendix 3), and return illegible duplicates to appellants with a "Notice of Non-Complying Appeal Brief"); and
- (f) Insert them as another duplicative document in the PTO IFW database.

The record of the application under appeal in the IFW example of Appendix 2 shows how the duplicative collection requirements under the current 2004 rule resulted in unnecessary duplicative and impaired record in the IFW. In this case, an appeal brief was submitted, as can be identified in Appendix 2 by the following four-field designators:

[Mail Room Date: **03-28-2007**, Document Code: **AP.B**, Description: **Appeal Brief Filed**, Page Count: **47**]

This 47-page appeal brief document includes in its Evidence Appendix a 13-page UK patent reference that was cited in prosecution and was already in the record (bottom of the list) as designated by

[Mail Room Date: **04-13-2006**, Document Code: **FOR**, Description: **Foreign Reference**, Page Count: **13**]

Upon inspection of this UK patent document as duplicated in the Evidence Appendix record of 03-28-2007, one finds that it is of lower quality and that PTO's IFW Indexing & Scanning Operations Office found defects in the "original" copy it received, as indicated by the appended Defective Image Problem Report shown in Appendix 3. It states:

"Defective images within this image are accurate representation of the original documents submitted by the applicant. **IMAGES ARE BEST AVAILABLE COPY**. As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox."

Moreover, in this case however, rescanning could have actually corrected an additional *unreported* cropping defect introduced by PTO scanning. The second page in the duplicated UK patent has numbers that are cropped at the top of the page. Evidently, the current rules not only impose unnecessary duplicative collection of records but the resulting duplicative records are defective and are *in the same database*. Furthermore, because the IFW is made available to the public on the Internet, now the PTO not only engages in duplicative information collection that is unnecessarily burdensome for the public and its own IFW operations, but it also engages in duplicative information *dissemination*. (See Section 2.2.1). This process and its attendant

burdens on the public and the government *is precisely* what Congress sought to eradicate by enacting the PRA and its related legislation.

If the aforementioned commenting parties' suggestion of document identification rather than duplication is somehow incompatible with what the PTO called, the "judicial economy" at the BPAI, then how about prescribing that such duplication would only be required for briefs that *actually reach the BPAI*? That suggestion was also made in public comments.<sup>32</sup> As Figure 2 shows, approximately 80% of appeals would not require such duplication in an appendix. Clearly, the PTO could have considered this suggested step by amending its proposed rules to require the extensive appendix only at the time of the submission of a Reply Brief.

Ignoring the aforementioned proposals for reducing duplicative collection, the PTO merely stated in the ICR Statement's section on the "Efforts to Identify Duplication" as follows:<sup>33</sup>

"This collection does, in part, solicit data already available at the USPTO, in that certain copies of evidence may have been submitted earlier as part of the patent examination process. The duplication of effort is limited, however, and the agency *considers it necessary*. In order to be clear as to the evidence, copies of evidence relied on in the appeal need to be filed with the brief. While the copies of evidence required by the appendix may be duplicates of evidence already in the file, the necessity of *absolute clarity* as to the evidence relied on *outweighs the burden on the public*." (Emphasis added).

This unavailing explanation belies reality. The PTO not only refused to answer the specific proposals it received for avoiding duplicative information collection, but it also failed to explain why its record identification system for the IFW document database would not permit *absolute clarity* as to the record relied on as evidence. It also failed to explain why it adopted an IFW system that, according to the PTO, does not permit such clarity. On page 13 of the ICR Statement, the PTO only makes unsupported assertions of "judicial economy" at the BPAI without ever identifying any step that it considered taking in order to avoid this duplication. See FOIA Req. No. 33-35 for my requests for supporting information.

In addressing duplicative information collection in its 2008 Final Appeal Rules, the PTO stated that it does "not require the collection of information beyond what is already required by the current rules". (73 FR 32955, Col. 3). Even if this statement is true, information PTO collects under the current rule have had duplicative collection violations of § 3506(c)(3)(B) that go as far back as 2003. As discussed in Section 2.1.2, although the PTO initiated new information collection by adopting its 2004 Final Appeal Rule, it made no certification for, nor received any OMB clearance for such collection, let alone for duplicative collection. It did not even attempt to comply, or argued to have complied with 44 U.S.C. § 3506(c). As Figure 2 shows, these prior PRA violations now have far reaching consequences in burdens of magnitudes that dwarf those of 2003.

---

<sup>32</sup> *Id.* IPO's Comments, page 5 (suggesting that at the time an appeal is transferred to the BPAI, an appendix could be assembled in any format the BPAI finds useful as it considers the appeal. IPO also suggested that the PTO should bear the burden of doing so).

<sup>33</sup> ICR Statement at 5.

### 2.2.1 *The 2004 and 2008 Final Appeal Rules’ duplicative collection of information contravene the purposes and goals of the Government Paperwork Elimination Act of 1998 and the E-Government Act of 2002*

The Government Paperwork Elimination Act of 1998<sup>34</sup> and OMB’s related implementing Circular No. A-130<sup>35</sup> at § (8)(b)(1)(b)(x) requires agencies to “[e]nsure that the selected [Information Technology] system or **process** [used by the agency for collecting, storing or disseminating information] maximizes the usefulness of information, minimizes the burden on the public and preserves the appropriate integrity”, and that agencies “specifically address the planning and budgeting for the information collection burden imposed on the public as defined by 5 CFR 1320”. In § (8)(b)(1)(b)(ix) the Circular states that agencies **must** “[e]nsure that improvements to existing information systems and the development of planned information systems do not **unnecessarily duplicate** IT capabilities”. Unfortunately, the PTO took no step to “minimize the burden on the public, and preserve the appropriate integrity” of data records and therefore, its rules result in assembling elements from the Evidence Appendix of appeal briefs in a manner that “unnecessarily duplicate” IT capabilities.

The example shown in Appendix 2 is typical of the very situations and instances that the initiatives enacted in The E-Government Act of 2002<sup>36</sup> sought to avoid. The pertinent purpose articulated in § 212(a)(2) of this Act is to “assist the public, including the regulated community, in electronically submitting information to agencies under Federal requirements, by **reducing the burden of duplicate collection and ensuring the accuracy of submitted information**”. In embarking on initial steps for implementing the E-Government Act of 2002, Congress stated that one of its goals is to “reduce information collection burdens by **eliminating duplicative data elements within 2 or more reporting requirements**”. § 212(d)(2)(B). As demonstrated in Section 2.2 above, the PTO’s appeal rules (the current as well as the new) fundamentally contravene these purposes and goals. It is the responsibility of the CIO of the U.S. Commerce Department under the PRA and the E-Government Act of 2002 to ensure that PTO appeal rules are withdrawn and are amended to comply with the law.

## 2.3 OMB must hold PTO to its Information Quality Act Obligations

Congress enacted the Information Quality Act<sup>37</sup> (“IQA”) for ensuring and maximizing the quality, objectivity, utility, and integrity of information (including statistical information) disseminated by Federal agencies in fulfillment of the purposes and provisions of the Paperwork Reduction Act. Thus, the PTO is obligated under the IQA to undertake its collection,

---

<sup>34</sup> Pub. L. 105-277, Title XVII.

<sup>35</sup> OMB, “Management of Federal Information Resources”, Circular No. A-130. *See* § (8)(b)(1)(b) (Agencies **must** (ix) “[e]nsure that improvements to existing information systems and the development of planned information systems do not **unnecessarily duplicate** IT capabilities within the same agency... “ and (x) “[e]nsure that the **selected system or process** maximizes the usefulness of information, **minimizes the burden on the public, and preserves the appropriate integrity**, usability, availability, and confidentiality of information throughout the life cycle of the information, as determined in accordance with **the PRA** and the Federal Records Act.”; § (8)(a)(5)(d) In determining whether and how to disseminate information to the public, agencies will: (i) Disseminate information in a manner that achieves the best balance between the goals of **maximizing the usefulness** of the information and **minimizing the cost to the government and the public**;

<sup>36</sup> Public Law 107-347, 44 USC § 3501 note.

<sup>37</sup> 44 U.S.C. § 3516 note, *Treasury and General Government Appropriations Act for Fiscal Year 2001*, Pub. L. No. 106-554, § 515 (2001).

production, generation, *analysis and dissemination* of its information under certain quality standards that the OMB established in its guidelines for agencies.<sup>38</sup>

Entrusted by Congress to supervise all agencies' IQA compliance, OMB specifically recognized the requirement for agencies' adherence to the IQA when discharging their obligations under the PRA. Accordingly OMB stated in its publication of the IQA rules as follows:

"Given the administrative mechanisms required by [the IQA] as well as the standards set forth in the Paperwork Reduction Act, it is clear that agencies should not disseminate substantive information that does not meet a basic level of quality. ... The more important the information, the higher the quality standards to which it should be held". (67 FR 8452, Col. 3). ... "[A]gencies ***must make their methods transparent by providing documentation***, ensure quality by reviewing the underlying methods used in developing the data and ***consulting*** (as appropriate) with ***experts and users***, and keep users informed about corrections and revisions". (67 FR 8453, Col. 2, emphasis added).

Pursuant to OMB directives, the PTO has subsequently established its agency-specific information quality guidelines<sup>39</sup>, ("IQA Guidelines"). The PTO undertook the obligation that "Effective October 1, 2002, information disseminated by the USPTO will comply with all applicable OMB and (these) USPTO information quality guidelines".<sup>40</sup> The PTO adopted OMB standards for information quality wherein the term "quality" is an encompassing term comprising *utility*<sup>41</sup>, *reproducibility*<sup>42</sup> and *objectivity*<sup>43</sup>.

### *2.3.1 PTO's Information Published to Support its Information Collection Requests is Subject to the IQA. Most of this Information is "Influential Information"*

It is clear that the information used in the ICR Statement is agency-initiated dissemination of information which, by PTO's own definition, is subject to the IQA:

---

<sup>38</sup> Office of Management and Budget, "Guidelines for Ensuring and Maximizing the Quality, Objectivity, Utility, and Integrity of Information Disseminated by Federal Agencies; Notice; Republication, [67 Fed. Reg. 8452-8460, \(Feb. 22, 2002\)](#)."

<sup>39</sup> PTO, "Information Quality Guidelines," online at <http://www.uspto.gov/web/offices/ac/ido/ifoqualityguide.html> .

<sup>40</sup> *Id.*

<sup>41</sup> "Utility" refers to the usefulness of the information to its intended users, including the public. In assessing the usefulness of information that the agency disseminates to the public, the agency considers the uses of the information not only from its own perspective but also from the perspective of the public (*Id.* § IV(A)6(b)).

<sup>42</sup> "Reproducibility" means that the information is capable of being substantially reproduced, subject to an acceptable degree of imprecision. For information judged to have more (less) important impacts, the degree of imprecision that is tolerated is reduced (increased). With respect to analytical results, "capable of being substantially reproduced" means that independent analysis of the original or supporting data using identical methods would generate similar analytical results, subject to an acceptable degree of imprecision or error (*Id.* § IV(A)7).

<sup>43</sup> Objectivity" involves two distinct elements, presentation and substance. The presentation element includes whether disseminated information is being presented in an accurate, clear, complete, unbiased manner, and within a proper context. Sometimes, in disseminating certain types of information to the public, other information must be disseminated in order to ensure an accurate, complete, and unbiased presentation. Sources of the disseminated information (to the extent possible, consistent with confidentiality protections) and, ***in a scientific, or statistical context, the supporting data and models need to be identified, so that the public can assess for itself whether there may be some reason to question the objectivity of the sources.*** Where appropriate, supporting data shall have full, accurate, transparent documentation, and error sources affecting data quality shall be identified and disclosed to users. The substance element focuses on ensuring accurate, reliable, and unbiased information. In a scientific, or statistical context, the original or supporting data shall be generated, and the analytical results shall be developed, using sound statistical and research methods. If the results have been subject to formal, independent, external peer review, the information can generally be considered of acceptable objectivity (*Id.* § IV(A)6(a), emphasis added).

“Agency initiated distribution of information to the public” refers to information that the agency distributes or releases which reflects, represents, or forms *any part of the support of the policies of the agency*. In addition, if the agency, as an institution, distributes or releases information prepared by an outside party in a manner that reasonably suggests that the agency agrees with the information, this would be considered agency initiated distribution and hence agency dissemination because of the appearance of having the information represent agency views”.<sup>44</sup> (Emphasis added).

Much of the statistical information pertaining to appeals in the ICR Statement relates to public policies regarding agency proceedings that are pivotal to applicants’ ability to secure key valuable private patent rights, which are central to their business decisions. Therefore it is “Influential Statistical Information” because it is “information that will have or does have a clear and substantial impact on important public policies or important private sector decisions”.<sup>45</sup>

As directed by OMB, PTO’s IQA Guidelines commit the PTO to objectivity standards for Influential Information that it disseminates, requiring that it be *reproducible*. The PTO states that its IQA standards support reproducibility of analytic results and “*when asked the USPTO does provide disclosure of the data sources that have been used and the specific quantitative methods and assumptions (if any) that have been employed*”.<sup>46</sup> (Emphasis added). But in this case, when the PTO was asked to “*provide disclosure of the data sources that have been used and the specific quantitative methods and assumptions that have been employed*” in the estimates of the ICR Statement, the PTO violated the IQA by refusing to do so.

Most, if not all, factual assertions made by the PTO in support of the claimed benefits of its 2008 Final Appeal Rule lacked any support in the record and the PTO ignored essentially all requests to provide such support. Several unsupported PTO assertions for which the public requested support in comments to the ICR Notice are listed in FOIA Req. Nos. 2-4, 21, 23, 25-35 (Appendix 1).

### 2.3.2 Faulty analytical methods

The PTO failed to use established quantitative methods, as it must under the IQA, for estimating burdens. Moreover, because of its refusal to disclose its sources and methods, such errors in analysis were only detected after the comment period. For example, the PTO uses statistical *medians* to estimate information collection burdens, (ICR Statement: Median hourly rate at 15). But the PRA requires estimates of burden on *the public* (in total) - not burdens estimated based on the 50<sup>th</sup> percentile of the public. Estimating the total burdens requires that the *average* burden (not the median) be multiplied by the number of all responses. This is crucial here because the burden-hour distribution is highly skewed such that the *mean (average) is considerably greater than the median* – a fact that the PTO knows very well. Information collection burdens must be accounted for *all* response not just for typical responses. For a total of  $N$  respondents each having possibly different costs or burdens, wherein the burden for the  $k^{\text{th}}$  respondent is designated by  $b_k$ , the total burden for *all* responses is easily shown below:

$$\text{Total burden} = \sum_{k=1}^N b_k = N \times \frac{1}{N} \sum_{k=1}^N b_k = N \times (\text{Average Burden})$$

---

<sup>44</sup> *Id.* § IV(A)(1)(a).

<sup>45</sup> *Id.* § IV(A)(3).

<sup>46</sup> *Id.* § VII(A)



On page 15 of the ICR Statement, the PTO states the following: “The agency believes the median figure is an appropriate figure upon which to base estimates given that attorneys charging above the median and below the median would be expected to participate in the appeal process”.

The agency is technically and legally wrong and its reasoning is clearly nonsensical. It is technically wrong because attorneys who craft appeals charge rates that come from the upper end of the hourly-rate distribution. It is legally wrong because the law calls for averages, not medians. The fact that half of all patent attorneys charge below the median and half charge above it, is true but irrelevant.

The PTO would not have to “invent” new illegal methods for estimating burdens if it simply read and followed OMB’s regulations. 5 CFR 1320.8(b)(3)(iii) requires that agencies provide “[a]n estimate, to the extent practicable, of the *average* burden of the collection (together with a request that the public direct to the agency any comments concerning the accuracy of this burden estimate and any suggestions for reducing this burden)” (emphasis added).

In a further violation of the PRA and the IQA, the PTO “forgot” that it should be accounting for future burdens and not 2006 burdens. The AIPLA survey, which the PTO cited as its billing rate source, reported the 2006 billing rates, which the PTO used for estimating burdens in 2009-2011. Appropriate annual increases must be factored as well. Moreover, the PTO’s citation of parties’ comments on billing rates (particularly my own estimates) is not directly pertinent. My estimate for the blended billing rate of a paralegal and a senior patent attorney was based on the *incremental* burden of the new rules that require a greater proportion of paralegal work as compared to the full burden of an appeal. If the PTO insists on using the billing rate for all attorneys, it should use the average of such rates, corrected for annual increases from 2006 to 2009-2011. Finally, the number of responses must be those projected for 2009-2011, as further discussed in Section 2.1.

### *2.3.3 The PTO misapprehends the requirements of the IQA and its own IQA Guidelines*

One of the clear examples that the PTO intends to ignore the IQA and PTO’s obligations under 5 C.F.R. § 1320.8(a)(4), is its “response” to serious comments challenging the PTO to provide objective support for its estimates. The following is on page 15 of the ICR Statement:

“Comment 7: Several comments were received which question the accuracy of and the factual basis on which agency estimates were made. ...

Answer 7: The agency believes that it has objective factual support for its estimates. Moreover, some of the comments support USPTO’s estimates.”

This type of blatant non-response clearly shows that PTO’s failure to provide a record of objective support is not inadvertent but deliberate. Moreover, the PTO appears to have forgotten that its reliance on “some of the comments support USPTO’s estimates” is an agency endorsement of third party information, which is therefore also subject to the IQA. The OMB should not let the PTO get away with these deliberate and blatant IQA violations.

### 3 CONCLUDING RECOMMENDATIONS TO OMB

The PTO has thwarted the PRA's substantive goals by violating its procedural requirements. The OMB is the last stop for the appeal rules before the PTO continues on a massive and illegal expropriation of valuable patent property rights, which would harm American innovation for years, continuing even well after these draconian rules are repealed in the future.

#### 3.1 Disapprove the ICR and direct PTO to comply with the Paperwork Reduction Act

I have been working diligently to provide OMB with informed and constructive public comments concerning the likely merits (if any) and burdens imposed by the new appeal rules, but I have been handicapped by PTO's unwillingness to document the basis for its estimates and its unwillingness to provide enough information to develop accurate independent estimates. My FOIA request to the PTO (FOIA Req., Appendix 1) lists the information that I, *or any other independent party*, would need in order to develop informed independent burden estimates. I urge OMB to expedite a resolution by demanding that the PTO produce this information as soon as possible, that the PTO *provide* the record as required by § 3506(c)(3), and that OMB *not approve any burden estimates that have not been independently vetted* to assure that they accurately reflect the true consequences of the rules. For that purpose, the following requests are particularly urgent and of high priority: FOIA Req. Nos. 1-7 and 30.

#### 3.2 Encourage the U.S. Department of Commerce to Administratively Stay the PTO's 2008 Final Appeal Rule and Undertake Immediate PRA Compliance Steps to Amend Even Its Existing Rules

While OMB had not been informed of these violations until recently, the relative obscurity of the duplicative information collections is quickly replaced by visible massive increases in such burdens, as indicated in Figure 2. As further explained in Section 2.2, OMB should not let stand any agency rules that have violated the PRA since 2004. The PTO must go back to basic principles. It should follow the law and OMB's regulations in crafting its appeal rules by diligently and genuinely working with the public to devise workable approaches for minimizing paperwork burdens. This is not merely a question of whether the new provisions in the 2008 Final Appeal Rule should be enforced. Of course they should not be enforced in their current form. Rather, this is about massive agency process failure that collaterally imposes paperwork burdens in the order of several hundred million dollars per year, growing exponentially by more than 35% per year. This effort is no longer a matter for stealth PTO rulemaking. OMB must scrutinize the rulemaking process and ensure that extreme care is exercised in protecting the public while enabling the PTO to do its important job.

The PTO may say that if OMB disapproves the ICR, the appeal process would either grind to a halt or be overcome by chaos. The evidence belies any such claims. First, the BPAI handled more appeals per year in the mid 1990's in absolute terms and double in relative terms, given the number of filed applications from which appeals arise. Second, there is no crisis in appeals *reaching the BPAI* that cannot be addressed by better management and supervision of the examination corps. The rising number of appeals at the PTO is the result of a rising number of meritorious patent applications being rejected. It was predictable from the outset that if PTO management were to order the examination corps to reduce its allowance rate for the sake of reducing it, the number of appeals would skyrocket.

Third, chaos will not occur because PTO has been operating its appeal function for decades without ever having sought OMB approval of its paperwork burdens. The patent community respected PTO's need for much of the information it sought in the past. Like the PTO, appellants desire an orderly and predictable appeal process. OMB should therefore let the PTO continue to operate under the 2004 appeal rules, while it engages in a thorough new and legal rulemaking proceeding to replace the 2004 rules. OMB should insist that, this time, the U.S. Department of Commerce be directly involved with the rulemaking process.

In sum, if the PTO were to administratively stay the 2008 Appeal Rules pending a bottom-up adherence to proper procedure and rulemaking, *no adversity would ensue* for the BPAI. That is the best course of action for the patent community – and, yes, it is also the best for the PTO. The first thing the Patent Office must do to get out of the hole it has dug for itself, is to stop digging.

Respectfully submitted by

A handwritten signature in black ink, appearing to read "Ron Katznelson". The signature is fluid and cursive, with the first name "Ron" being more prominent than the last name.

Ron D. Katznelson, Ph.D.

Encinitas, CA

Office: (760) 753-0668

Mobile: (858) 395-1440

[rkatznelson@roadrunner.com](mailto:rkatznelson@roadrunner.com)

**APPENDIX 1**  
FOIA request filed with USPTO

By Email: [efoia@uspto.gov](mailto:efoia@uspto.gov)  
FOIA Officer,  
United States Patent and Trademark Office,  
Alexandria, Virginia 22313-1450

November 17, 2008

**Re: Freedom of Information Act Request - Materials Relating to the Patent Appeal Process**

Dear FOIA Officer:

I am an inventor and an independent scholar of the U.S. patent system, writing on my own behalf and not on behalf of any for-profit entity. Under the Freedom of Information Act, 5 U.S.C. § 552, I respectfully request the following information.

**DEFINITIONS AND INSTRUCTIONS**

The term “document” includes all articles or electronically-stored information as construed under Federal Rule of Civil Procedure 34(a)(1)(A). A draft or non-identical copy is a separate document within the meaning of this term. The term “document” also includes any study, summary, memorandum, communication, recommendation, guideline, review, report, summary, notes, email, transcript, presentation, audio recording or video recording, briefing, electronic computer spreadsheet, software, mathematical or policy model.

The term “concerning” means relating to, referring to, describing, evidencing or constituting. The term “concerning,” with respect to a document or information developed with assistance of any computer software or mathematical model, includes the software or model, data input to the software or model, and documents explaining the internal and user-level operation of the software or model. Output from the model, without the materials requested in the previous sentence, is not a complete reply. The term “concerning” includes all information relating to the matter, including assumptions. “Concerning” includes all documents reflecting information used as inputs to the matter, and all documents reflecting the conclusions reached in the matter.

The term “appeal” relates to patent appeals filed under 35 U.S.C. §§ 134 or 306.

"And" and "or" as used herein shall be construed both conjunctively and disjunctively in order to bring within the scope of this request any document that would otherwise not be brought within its scope.

The term “2003 Appeal NPRM” is the Notice of Proposed Rulemaking published at 68 Fed. Reg. 66648 on November 26, 2003.<sup>1</sup>

The term “2004 Final Appeal Rule” means the final rule published at 69 Fed. Reg. 49960 on August 12, 2004, and the rules that came into effect as a result of that notice.<sup>2</sup>

---

<sup>1</sup> PTO, *Rules of Practice Before the Board of Patent Appeals and Interferences, Proposed Rule*. [68 Fed. Reg. 66648](#) (November 26, 2003).

<sup>2</sup> PTO, *Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule* [69 Fed. Reg. 49960](#) (August 12, 2004).

The term “2007 Appeal NPRM” is the Notice of Proposed Rulemaking published at 72 Fed. Reg. 41472 on July 30, 2007.<sup>3</sup>

The term “2008 Final Appeal Rule” means the final rule published at 73 Fed. Reg. 32938 on June 10, 2008 and the rules that came into effect as a result of that notice.<sup>4</sup>

The term “ICR” means the Information Collection Request under the Paperwork Reduction Act having an ICR reference number 200809-0651-003<sup>5</sup> that the PTO filed with the Office of Management and Budget (“OMB”) on October 9, 2008.

The term “ICR Notice” means the notice published in 73 Fed. Reg. 32559 on June 9, 2008<sup>6</sup> regarding PTO’s information collection clearance request from OMB.

The term “ICR Statement” means the supporting statement often referred to as OMB 83-I statement, as submitted with the ICR to OMB<sup>7</sup>.

The term “September ‘07 ICR” means the Information Collection Request under the Paperwork Reduction Act having an ICR reference number No. 200707-0651-005<sup>8</sup> that the PTO filed with the OMB under control number 0651-0031 on September 26, 2007.

To avoid information duplication and to reduce administrative burdens, I request that you omit any portions of documents that are available on the publicly available sections of government web sites or published in the Federal Register or another freely-available source, provided that you supply a correct URL or citation from which the document can be obtained and provided that the validity of any such URL is verified during the preparation of your response hereunder.

Please provide all requested information that exists in electronic form in its native electronic form. Providing only images of such information is not compliant with the directives of Rule 34<sup>9</sup> or with the statutory requirements for agency replies to FOIA requests.<sup>10</sup> To the

---

<sup>3</sup> PTO, *Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals*, Proposed Rule, [72 Fed. Reg. 41472](#), (July 30, 2007).

<sup>4</sup> PTO, *Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals*, Final Rule, [73 Fed. Reg. 32938](#), (June 10, 2008).

<sup>5</sup> PTO, *Board of Patent Appeals and Interferences (BPAI) Actions*. Type of Information Collection: New collection (Request for a new OMB Control Number).

At [http://www.reginfo.gov/public/do/PRAViewICR?ref\\_nbr=200809-0651-003#section0\\_anchor](http://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=200809-0651-003#section0_anchor)

<sup>6</sup> PTO, *Board of Patent Appeals and Interferences Actions, New collection; comment request*, [73 Fed. Reg. 32559](#), (June 9, 2008).

<sup>7</sup> At <http://www.reginfo.gov/public/do/DownloadDocument?documentID=89627&version=0>.

<sup>8</sup> [http://www.reginfo.gov/public/do/PRAViewICR?ref\\_nbr=200707-0651-005](http://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=200707-0651-005)

<sup>9</sup> *Jicarilla Apache Nation v. U.S.*, 60 Fed. Cl. 413, 416 (Fed. Cir. 2004) (Under the general provisions of Federal Rule of Civil Procedure 34, the responding party must produce the discovery “in the **format in which that party routinely uses or stores them**, provided that electronic records shall be produced along with available technical information necessary for access or **use thereof**.”); *U.S. v. First Data*, 287 F. Supp. 2d 69, 71 (D.D.C. 2003) (ordering production of “electronic documents[] in **the native electronic format** (or a mutually agreeable format)”). (Emphasis added).

extent that the disclosable requested tabulations, mathematical models, calculations, analysis or computer software are embedded in electronic spreadsheets, please provide the native electronic form of such spreadsheets in their entirety. Providing merely a printout image of such spreadsheets without also including their native electronic files would not be responsive to this request because it would fail to provide the “software” requested hereunder and because it would remove the embedded cell relationships which may contain cell-reference links and embedded equations, frustrating a purpose of this request for model verification and reproducibility.

If this request is denied in whole or in part, I ask that, consistent with the burden on “the agency to sustain its action”, 5 U.S.C. § 552(a)(4)(B), you provide a *Vaughn* index<sup>11</sup> of withheld information by (1) identifying each information segment withheld, by the numerical index below; (2) stating the statutory exemption claimed; and (3) explaining how disclosure of each withheld information segment would damage the interests protected by the claimed exemption. See, e.g., *Hall v. DOJ*, 552 F. Supp. 2d 23, 27-31 (D.D.C. 2008); *Kimberlin v. DOJ*, 139 F.3d 944, 950 (D.C. Cir. 1998). Please notify me of appeal procedures available under the law.

If no document exists for any enumerated request or subpart, please affirmatively so state. If some responsive documents are readily available and others may be delayed, kindly produce the readily available documents promptly.

Please email the requested documents to my address at [rkatznelson@roadrunner.com](mailto:rkatznelson@roadrunner.com). To the extent that the size of your response exceeds 10 Mbytes, please divide it into multiple parts and send multiple sequentially numbered messages with attachments that do not exceed 10 Mbytes per message.

The above instructions do not in any way limit the scope of this request.

## REQUESTS

### 1 PATENT APPEAL WORKLOAD ESTIMATES AND PROJECTIONS

1. On February 22, 2006, the PTO budget request document for FY 2007<sup>12</sup> stated:

“[D]uring fiscal year 2007, the Board of Patent Appeals and Interferences (BPAI) *anticipates it will begin to receive an increased level of appeals* following continuation rulemaking to bring greater finality to patent application prosecution. Based on *existing assumptions*, the office anticipates BPAI’s appeal workload to *increase by approximately one-third*. Therefore, in order to maintain a level of timeliness in appeal processing while initializing post-grant review, the office *estimates an increase* of 10 APJ’s [Administrative Patent Judges], or other legal professionals, and seven paralegals to support continuation reform”.<sup>13</sup> (Emphasis added).

Please provide all documents (including models, assumptions and software) concerning future number of patent appeals likely to be filed with the PTO, used in preparing the FY 2007

---

<sup>10</sup> 5 U.S.C. § 552(a)(2)(E) (“For records created on or after November 1, 1996... each agency shall make such records available, including by computer telecommunications or... by other electronic means.”).

<sup>11</sup> *Vaughn v. Rosen*, 484 F.2d 820, 827-28 (D.C.Cir.1973) (outlining requirements agency must meet in indexing documents for which it claims exemption from disclosure under FOIA).

<sup>12</sup> USPTO 2007 Budget. At <http://www.uspto.gov/web/offices/ac/comp/budg/fy07pbr.pdf>

<sup>13</sup> USPTO 2007 Budget, note 12 at 32.

budget request document. In particular, please provide all documents concerning the statements set forth above in bold including such information, models and software related to the required number of APJ's and paralegals and the assumptions used to project these numbers. If PTO developed appeal projections for both the case in which the Continuations/Claims rules go into effect and the case in which they do not, kindly provide documents concerning both cases.

2. In the 2007 Appeal NPRM, the PTO states: "In FY 2007, the Board *expects* to receive more than 4,000 ex parte appeals. In FY 2008, the Board *expects* to receive over 5,000 ex parte appeals". (72 FR 41472, col. 2, emphasis added). Please provide all documents (including models, assumptions and software) concerning these two expectations.

3. In the 2008 Final Appeal Rule, the PTO states: "In FY 2008, the Board *expects* to receive more than 6000 ex parte appeals". (73 FR 32938, Col. 2). The PTO further said: "it also must be recognized that the number of appeals is *expected to rise significantly* in the near future". (73 FR 32958, Col. 2, emphasis added). Please provide all documents (including models, assumptions and software) concerning these expectations and statements.

4. On page 7 of the ICR Statement, the PTO stated that "In FY 2008, the Board *expects* to receive more than 6000 ex parte appeals" (Emphasis added). Please provide all documents (including models, assumptions and software) concerning these statements.

5. Please provide all documents (including models, assumptions and software) concerning all numerical estimates submitted in the ICR Statement.

6. Please provide all documents (including models, assumptions and software) concerning paperwork burden projections associated with appeal rules for each year covered by the ICR (2009, 2010 and 2011). If PTO developed projections for both the case in which the new Continuations/Claims rule goes into effect and the case in which these rules do not go into effect, kindly provide documents concerning both cases.

7. Please provide all documents (including models, assumptions and software) not otherwise included in items 1 to 6 above, concerning analysis or projections covering any period in FY 2005 through FY 2011, of the numbers of appeal briefs and appeal reply briefs to be filed or actually filed (including pre-appeal briefs, appeal briefs filed with the appeal conference before the appeal is docketed by the Board).

## **2 INFORMATION QUALITY ACT (IQA) AND PAPERWORK REDUCTION ACT (PRA) PROCEDURES**

8. Please provide all documents other than PTO's Information Quality Guidelines<sup>14</sup> ("IQA Guidelines") that contain any guidelines, checklists and procedures to be followed in PTO's Information Quality Act's Pre-Dissemination Review described in Section VIII of PTO's IQA Guidelines.

---

<sup>14</sup> PTO, "Information Quality Guidelines," at <http://www.uspto.gov/web/offices/ac/ido/ifoqualityguide.html>, issued pursuant to the IQA, Pub. L. 106-554, Section 515.



9. Please provide all documents that list, identify, classify or determine the information that the PTO considers “Influential Information” within the definitions promulgated by OMB under the IQA.<sup>15</sup>

10. Please provide all information, documents, procedures, guidelines or checklists adopted or used by the PTO’s “Senior Official” or designee as defined in 5 C.F.R. § 1320.7, that describe, embody or establish the information collection review process (including in rulemaking) “that is sufficiently independent of program responsibility to evaluate fairly whether proposed collections of information should be approved under [the PRA]”, 5 C.F.R. § 1320.7(d), (“PRA Review”).

11. Please provide all documents concerning PTO’s decision to initiate accounting for paperwork burdens imposed by appeal briefs and appeal reply briefs and to seek OMB approval under the PRA for such information collection. Please provide all documents (including position papers) concerning communications with OMB regarding the need to rectify PTO’s PRA violations (if any) associated with the failure to obtain information collection clearance from OMB for prior years’ appeal burdens.

12. Please provide all documents containing information considered at any time for inclusion in, but ultimately omitted from, the ICR Notice or from the ICR Statement.

13. Please provide all information and supporting documents considered for the ICR Notice and for the ICR Statement under the Information Quality Act’s Pre-Dissemination Review described in Section VIII of PTO’s IQA Guidelines. Provide all pertinent documents including but not limited to those containing the following:

- (a) Active review of information by supervisors and managers, either by reviewing each individual document, or selected samples, or by any other method.
- (b) Quality checklists, charts, statistics, or other means of tracking quality, completeness, and usefulness.
- (c) Monitoring and checks on information quality.
- (d) Review during information preparation.
- (e) Use of management controls.
- (f) Any other method that serves to enhance the accuracy, reliability, and objectivity of the information.

14. Please provide all documents, information, lists, recommendations, drafts or classification documents that suggest, identify or designate any information component described in the ICR Statement as “Influential Information” or “Influential Statistical Information” under the IQA.

15. Please provide all documents, summaries, reports, recommendations, drafts or position papers that describe or reply to public comments filed in response to the 2007 Appeal NPRM or the ICR Notice. In particular, with respect to information collection responses, provide all documents justifying, instructing or recommending that no projections or adjustments be made

---

<sup>15</sup> Office of Management and Budget, “*Guidelines for Ensuring and Maximizing the Quality, Objectivity, Utility, and Integrity of Information Disseminated by Federal Agencies*”; Notice; Republication, [67 Fed. Reg. 8452-8460, \(Feb. 22, 2002\)](#).

or included in the ICR, ICR Notice or the ICR Statement for the number of appeal responses in the years 2009-2011, the three years covered by the ICR.

16. The PTO estimated in the September '07 ICR that 16,500 Notices of Appeal would be filed by the public annually. This number appears to be the response rate that the PTO estimated for the same item in an ICR three years prior. Indeed, PTO's own data disclosed under FOIA Request No. 06-146 suggests that the aforementioned estimate was unchanged from an old estimate based on FY 2003 appeals data. The '146 FOIA response document reveals that the annual number of Notices of Appeal was 16,545, 17,579 and 18,112 for fiscal years 2003, 2004 and 2005 respectively.<sup>16</sup> By FY 2007, this number reached 27,630, according to the ICR Statement.

16(a). Please provide all documents concerning the IQA Pre-Dissemination Review for the September '07 ICR. Please provide documents sufficient to establish the identity of the "Senior Official" that provided the requisite certification under the PRA in the September '07 ICR. Provide all documents including but not limited to those characterized by any Pre-Dissemination Review steps such as (a)-(f) in request 13. Provide all documents that may justify or explain the use of FY 2003 data in the September '07 ICR.

16(b) PTO's information collection authority for the items listed in the September '07 ICR expired on September 30, 2007. OMB's online records do not show approval of this ICR but it appears that a series of a dozen temporary 30-day extensions might have taken place. Please provide all documents, requests and correspondence with OMB concerning the September '07 ICR and all documents evidencing extensions of information collection authority for items therein.

### **3 APPEAL RULES' PAPERWORK BURDEN ESTIMATES**

17. The PTO is required under 5 C.F.R. § 1320.17 to develop and submit to OMB "an annual comprehensive [Information Collection B]udget for all collections of information from the public to be conducted in the *succeeding* twelve months" ("ICB"). Please provide a copy of PTO's contribution to each such ICB submitted by PTO to OMB (directly or through the Department of Commerce) in the years 2003-2008. Please provide all documents (including models and data) concerning the paperwork burdens associated with PTO ex parte appeal rules that were included, or relied upon for deriving the burden estimates in the ICB reports requested above.

18. In a September 26, 2006 memorandum to agencies, the Administrator of the Office of Information and Regulatory Affairs OIRA ("OIRA") at OMB stated: "... OMB is also reminding you of the importance of the requirement that a senior agency official certify that PRA standards have been met. Specifically, OMB calls on [Chief Information Officers] to review their procedures to ensure that this certification process is robust".<sup>17</sup> Please provide all documents

---

<sup>16</sup> Response to FOIA Request No. 06-146. See PDF page 14 of 35 at <http://docs.justia.com/cases/federal/district-courts/virginia/vaedce/1:2007cv00846/221151/178/2.swf>.

<sup>17</sup> Memorandum for Chief Information Officers from Steven D. Aitken, Acting OIRA Administrator, Appendix C - *Compliance with the Paperwork Reduction Act of 1995*. (September 29, 2006), at page 17. Available at [http://www.whitehouse.gov/omb/inforeg/icb/data\\_call\\_agencies092906.pdf](http://www.whitehouse.gov/omb/inforeg/icb/data_call_agencies092906.pdf).

concerning any review (if any) of “procedures to ensure that [the PRA] certification process is robust” that PTO undertook subsequent to, and in connection with, this memorandum.

19. In a November 8, 2002 memorandum to agencies, OIRA Administrator stated that “agencies must make stronger efforts not only to resolve existing [PRA] violations, but to put into place policies that will prevent future violations from occurring. ... [T]hese plans should be carried out diligently. If the plans are not effective in eliminating new violations, agencies should reevaluate and strengthen their plans. Attention should be given at the highest levels of the agency to assure that agencies are complying with their responsibilities under the PRA”.<sup>18</sup> Please provide all documents (if any) concerning any “reevaluation” or “strengthening” of plans ensuring that the PRA certification process is robust, that PTO undertook subsequent to, and in connection with this memorandum.

20. In a June 6, 2002 memorandum to agencies, OIRA Administrator requested that agencies “[d]escribe the procedures that you (and your agency) have in place to prevent future [PRA] violations, both through your monthly review of OMB’s computer-generated reports and through your general oversight and participation in the agency’s programmatic functions”.<sup>19</sup> Please provide documents containing PTO’s response to this memorandum as sent to OMB (directly or through the Department of Commerce) including the description of procedures that PTO had in place to prevent future [PRA] violations.

21. In the PRA section of the 2007 Appeal NPRM, the PTO states that the collection of information involved in the proposed appeal rule *has been reviewed* and it certified that the PTO was not resubmitting an information collection package to OMB for its review and approval because the proposed rule would not affect information collection requirements (72 FR 41484, Cols. 1-2). Five years ago, in the PRA Section of the 2003 Appeal NPRM, the PTO admitted that “[t]his proposed rule involves information collection requirements which are subject to review by the [OMB under the PRA]” (68 FR 66667, Col.3), but made no statements as to paperwork burdens, made no solicitation, and provided no opportunity or instructions for submitting public comments on paperwork burdens. An identical PRA statement was made in the 2004 Final Appeal Rule.

21(a) Please provide all documents concerning the PRA Review of the 2007 Appeal NPRM, including all documents concerning PTO’s certification in the 2007 Appeal NPRM of no change in PRA burdens. Please provide documents sufficient to establish the identity of the “Senior Official” that provided such requisite certification under the PRA.

21(b) Please provide documents sufficient to establish the identities of all members of the public that the PTO consulted prior to publishing the 2007 Appeal NPRM, to solicit comments with respect to the proposed 2007 Appeal Rule, in order to: (i) evaluate whether these proposed rules are a necessary amendment to the current (2004) appeal rules; (ii) evaluate the

---

<sup>18</sup> Memorandum for Chief Information Officers from Dr. John D. Graham, OIRA Administrator, *Ensuring Full Compliance with the Paperwork Reduction Act*. (November 8, 2002), at page 2. Available at <http://www.whitehouse.gov/omb/inforeg/pramemo111302.pdf>

<sup>19</sup> Memorandum For Chief Information Officers General Counsels And Solicitors from Dr. John D. Graham, OIRA Administrator, *Ensuring Full Compliance with the Paperwork Reduction Act*. (June 6, 2002), page 2. At <http://www.whitehouse.gov/omb/inforeg/violationmemo060602.pdf>

accuracy of PTO's estimate of the burden imposed by the proposed rules; (iii) evaluate whether these proposed rules will have practical utility to the PTO, and whether that practical utility is greater than the burden imposed on the public; (iv) explore how the provisions of the proposed rules could be framed to minimize the burden on appellants; (v) evaluate alternatives for avoiding duplicative information collection.

21(c) Please provide a copy of any public notice published prior to the publication of the 2003 Appeal NPRM that provided (i) estimates for the paperwork burdens associated with the rules proposed in the 2003 Appeal NPRM or that (ii) solicited and provided opportunity and instructions for submitting public comments to OMB on such paperwork burdens.

21(d) Please provide all documents concerning the PRA Review of the 2003 Appeal NPRM, including all documents concerning the PTO's apparent conclusion that no changes in PRA burdens were associated with the proposed rules published in the 2003 Appeal NPRM. Please provide documents sufficient to establish the identity of the "Senior Official" that provided such requisite certification under the PRA.

21(e) Please provide copies of all public comments submitted in response to the 2003 Appeal NPRM and any review or comment period under the Paperwork Reduction Act concerning the 2003 Appeal NPRM and the 2004 Final Appeal Rule. Please provide documents sufficient to establish the identities of all members of the public that the PTO consulted prior to publishing the 2003 Appeal NPRM, to solicit comment with respect to the proposed 2003 Appeal Rule, in order to: (i) evaluate whether these proposed rules are a necessary amendment to the then existing appeal rules; (ii) evaluate the accuracy of PTO's estimate of the burden imposed by the proposed rules; (iii) evaluate whether these proposed rules will have practical utility to the PTO, and whether that practical utility is greater than the burden imposed on the public; (iv) explore how the provisions of the proposed rules could be framed to minimize the burden on appellants; (v) evaluate alternatives for avoiding duplicative information collection.

22. Please provide all documents (including procedures, guidelines or checklists) concerning standards and methods adopted or used by the PTO to evaluate and determine whether a given proposed rule may be "Not significant," "Significant Regulatory Action" or "Economically significant" under Executive Order 12,866.

23. In the 2007 Appeal NPRM, the PTO states that "this rule making has been determined to be not significant for purposes of Executive Order 12866" (72 FR 41484, Col. 1). An identical statement was made in the 2008 Final Appeal Rule (73 FR 32972, Col. 2). Please provide all documents concerning this determination. Include all supporting numerical economic analysis estimates that were used in deriving PTO's projected economic effects in connection with the aforementioned determination under Executive Order 12,866.

24. Please provide all memoranda or guidance documents concerning use or completion of Form PTOL-461, "*Communication Re: Appeal*"; Form PTOL-462, "*Notification of Non-Compliant Appeal Brief (37 CFR 41.37)*"; Form PTOL-462R, "*Notification of Non-Compliant Appeal Brief (37 CFR 41.37) in Ex Parte Reexamination*". In particular, please include guidance documents directed to any standards for the "Summary of claimed subject matter" of 37 C.F.R. § 41.37(c)(1)(v).

25. The 2008 Final Appeal Rule mentions an "informal survey" of appeal briefs at 73 Fed. Reg. 32966, col. 1. The ICR Statement also refers to an "informal survey" of appeal briefs at page 18.

25(a) Please provide documents sufficient to establish whether the "informal survey" mentioned in the 2008 Final Appeal Rule and the "informal survey" mentioned in the ICR Statement refer to the same survey or to two different surveys.

25(b) Please provide all documents concerning the "informal survey(s)" including documents setting forth the sampling methodology, analysis, results and controls for confounding variables such as type size and line spacing of the appeal briefs surveyed. Please provide documents sufficient to identify the appeal briefs that were evaluated in this "informal sample." This identification request may be satisfied by a list of the serial numbers of the applications subject to these surveyed appeals.

26. On page 18 the ICR Statement, PTO states: "Based on an informal survey of appeal briefs in FY 2007, the Board expects less than three percent (3%) of all appeal briefs, reply briefs, and requests for rehearing filed would, under the amended rules, require a petition to increase the page limit." Please provide all documents concerning the "informal survey," including (a) documents defining the information quality standards applied to the "informal survey," (b) the compliance of the "informal survey" with the PTO's information quality guidelines, (c) documents concerning sampling methodology, analysis, results and controls for the appeal briefs surveyed. Please provide documents sufficient to identify the appeal briefs that were evaluated in this "informal survey" and how the PTO accounted for the additional material required in briefs under the 2008 Final Appeal Rule. This identification request may be satisfied by a list of the serial numbers of the applications subject to these surveyed appeals.

27. Please provide all documents (including models and software) concerning the specific numerical estimate of 1,315 petitions seeking an increase in page limit under the 2008 Final Appeal Rule as reported in the ICR Statement.

28. At page 9 of the ICR Statement, the PTO asserts: "A ... table of authorities require minimal additional effort since they can be generated through modern day computer word processing programs". In Answer 6 at page 14 the PTO states: "Generating a table of authorities is considered relatively easy with modern word processing programs and so any **additional burden** is **believed to be minimal**, and is **considered to be outweighed** by the efficiency gained in the decision making process". (Emphasis added). Please provide all documents or objective support concerning these statements, and any estimate for additional burdens of generating table of authorities, or basis for the PTO's "belief". Include information sufficient to identify the appeal briefs that were evaluated for estimating such burden. This identification request may be satisfied by a list of the serial numbers of the applications subject to these evaluated appeals.

29. Please provide all documents and objective support concerning any estimate or measurement of efficiency gained by the BPAI or the "efficiency gained in the decision making process" attributable to table of authorities in appeals.

30. In Answer 1 on page 12 of the ICR Statement, the PTO asserts that the 2008 Final Appeal Rule is **expected** to reduce delays and that "the agency estimates that, in addition to the time that will be saved in the intake process, 5.5 months of time will be saved in **all** appeals to the Board."

(Emphasis added). Please provide all documents concerning the "agency estimate" and the aforementioned statement of time-savings for all appeals. Include documents setting forth the sampling methodology, analysis, results and controls for the appeal briefs surveyed. Please provide documents sufficient to identify the appeal briefs that were evaluated in this "agency estimate." This identification request may be satisfied by a list of the serial numbers of the applications subject to these appeals.

31. In Answer 2 on page 13 of the ICR Statement, the PTO states: "Agency studies show that less than 10% of the appeal briefs currently being filed would exceed a 25-page limit. In the 2008 Final Appeal Rule, at 73 Fed.Reg. 32966, Comment 87, the PTO states that "in response to other comments the proposed page limit of 25 pages was increased to 30 pages. Accordingly, *a small percentage* of current briefs might exceed 30 pages". Please provide all documents concerning any "agency studies" referred to above. Include documents setting forth the sampling methodology, analysis, results and controls for the appeal briefs surveyed. Please provide documents sufficient to identify the appeal briefs that were evaluated in this "agency study" and how the PTO accounted for the additional material required in briefs under the 2008 Final Appeal Rule. This identification request may be satisfied by a list of the serial numbers of the applications subject to these surveyed appeals.

32. Please provide all documents concerning the change in page limit in appeal briefs from 25 pages in the 2007 Appeal NPRM to 30 pages in the 2008 Final Appeal Rule. Include any documents concerning any the balance of burdens and efficiency loss to the Board of Appeals attributable to this change. Please include any analysis or comparison calculation that takes into account the overwhelming majority of appeal briefs that never reach the Board when the examiner withdraws the pending rejection.

33. In Answer 3 on pages 13-14 of the ICR Statement, the PTO states that "the [2008 Final Appeal Rule's] requirement for an appendix saves agency resources in *many* areas" and that "Searching for and retrieving this information from earlier applications *delays* BPAI action on the appeal. ... Thus, while the copies of evidence required by the appendix may be duplicates of evidence already in the file, the needs to *save agency resources* and promote judicial economy *demonstrate* that the appendix is not unnecessarily duplicative." (Emphasis added). The PTO further states "searching for and retrieving this information from earlier applications *delays* BPAI action on the appeal." Please provide all documents (including models or surveys) concerning these statements, burden associated with, and any measurements of practical utility to the agency of, the duplicative material requirements in the 2007 Appeal NPRM, and/or the 2008 Final Appeal Rule. Please include any analysis or comparison calculation that takes into account the overwhelming majority of appeal briefs that never reach the Board when the examiner withdraws the pending rejection.

34. In Answer 3 on pages 13-14 of the ICR Statement, the PTO states that "[p]rior to former Rule 41.37(c)(1)(ix) (2004) requiring an appendix with the evidence, the Board received *many* appeals wherein the evidence relied on by the applicant and the examiner did not correspond." Please provide documents sufficient to establish the number or fraction of appeals prior to the 2004 Appeal Rule in which the evidence relied on by the applicant and the examiner did not correspond. Please provide all documents concerning alternatives and identification of PTO's "every reasonable step to ensure that the proposed collection of information" with respect to

duplication in the brief's appendix "is the least burdensome necessary ... [and is] not duplicative of information otherwise accessible to the agency." 5 C.F.R. §§ 1320.5(d)(1)(i),(ii).

### **FEEs**

With few exceptions, the documents requested above are part of the administrative record required under the Administrative Procedure Act or the Paperwork Reduction Act, which the PTO was required to assemble. Thus I believe that no fee for searching or assembling of documents can be charged.

Thank you for your attention. If you have any questions about handling this request, you may telephone me at (760) 753-0668, or indicate by email a convenient time and a phone number for me to call you.

Sincerely,


A handwritten signature in black ink, appearing to read "Ron Katznelson". The signature is fluid and cursive, with the first name "Ron" and last name "Katznelson" clearly distinguishable.

Ron D. Katznelson, Ph.D.  
Encinitas, CA  
Office: (760) 753-0668  
Mobile: (858) 395-1440  
[rkatznelson@roadrunner.com](mailto:rkatznelson@roadrunner.com)



# APPENDIX 2

## Image File Wrapper Document Identification

**United States Patent and Trademark Office**  
[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz Alerts](#) | [News](#) | [Help](#)

[Portal Home](#) | [Patents](#) | [Trademarks](#) | [Other](#)

**Patent eBusiness**

- [Electronic Filing](#)
- [Patent Application Information \(PAIR\)](#)
- [Patent Ownership](#)
- [Fees](#)
- [Supplemental Resources & Support](#)

**Patent Information**

- [Patent Guidance and General Info](#)
- [Codes, Rules & Manuals](#)
- [Employee & Office Directories](#)
- [Resources & Public Notices](#)

**Patent Searches**

- [Patent Official Gazette](#)
- [Search Patents & Applications](#)
- [Search Biological Sequences](#)
- [Copies, Products & Services](#)

**Other**

- [Copyrights](#)
- [Trademarks](#)
- [Policy & Law](#)
- [Reports](#)

**Patent Application Information Retrieval**

[Order Certified Application As Filed](#) [Order Certified File Wrapper](#) [View Order List](#)


**10/207,807 ROLL-BALER**

[Select New Case](#) [Application Data](#) [Transaction History](#) [Image File Wrapper](#) [Patent Term Adjustments](#) [Foreign Priority](#) [Published Documents](#) [Address & Attorney/Agent](#)

This application is officially maintained in electronic form. To View: Click the desired Document Description. To Download and Print: Check the desired document(s) and click Start Download.

**Available Documents**

Mail Room Date	Document Code	Document Description	Page Count	Select All	Start Download	Clear All
10-29-2008	APDR	<a href="#">BPAI Decision - Examiner Reversed</a>	9	<input type="checkbox"/>		
08-29-2008	APCH	<a href="#">Confirmation of Hearing by Appellant</a>	2	<input type="checkbox"/>		
08-29-2008	N417	<a href="#">EFS Acknowledgment Receipt</a>	2	<input type="checkbox"/>		
08-29-2008	LET.	<a href="#">Miscellaneous Incoming Letter</a>	1	<input type="checkbox"/>		
08-29-2008	APCH	<a href="#">Confirmation of Hearing by Appellant</a>	2	<input type="checkbox"/>		
08-21-2008	APNH	<a href="#">Notification of Appeal Hearing</a>	3	<input type="checkbox"/>		
03-19-2008	AP_DK_M	<a href="#">Appeal Docketing Notice</a>	2	<input type="checkbox"/>		
10-31-2007	RBNE	<a href="#">Reply Brief Noted - BPAI</a>	2	<input type="checkbox"/>		
08-28-2007	APRB	<a href="#">Reply Brief Filed</a>	5	<input type="checkbox"/>		
08-28-2007	APOH	<a href="#">Request for Oral Hearing</a>	2	<input type="checkbox"/>		
08-28-2007	WFEE	<a href="#">Fee Worksheet (PTO-06)</a>	2	<input type="checkbox"/>		
08-28-2007	N417	<a href="#">EFS Acknowledgment Receipt</a>	2	<input type="checkbox"/>		
08-08-2007	CTMS	<a href="#">Miscellaneous Action with SSP</a>	3	<input type="checkbox"/>		
06-28-2007	APEA	<a href="#">Examiner's Answer to Appeal Brief</a>	10	<input type="checkbox"/>		
03-28-2007	AP.B	<a href="#">Appeal Brief Filed</a>	47	<input type="checkbox"/>		
02-28-2007	APBD	<a href="#">Notice - Defective Appeal Brief</a>	2	<input type="checkbox"/>		
12-11-2006	AP.B	<a href="#">Appeal Brief Filed</a>	46	<input type="checkbox"/>		
10-11-2006	N/AP	<a href="#">Notice of Appeal Filed</a>	1	<input type="checkbox"/>		
07-26-2006	CTAV	<a href="#">Advisory Action (PTOL-303)</a>	3	<input type="checkbox"/>		
07-13-2006	A.NE	<a href="#">Amendment After Final Applicant Arguments/Remarks Made in an Amendment</a>	2	<input type="checkbox"/>		
07-13-2006	REM	<a href="#">Final Rejection</a>	4	<input type="checkbox"/>		
04-13-2006	CTFR	<a href="#">List of references cited by examiner</a>	7	<input type="checkbox"/>		
04-13-2006	892	<a href="#">Foreign Reference</a>	1	<input type="checkbox"/>		
04-13-2006	FOR	<a href="#">Foreign Reference</a>	13	<input type="checkbox"/>		



## APPENDIX 3

IFW Defective Image Problem Report Inserted In Evidence Appendix of the  
Appeal Brief in Ser. No. 10/207,807 shown in APPENDIX 2

**This Page is Inserted by IFW Indexing and Scanning  
Operations and is not part of the Official Record .**

### BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☐ FADED TEXT OR DRAWING
- ☐ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☐ GRAY SCALE DOCUMENTS
- ☒ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: \_\_\_\_\_

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.**