

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

December 8, 2008

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

Via E-mail
Nicholas_A_Fraser@omb.eop.gov

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

Dear Mr. Fraser:

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

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

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

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

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

