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July 11, 2011

The Honorable David Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Mail Stop Comments –Patents
P.O. Box 1450
Alexandria, VA 22313–1450

Attn: Linda Horner, BPAI Rules

Re: Comments on Proposed Rules Bd. R. 41.35(c) and 41.50(a)
published in *Rules of Practice Before the Board of Patent
Appeals and Interferences in Ex Parte Appeals*, 75 Fed. Reg.
69828 (November 15, 2010).

Dear Under Secretary Kappos:

Further to my letter of February 10, 2011, I am writing on behalf of the American Bar Association Section of Intellectual Property Law (the “Section”) to provide comments in response to the request the United States Patent and Trademark Office (the “Office”) published in the Federal Register on November 15, 2010 (PTO-P-2009-0021). In particular, the Section submits the following comments on Proposed Rules Bd. R. 41.35 (c) and 41.50(a) published in the *Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals*, 75 Fed. Reg. 69828. Please note, these comments have not been approved by the ABA House of Delegates or Board of Governors, and should not be considered to be views of the American Bar Association.

Under the 2004 Appeal Rules in effect today, a panel of the Board of Patent Appeals and Interferences (the “Board”) can remand an *ex parte* appeal to the examiner on its own authority. 37 C.F.R. § 41.50(a)(1), MPEP § 1211. The November 2010 proposal for Bd.R. 41.50(a) would eliminate the Board’s independent authority to remand an application to an examiner insofar as the Board would be required to decide the appeal on the merits and only with the Director’s approval may the Board remand an application back to the examiner (proposed Bd.R. 41.35(c)).

The Section recognizes the efforts of the Office to address concerns raised in comments in response to its previously proposed rule to revise the current rule so that only the Chief Administrative Patent Judge had the authority to remand an application to the examiner. The Office received a wide range of comments (including contradictory comments) from the public ranging from “the Chief Administrative Patent Judge should not have sole authority over merits remands” to “allowing the Chief Administrative Patent Judge to issue remand orders would improve [and would not] the appellate process before the Board.” 75 Fed. Reg. 69828, 69841.

The Section is concerned that the current rule (namely, 37 C.F.R. § 41.50(a)(1)) and the Proposed Rules Bd. R. 41.35(c) and 41.50(a) do not provide an adequate mechanism which would ensure that the Board decides each appeal on the merits, once properly before the Board, and provides the appellant with a final decision in a prompt and timely manner.

Accordingly, the Section encourages the Office to enact rules that would provide for the following:

- (1) after an appeal has been lodged and the appellant has placed the appeal before the Board in accordance with all applicable regulations, the Board shall promptly decide the appeal on its merits unless the appeal is subsequently abandoned by the appellant or the appellant has requested (or consented to) a remand of the appeal to the examiner for further action;
- (2) in lieu of a remand, the Board may order the examiner to supplement the record in an appealed application and require that the examiner so act on the appealed application within a reasonable period of time, not to exceed three months;
- (3) once an application on appeal has been subject to an order to supplement, the appeal shall not be subject to a further delay and, once the time set for the examiner to act has expired, shall be thereafter decided by the Board with special dispatch; and
- (4) if an examiner has supplemented the record on appeal, the appellant shall have the right to file a response to any action taken by the examiner.

In closing, the Section acknowledges with appreciation the willingness of the Office to consider public comments regarding the proposed changes to the current rules governing practice before the Board.

If you have any questions or would wish for us to further explain any of our comments, please do not hesitate to contact me. Either I or another member of the leadership of the Section will respond to any inquiry.

Very truly yours,



Marylee Jenkins
Section Chairperson
American Bar Association
Section of Intellectual Property Law