

JOEL MILLER
ATTORNEY AT LAW
17 WESTWOOD DRIVE SOUTH
WEST ORANGE, N.J. 07052
(973) 736-8306
jm@JoelMillerLaw.com
www.JoelMillerLaw.com

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Via E-Mail (BPAI.Rules@uspto.gov)

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

Re: Comments on Proposed Rules: Rules of Practice Before the
Board of Patent Appeals and Interferences in *Ex Parte* Appeals
75 Fed. Reg. 69,828 (Nov. 15, 2010)

Dear Under Secretary Kappos:

Under the current and proposed versions of Rule 41.33, appellants may submit certain specified amendments, affidavits, and other evidence during the course of an appeal. For example, an appellant may submit an amendment cancelling a claim, on or after the date on which an appeal brief has been filed. *See* 37 C.F.R. § 41.33(b)(1) (2004 and 2010).

Both the current and the proposed rules state that appeal briefs and reply briefs “shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence.” *See* 37 C.F.R. §§ 41.37(c)(2), 41.41(a)(2) (2004); proposed rules 37 C.F.R. §§ 41.37(c)(2), 41.41(b)(1) (2010). The meaning of “new” in this context is unclear to this reader and the prohibition of a “new” amendment, affidavit, and other evidence arguably precludes the submission of items otherwise permitted under Rule 41.33.

As an alternative, the rules could state that an appeal or a reply brief “shall not rely upon or refer to a non-admitted amendment, affidavit or other evidence.” Should the examiner deny entry of an amendment, affidavit or other evidence, the appellant should then submit an amended brief deleting any such reliance or reference.

Respectfully submitted,


Joel Miller

Reg. No. 29,955

Author, *The PTO Board of Patent
Appeals and Interferences:
Appellate Advocacy and Practice*