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February 17, 2011

By Email

APJ Linda Horner, BPAI Rules  
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Re: Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals (RIN 0651-AC37), 75 Fed. Reg. 69828 (Nov. 15, 2010)

Dear APJ Horner:

I recently encountered another issue worthy of comment. Please accept this letter even though it is out of time.

The provisions of 37 C.F.R. § 41.33 and § 41.37(c)(1)(ix) relating to Evidence Appendices are not proposed for amendment, but should be amended to correctly state existing law and established Board practice, to reduce examiner confusion and satellite petitions practice. The 2004 version of § 41.37(c)(1)(ix) reads as follows:

(ix) *Evidence appendix*. ... Reference to unentered evidence is not permitted in the brief. ...

Materials that may be judicially or Officially noticed without being formally admitted "in evidence" are appropriately referenced in a Brief, and included in an

Evidence Appendix.<sup>1</sup> If a reviewing court will rely on information, it would seem wasteful and unwise for the Board to close its eyes to that information. And indeed, the Board has recognized this practical reality: the only Board cases I know of relating to the issue not only *permit* but *require* inclusion of noticeable materials in the Evidence Appendix.

One specific class of noticeable materials relates to definitions. The Supreme Court has long held that courts on review of agency decisions are “bound to take judicial notice” of the ordinary meaning of terms, or special meaning in trade or commerce. “[D]ictionaries are admitted not as evidence, but only as aids to the memory and understanding of the court.”<sup>2</sup> Courts take judicial notice of dictionaries and encyclopedias to define terms,<sup>3</sup> so such definitions should be permitted in the Evidence Appendix, even if not admitted during prosecution. The Board’s actual practice reflects this common sense—the Board uses publicly-available articles to establish definitions of terms, even if the Board locates the article *sua sponte* after briefing is closed.<sup>4</sup> If a dictionary definition or relevant web material is *not* included in the Evidence Appendix, the Board will enter return of an Appeal Brief to the examiner to require the dictionary

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<sup>1</sup> *Boehringer Ingelheim Vetmedica Inc. v. Shering-Plough Corp.*, 320 F.3d 1339, 1346, 65 USPQ2d 1961, 1966 (Fed. Cir. 2003) (“Like trial judges, we are free to consult dictionaries regardless of whether they have been offered by a party in evidence or not.”).

<sup>2</sup> *Nix v. Hedden*, 149 U.S. 304, 306-307 (1893) (in reviewing a classification decision by Customs, looking to ordinary dictionaries).

<sup>3</sup> *Sxchott Optical Glass Inc. v. United States*, 612 F.2d 1283, 1286 (CCPA 1979) (relying on Encyclopedia Britannica to define “optical glass”); *Hancock v. American Steel & Wire Co. of new Jersey*, 203 F.2d 737, 740 (CCPA 1953) (“Courts take judicial notice of the meaning of words, ... and the court may always refer to standard dictionaries or other recognized authorities to refresh its memory and understanding as to the common meaning of language.”).

<sup>4</sup> *Ex parte Denton*, Appeal No. 2009-002960, <http://des.uspto.gov/Foia/ReterivePdf?system=BPAI&fINm=fd2009002960-03-29-2010-1> at 8, 2010 WL 1250650 at \*4 (BPAI Mar, 29, 2010) (unpublished) (“One of ordinary skill in the art, if he or she did not already know what was meant by ‘sensitivity data,’ would have reasonably looked to various articles and other technical references describing such models,” and then relies on a magazine article located on the web for a definition of a term).

definition to be *added* to the Evidence Appendix.<sup>5</sup> Thus it seems that the only efficient thing to do is to amend the written rules to conform to actual practice.

Further, one of the nation's most prominent appellate judges, Richard Posner on the Seventh Circuit, stated in a 2010 ABA webcast that he relies on the web for "nonadjudicative facts that illuminate the background and context of a case—that make the case come alive to a person not immersed in the field of law, or the commercial or personal situation, out of which it arises."<sup>6</sup> This broader class of materials seem appropriate for inclusion in the Evidence Appendix as well.

The Evidence Appendix rules should also clarify that it is appropriate to include any legal materials that are not readily available to the Board, for example decisions that are not reported in the USPQ (or the West Reporter System, whichever the Board prefers), administrative materials, and the like.

Sincerely,

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<sup>5</sup> *Ex parte Scroggie*, App. Ser. No. 09/401,939, Appeal 2008-4478, Decision on Petition (BPAI Jul. 18, 2008) (unpublished); *Ex parte Virolainen*, Appeal 2007-0989, <http://des.uspto.gov/Foia/ReterivePdf?system=BPAI&fINm=fd20070989-09-13-2007-1> at 4-5, 2007 WL 2758420 at \*2 (BPAI Sep. 13, 2007) ("We are unfamiliar with the content of the 'Merriam-Webster online dictionary' ... [W]e remand ... to ensure that the Appellants provide copies of the evidence on which they rely...")

<sup>6</sup> Richard A. Posner, Effective Appellate Brief Writing, [http://www.abanet.org/litigation/litigationnews/trial\\_skills/appellate-brief-writing-posner.html](http://www.abanet.org/litigation/litigationnews/trial_skills/appellate-brief-writing-posner.html) (Sep. 1, 2010) ("The Web is an open source; it is as great a resource for lawyers as for judges").