

Horner, Linda

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Sent: Tuesday, November 16, 2010 10:43 AM
To: BPAI Rules
Subject: Comment on Claim Appendix

Dear BPAI. Rules

With regard to the requirement for a claim appendix, the proposed rules say:

[Heading 2:] “Obviousness Rejection”

(**Note:** Because there is only one obviousness rejection in the appeal, this heading is sufficient for the Board to know which ground of rejection is being argued.)

[Subheading 1:] “*Claims 11–19*”
 [Add Argument for claims 11–19 here].

[Subheading 2:] “*Claim 20*”
 [Add Argument for claim 20 here].

Appeal Brief—Content of Appeal
 Brief—Claims Appendix

The proposed rule deletes Bd.R. 41.37(c)(1)(viii).

Bd.R. 41.37(c)(1)(viii) and the ANPRM required appellants to include a claims appendix with the brief. The proposed rule deletes the claims appendix from the briefing requirements. Because the last entered amendment is the most accurate reflection of the claims on appeal, the Office would look to the claims as presented in the last entered amendment as the claims on appeal.

Appeal Brief—Content of Appeal
 Brief—Evidence Appendix

This implies that only the last paper filed by the applicants (“the last entered amendment”) will be reviewed by the office. Since the last entered paper might not include any amendment or may only include an amendment of the specification and because the current claims might be entirely original, to be clear, this portion should instead state that the **Office will consult the most recently filed set of claims.**