

Fawcett, Susan

From: Brian Schar [schar@cardica.com]
Sent: Friday, August 01, 2008 8:19 PM
To: Fawcett, Susan
Subject: Comments on the proposed appeal brief rules

Dear Ms. Fawcett,

This is a short email regarding the proposed USPTO appeal brief rules, published at 73 FR 32938 et. seq. In an effort to avoid duplicating comments that others will likely make, I wanted to focus on three particular points.

First, the PTO provided no factual basis for the estimate of time for preparing briefs in the new format. For example, the statement of facts section alone is a major change to the current process. Preparation of this section in conjunction with the argument section may require a significant amount of time – or it may not. However, no analysis of any kind is provided as to the impact of this change. The lack of analysis extends to every part of the appeal brief time estimate.

Second, a major source of hours consumed are the Notices of Non-Compliant Appeal Brief sent to applicants improperly. As an example, I received such a Notice the other day indicating that my grounds of rejection and argument sections did not match. The grounds of rejection were 102 and 103; the two sections of the argument portion of the brief referred to anticipation (102) and obviousness (103). The lack of training and/or legal knowledge of the Legal Instrument Examiner cost me a hour of time to correct. The new rules provide a larger number of nits for the LIEs to pick, thereby likely increasing the number of Notices sent to applicants and thereby increasing the amount of time that applicants need to spend overall in preparing their briefs.

Third, the process flow for petitions bears no resemblance to reality. As I read the rules, failure to petition a petitionable item in an application causes that item to be waived. However, petitions often take over a year to be decided; applicants only have 90 days after final to file an appeal. Thus, if applicants have reached an impasse with the examiner, they are forced to file an RCE that will not advance the process in order to wait for a petition to be decided, and will likely reach final rejection in that RCE prior to decision of the petition.

These rules (particularly with regard to the timing of petitions) go beyond procedural changes to the format of the brief to substantive changes to the appeals process, and as such should not be implemented. Thank you for your consideration.

*Brian A. Schar, Esq.
Director of Intellectual Property
Cardica, Inc.
900 Saginaw Drive
Redwood City, CA 94063
(650) 331-7162 (direct)*

8/11/2008