

**Fawcett, Susan**

---

**From:** Shirley A. Dunne [sad@suiter.com]  
**Sent:** Friday, August 08, 2008 4:23 PM  
**To:** Fawcett, Susan  
**Subject:** Comments on RIN 0651-00xx Board of Appeals and Interferences Actions  
**Importance:** High  
**Attachments:** Fawcett 8-8-08.pdf

Please read attached communication. Thank you.

Shirley Dunne  
Paralegal  
Suiter Swantz pc llo  
14301 FNB Parkway  
Suite 220  
Omaha, NE 68154-5299  
402.496.0300 phone  
402.496.0333 fax  
[sad@suiter.com](mailto:sad@suiter.com)

The information contained in this e-mail message may be privileged, confidential, and protected from disclosure. If you are not the intended recipient, any further disclosure or use, dissemination, distribution, or copying of this message or any attachment is strictly prohibited. If you think that you have received this e-mail message in error, please delete it and notify the sender.

8/11/2008

SUITER · SWANTZ PC LLO  
PATENTS, TRADEMARKS, COPYRIGHTS AND TECHNOLOGY MATTERS  
14301 FNB PARKWAY, SUITE 220  
OMAHA, NEBRASKA 68154-5299

HTTP://WWW.SUITER.COM  
TELEPHONE: 402.496.0300  
TELECOPIER: 402.496.0333

August 08, 2008

Susan K. Fawcett, Records Officer  
Office of the Chief Information Officer  
Customer Information Services Group  
Public Information Services Division  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

---

COMMENT

RIN 0651-00xx BOARD OF PATENT APPEALS AND INTERFERENCES ACTIONS

---

Dear Ms. Fawcett:

We are patent attorneys and members of a small law firm specializing in the preparation and prosecution of patent applications. Concerning the Agency's proposed changes to the *ex parte* appeal process, kindly consider the following comments regarding the effect of the proposed changes in light of 5 CFR 1320 et seq.

The United States Patent and Trademark Office (Agency) has indicated the new appeal rules are needed as a result of an increase in *ex parte* appeals. The Agency has indicated the proposed amendments will facilitate timely resolution of appeals.

The Agency states: "[a] major objective of the amended rules is to avoid unnecessary returns to examiners by the Appeals Center and the Board, along with the resulting delays in application and appeal pendency." The Agency does not quantify the delay caused by "unnecessary returns." Additionally, the Agency does not explain why it is making "returns" if they are unnecessary.

It should also be noted that the Agency does not explain how the new rules will reduce delay. Further, the Agency does not provide details on what amount of delay will be eliminated by the new rules. The Agency simply supports the changes by contending that the new rules will "minimiz[e], if not eliminat[e], a need to hold appeal briefs defective."

The Agency does not indicate the percentage or number of briefs it holds defective. Likewise, the Agency does not set forth the common defects which require briefs to be held defective. Interestingly, the Agency does not explain how a rule change will reduce the number of defective briefs when the current rules already have requirements which allow the Agency to hold a brief defective. Ostensibly the Agency

SUITER · SWANTZ PC LLO

is holding a large number of briefs defective pursuant to its current rules. One may reasonably ask how changing the rules (requirements) will increase compliance unless the proposed amendments do away with the requirements causing the defects.

The proposed rule changes are so sweeping that the notice is 41 pages long (73 Fed. Reg. 32938). Yet the Agency has indicated the time burden to the appellant (applicant) will remain substantially the same. Patent applications and their prosecutions are complex. Applications representing the most technologically significant and valuable to the public tend to be those that generate complex prosecutions (appeals).

The Agency has indicated that a 30-page limit for appeal briefs will reduce the number of defective briefs without increasing the cost or amount of time necessary to comply. The Agency has stated that the 30-page limit will promote “concise and precise writing.” The following quotations are instructive on the relative time requirement of being “concise and precise”:

*I have only made this letter longer because I have not had the time to make it shorter.*

Blaise Pascal

*Not that the story need be long, but it will take a long while to make it short.*

Henry David Thoreau

*If I had more time, I would have written a shorter letter.*

Marcus T. Cicero

*[W]riting briefly takes far more time than writing at length.*

---

Karl Friedrich Gauss

*If you want me to give you a two-hour presentation, I am ready today.  
If you want only a five-minute speech, it will take me two weeks to prepare.*

Mark Twain

The Agency has dramatically understated the time requirement necessary to comply with the proposed rules. The Agency has not established a need. Nor has the Agency demonstrated that the proposed rule changes will solve any problem. The proposed rules will add cost, increase delay, and make it more difficult to obtain a patent. This will harm the public and thwart the public policy rationale for the patent system

SUITER · SWANTZ PC LLO

(reward inventors for disclosing their inventions in order to benefit the public). The proposed rules should not be allowed to go into effect.

The United States Patent and Trademark Office does an excellent job performing exceedingly difficult work. The proposed rules will not help the Agency—only unnecessarily burden applicants. Thank you for your consideration.

Respectfully,



Sean Patrick Suiter



Chad W. Swantz