



UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

July 23, 2012

Comments of the United States Patent and Trademark Office to the Merit Systems Protection Board Proposed Revision of its Rules Published on June 7, 2012.

The Merit Systems Protection Board (MSPB) published a Proposed Rule on June 7, 2012, to revise its rules of practice and procedure to improve and update the MSPB's adjudicatory processes. Fed Reg. Vol. 77, No. 110. Written comments are due on July 23, 2012. The United States Patent and Trademark Office (USPTO), Office of General Counsel, submits the following comments for consideration. These comments are based on the extensive practice of the USPTO Office of General Counsel before the Board.

Comment on 5 CFR 1201.23 *Computation of Time:*

The Agency appreciates the clarification that this section applies to all deadlines, including those set forth in a Judge's Order and to discovery requests and responses. The Agency recommends that this section be further amended to incorporate the concept of constructive receipt as was added to section 1201.22 regarding receipt of agency decisions. In situations in which the deadline for the action of a party is determined to run from that party's receipt of a document, a presumption of delivery would assist in the efficient conduct of the litigation. For example, when the date for response to discovery is determined by the date the party receives the discovery request, a presumption of delivery would insure that an appellant not intentionally or negligently avoid service.

Comment on 5 CFR 1201.24 *Content of an Appeal, Right to Hearing:*

The USPTO appreciates the Board's attempt to limit duplicative filings by limiting the information an appellant is required to file with an appeal and supports that goal. The USPTO agrees that evidence on jurisdiction should be filed in response to an Order to Show Cause on Jurisdiction, but only if the Board would hold in abeyance the agency's narrative response to the appeal until after the resolution of jurisdiction in a case. Acknowledgment Orders typically require the agency's narrative response to contain the agency's statement of jurisdiction, and the narrative response frequently is due either before the appellant is required to respond to the Order to Show Cause or before the Administrative Judge has resolved the jurisdictional question. Without any supporting documents, the agency is frequently unable to make any meaningful statement on jurisdiction. For example, in a case alleging jurisdiction under the VEOA, the agency may not have any idea if the appellant has exhausted his or her administrative remedies with the Department of Labor and could not make any statement on jurisdiction until the

appellant files supporting documentation. The Agency suggests that the rule be modified to provide that the agency not be required to file its narrative statement until the appellant has filed his/her response to the Order to Show Cause.

Comment on 5 CFR 1201.33 *Federal Witnesses:*

The initial clarification is welcome. The Agency additionally requests that the Board clarify the responsibility for payment of travel and per diem for Federal witnesses. We request that you clarify which Federal agency is responsible for the expenses when the Federal employee called to testify is not an employee of the agency that is party to the matter before the Board. Of special interest is when the Federal employee witness is an employee of an agency located in a different city and could, therefore, incur substantial travel and per diem expenses.

Comment on 5 CFR 1201.58 *Closing the Record:*

The Agency believes the intent of the change, as stated in the Summary of Changes, to allow a party “to submit evidence to rebut new evidence submitted by the other party just prior to the close of the record,” will ensure fairness and completeness of the record. We have two comments for your consideration on the wording of the regulation: (1) We are concerned by the addition of the phrase “or argument” (i.e., “. . . unless the party submitting it shows that the evidence or argument was not readily available . . .”). The addition of this phrase appears to broaden the opportunity of a party to add additional arguments that they just omitted to raise before the briefing deadline. While the opportunity to submit new evidence may be justified, if it supports an existing argument, the text seems to permit the submission of new argument independent of newly discovered evidence. (2) In the context of jurisdictional responses, typically the appellant submits a response to the Show Cause Order and the agency files a response with the record closing upon submission of the agency’s response. The revised regulation could be interpreted to permit appellant to reply to the agency’s response since in its response the agency would be submitting new argument.

Comment on 5 CFR 1201.73 *Discovery Procedures:*

The USPTO appreciates the Board’s attempt to limit duplicative filings in this context as well. However, while the agency may duplicate all information supplied in its initial disclosures in the Agency File, no similar disclosure exists for appellants. An appellant’s initial disclosures provide the agency with a valuable avenue to quickly determine whom to depose from the appellant’s case in chief. Without initial disclosures, the agency cannot learn anything about what witnesses the appellant intends to call until it receives the appellant’s responses to discovery, over a month after initial disclosures would have been due. Given the short timeframes in MSPB cases, a month delay can prevent an agency from being able to depose all relevant witnesses. Accordingly, the USPTO suggests that 5 CFR 1201.73 be amended to eliminate the agency’s initial disclosures but require the appellant to provide “[t]he name and, if known, the address, telephone number, and e-mail address of each individual likely to have discoverable information

that the appellant may use in support of his or her claims or defenses, identifying the subject of such information,” *i.e.*, the information currently required by 5 CFR 1201.73(a)(2)(ii).

Comment on 5 CFR 1201.115 *Criteria for Granting Petition or Cross Petition for Review*:

The Board’s clarification is helpful. The USPTO offers this comment on subsection (d), permitting a Petition for Review (PFR) when “New and material evidence or legal argument is available that, despite the petitioner’s due diligence, was not available when the record closed” The Agency notes that the Board has previously held that “The Board will not consider an argument raised for the first time in a petition for review absent a showing that it is based on new and material evidence not previously available despite the party’s due diligence.” *Mascarenas, v. Dep’t of Defense*, 57 M.S.P.R. 425 (May 7, 1993). The text of the proposed rule appears to broaden *Mascarenas* to permit the submission of new argument in and of itself. Under this rule, a party could raise new argument in the PFR that it merely omitted, or hadn’t thought of, below. The Agency requests that the text be clarified to reflect case law.

Comment on 5 CFR 1201.118 *Board Reopening of Final Decisions*:

The Agency appreciates the opportunity to comment on the revision and requests clarification of the impact of the change on Petitions for Review.