

-----Original Message-----

**From:** Nunez, Jordany  
**Sent:** Monday, March 13, 2006 12:53 PM  
**To:** AB94Comments  
**Subject:** Changes to Practice for the Examination of Claims in Patent Applications

Requiring that the applicant share the burden of examining the application by submitting an examination support document covering all of the representative claims is not sharing the burden at all. This is more likely to increase, not decrease, the office workload.

It is all too easy for an applicant to state that a reference is prior art to an application. For example, who could dispute that a horse-drawn cart is not prior art to a pick-up truck. Applicants will simply use very generic references to comply with this new rule. This will result in an increase effort on the part of the patent examining core since the examiner will now have to take a close look at the examination support document submitted in addition to conducting the required search for the best prior art reference.

This is a solution in search of a problem.

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**From:** Nunez, Jordany  
**Sent:** Monday, March 13, 2006 1:20 PM  
**To:** AB94Comments  
**Subject:** Changes to Practice for the Examination of Claims in Patent Applications

***Limiting an applicant to file no more than a single request for continued examination (RCE) will result in lengthier examinations per individual application, thus increasing, not decreasing, the pendency.***

***Since applicants will be limited, with very few exceptions, to a single RCE, applicants will be more prone to pursue their patent applications with greater zeal.***

***This will in turn force examiners to conduct lengthier searches per application to rebutt the increased number of arguments that applicants will be forced to make in light of the new rules.***

***For most junior examiners who are still in the learning stages of their career, the increased number of arguments will result in a greater number of office actions per application disposal. For most examiners, regardless of experience level, this will result in lengthier office replies.***

***Thus, limiting an applicant to file no more than a single (RCE) will increase the time and effort to the dispose of a patent application, thereby contributing to increased pendency.***