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From: Charles Gaines [mailto:charles.gaines@hittgaines.com]
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To: AB93Comments
Subject:

I believe that this unfairly increases the burden on the Applicant. In many instances, the Examiners hide behind vague and general rejections, usually based on 103 obviousness. This causes the Applicants to amend and argue various ways to challenge the Examiner's vague position, which typically leads to a final rejection, after which no further amendments are typically entered. If the threshold for the argument for why something was not presented earlier is reasonably low, then I would imagine that the reasons for filing the continuation would often be "because the Examiner presented new arguments (not art) on Final or because the Examiner found the earlier arguments and amendments to be unpersuasive", which is another phrase the Examiners use quite often and which are also typically unsupported. If the burden is heavier than this, then I think it is unfair to the Applicant because the Applicant is left to play a guessing game. In my experience, the 103 rejections made by most Examiner's are very weak because they often do not point to specific teachings of motivation to combine and sometimes, I have even had the entire reference cited as support for obviousness. Nevertheless, they stand by them in the hope that it will cause the Applicant to file a continuation application of some kind and in the process get credit for a disposal. Additionally, I have found them very uncooperative in trying to resolve things over the phone. I get excuses as such, "well you have to write it up" and when asked if they would enter it for Appeal purposes, they usually say "No." Frequently, but not in all cases, they do not make any offers as to what they believe could get the case allowed and there is no honest discussion on their part as to the invention and the applied art. So, typically, on Final, the Applicant is left with a vague 103 rejection, with no idea as to what the Examiner has in mind regarding the case. If the USPTO is truly interested in getting a better quality application and reducing the workload of the Examiners, which admittedly is significant, then the Examiners should be encouraged to cooperate more fully with the applicants instead of looking for their next disposal and produce better quality rejections so that the Applicant is not left guessing as to what might be allowable in the case. Increasing the argument burden on the Applicant is not the answer, in my opinion, until some of these issues are addressed.

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