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From: Jim Retter [mailto:jar@wfva.net]

Sent: Friday, March 10, 2006 4:42 PM

To: Clarke, Robert; AB93Comments

Subject: Comments on proposed changes to rules regarding continuation practice

Dear Sirs,

Regarding the proposed rules changes limiting the number of continuations (of any sort) absent a showing of why a further continuation is necessary, I urge you to reconsider.

I respectfully submit that as long as a large fraction of Examiners believe that references can be combined using in essence the ground that altering the teaching of the main reference according to the teaching of the secondary references would be an improvement, prosecution will be unnecessarily protracted, often requiring the filing of a continuation, and quite often the filing of an appeal. To reduce pendency, instead of placing additional barriers before the applicant I urge the Office to consider more extensive training of Examiners in respect to obviousness rejections. If the prima facie case required by MPEP 706.02(j) cannot fairly be made, Examiners ought to feel that it is OK to allow the case, that it is not a mark of dishonor to do so. More patents would issue, of course, but there is always reexamination if needed. My guess is that if the proposed rules are adopted, there will be simply a substantial increase in the number of appeals filed. And even though the Office is contemplating changes in respect to the appeal process (i.e. the pre-appeal conference), my sense is that the Examiner who sees obviousness rejections as a license to reject practically any claim, what happens now in case of appeal will continue to happen—the Examiner will reopen prosecution with a new obviousness rejection.

Instead of limiting the number of continuations, and instead of a pre-appeal conference, I urge the Office to set out more clearly for all Examiners what is required to fairly combine references, and to take steps to make sure that Examiners do not let their personal feelings enter into their decision of whether to allow a case.

I have filed approximately ten appeals (including supplemental appeals) in the last three years. As you know, an appeal brief is reviewed by Examiners from the art unit, and on the basis of that review a decision is made whether to reopen prosecution or have the appeal go to the Board

of Appeals. In every instance for me, prosecution was reopened (necessitating supplemental appeals), i.e. the appeal brief did not once find its way to the Board of Appeals.

I respectfully submit that the review made by an art unit when an appeal is filed ought to be made (in perhaps a scaled-down way) whenever an Examiner is of a mind to issue a final Office action based on a combination of references. This would, I believe, be far more effective in reducing pendency than the proposed rules changes.

Respectfully submitted,
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