

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

From: William H. Eilberg [mailto:whe@eilberg.com]
Sent: Sunday, February 26, 2006 11:59 AM
To: AB93Comments
Subject: Comments to Proposed Rules (RIN 0651-AB93)

Dear Sirs:

The requirement of showing that an amendment or argument could not have been presented earlier is likely to produce unjust results, in the following situations:

1. New Grounds of Rejection

Sometimes, the Examiner makes a final rejection, citing new prior art. In other cases, the Examiner rejects over a reference which was previously cited but not previously applied to the claims. In still other cases, the Examiner rejects over the same reference, but for somewhat different reasons.

In the case where new art is cited, it appears inherently true that a response to that art could not have been presented earlier. In the other two cases, it is not certain that the applicant could claim that the argument could not have been presented earlier.

It is unfair to punish an applicant for doing no more than try to respond to a new ground of rejection, whether that new ground is based on newly discovered art, or whether it is based on a reason not previously set forth by the Examiner.

The above problem could be solved by a provision that explicitly allows an applicant to respond whenever there is a new ground of rejection.

Such a provision would be in harmony with the current rules governing appeals. Those rules allow the applicant to re-open prosecution when the Examiner makes a new ground of rejection when the case is on appeal.

2. Continuations-in-Part

The proposed rules cover Continuations-in-Part. A CIP is almost always filed for the purpose of inserting new matter, discovered after the filing of the parent case. Thus, by definition, the CIP presents subject matter that could not have been presented earlier, at least in the vast majority of cases.

In view of the above, it seems unnecessary to penalize applicants by requiring them to undergo an additional stage of review, and pay an additional petition fee, simply to state that the CIP was filed for the purpose of adding previously unknown new matter.

3. Failure to Appreciate the Essence of the Invention

There are cases, admittedly infrequent, where the applicant's or attorney's understanding of the invention changes over time, and where the attorney thinks of a new way of characterizing the invention. This may be true even though the invention itself has not changed.

In all such cases, it could be said that the new argument or new claim could have been presented earlier. But the reason they were not presented might not be that applicant wanted to delay, but simply that the applicant

or the attorney did not fully appreciate the best way to present the invention.

In my more than two decades of practice, I have learned that the one piece of equipment that a patent attorney needs most is a crystal ball. Unfortunately, I have not been able to find a workable model. The proposed rules effectively require that the applicant or attorney have a crystal ball.

The proposed new rules therefore penalize applicants for simple failure to analyze fully the implications of an invention, and to present the invention in the best possible way.

It seems to me that the only way to avoid the above injustice is to insure that applicants have the right to file a further response, as long as the response is a bona fide new argument, and not just a repeat of arguments previously made.

It seems that the point of the proposed new rules is to reduce the number of frivolous multiple filings. This is a laudable goal, but the rules should be crafted so as not to bar filings made in good faith.

William H. Eilberg
Reg. No. 28,009