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From: dickapley@aol.com [mailto:dickapley@aol.com]

Sent: Wednesday, May 03, 2006 12:34 PM

To: AB93Comments

Subject: Proposed New Rules for Cont. Exam. Practice

The Honorable Jon Dudas

Under Secretary of Commerce for Intellectual Property
and Director Of the USPTO

Dear Under Secretary Dudas:

As a former USPTO supervisory patent examiner, Director of Independent Inventor Programs, and currently a patent agent working with independent inventors, I can categorically state that the proposed rules covering continuation examination practice are ill advised, unworkable, and will not produce the reduction in pendency that is forecasted.

I totally concur in the opposition opinion voiced by the AIPLA in their position paper.

Suggested changes:

If the proposed rules are adopted, I suggest the following change to both rules 78(d)(1) and 114(f). If the "single continuation" is expressly abandoned before an examination is made (see rule 138(d)), the "single continuation" will be the new application claiming benefit of the expressly abandoned application.

Clearly, the so-called "single continuation" should not be an application that was expressly abandoned before an examination.

If the proposed rules are adopted, there should be a differentiation between a continuation filed under rule 53(b) and rule 53(d). An RCE has always been viewed as an acceptable and Office efficient practice.

Recommendations:

1. The pendency problem is technology specific and definitely Tech Center specific. The Office must concentrate on creative solutions in those areas. The Office **can** hire its way out of its pendency problem if it **TRAINS and RETAINS** its experienced examiners. When an examiner leaves the Office, an amended and rejected docket of hundreds of cases is left behind and this causes huge problems for an art unit. The examiners must take time away from their own docket to work on a former examiner's cases. This causes a bigger pendency problem than a second continuation.

2. Retired examiners should be given an opportunity to do specific big applications that could cause an examiner to be "off line" for weeks. By out-sourcing these "enormous" cases to former primary examiners, you obtain two desired results: a) free the examiner to work on his/her docket; and b) get an excellent product from an out-source that the USPTO trusts and can quickly accept as its own work product.

Good luck.

Hope all is well.

Sincerely,

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