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From: Frank H. Foster [mailto:ffoster@ohiopatent.com]

Sent: Tuesday, January 24, 2006 7:18 PM

To: AB93Comments

Subject: Comments on proposed changes to continuation/RCE practice.

Although the problems described in the notice undeniably exist and the goal is desirable, the proposed rule making creates more problems than it solves. I urge that it not be adopted, or be substantially modified, for the following reasons.

First, the issue of whether an amendment, argument or evidence could have been previously submitted is just one more time and expense burden on applicants to argue and one more time and expense burden on the office to decide and to describe the basis for the decision.

Second, absent from the list of problems described in the notice but affected by the proposed rule making is the problem of the minority of incompetent, unreasonable or cursory examinations caused, apparently, by the high turnover in examiners and the time constraints they are confined by. Continuation/RCE practice is a way of dealing with that and attempting to resolve the problem when it arises before going to appeal. It takes two office actions to determine whether that is the problem and by then one is faced with a rejection that has been made final. A cursory examination is an easy way for an examiner, deficient in work ethic, to get an easy disposal. While unlimited continuation and RCE practice is certainly undesirable, an applicant should be allowed at least three continuation/RCEs without the required showing. If the problem isn't solved by then, it won't be and an appeal should be taken.

Third, an applicant should, in my opinion, have the right to take the claims that an examiner will allow and issue a patent, but still file a continuation before the patent issues to prosecute and, if necessary, appeal only the claims the examiner would not allow. Otherwise, an applicant is forced to wait the substantial length of time for an appeal to be concluded in order to issue a patent. By filing a continuation in this situation, an applicant can get a patent and still pursue broader claims (with a terminal disclaimer) in a continuation. The proposed rule change sounds like it might interfere with that practice.

Fourth, in my opinion, the more limitation the office places on continuation/RCE practice, the more appeals that will exist. I would expect this rule change to greatly increase the work load of the Board of Appeals.

Finally, the notice observes that it is expected that the rule changes will make the exchanges between the examiners and applicants more efficient and effective. I see no basis for that expectation because the efficiency and effectiveness of those exchanges is a function of the knowledge, competence and work ethic of examiners and applicants or their attorneys. None of those will be enhanced by interposing one more hurdle to cross and one more issue to be argued and decided.

Frank

Frank H. Foster

Patent, Trademark and Copyright Law

Intellectual Property Law

Kremblas, Foster, Phillips & Pollick Columbus, Ohio

7632 Slate Ridge Blvd. Reynoldsburg, OH 43068

email: ffoster@ohiopatent.com

voice: 614/575-2100 fax: 614/575-2149

Web Page: <http://www.ohiopatent.com>