From: Keith Saunders [ksaunderscomm@msn.com]
Sent: Thursday, February 25, 2010 4:58 PM
To: BPAI Rules
Cc: BPAI.Roundtable; ksaunderscomm@msn.com
Subject: Request for Comments on Potential Modifications to Final Rules Re Practice before BPAI

The Honorable David Kappos
Under Secretary of Commerce for Intellectual Property
and Director, United States Patent and Trademark Office

Attn: Linda Horner, BPAI Rules/BPAI Gen. Topics

RE: --Docket No.: PTO–P–2009–0021
--Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Request for Comments on Potential Modifications to Final Rule
--Roundtable Discussion
Proposed Rule §41.39

Dear Director Kappos:

These comments address proposed Rule § 41.39:

<<**Proposed Rule**>>
§ 41.39 Examiner's answer.
(a)(1) *Answer.* If the examiner determines that the appeal should go forward, then within such time and
manner as may be established by the Director the examiner may enter an examiner's answer responding to the
appeal brief.
(2) *New ground of rejection.* An examiner's answer may include a new ground of rejection.
(underlining emphasis added)

In the interest of compact prosecution and fundamental fairness, it is respectfully submitted that an examiner's answer should not be permitted to include a new ground of rejection.

When a rejection is made final, all of the evidence, grounds, etc. of the rejection should already be made of record so that Applicant has a fair opportunity to evaluate the propriety and desirability of filing an appeal (e.g., versus an RCE or other action that may be taken). Consequently, no new grounds of rejection and

no new evidence should be permitted after an Applicant has filed an Appeal Brief.

In the rare and extraordinary circumstance in which an Examiner feels compelled to newly present grounds of rejection and/or evidence after an Appeal Brief has been filed, the Examiner should reopen prosecution so that Applicant has a fair opportunity to consider and address such new grounds and/or evidence.

This will facilitate expediting prosecution and therefore ultimately reduce overall pendency before the Office.

These comments are submitted on my own behalf as an independent attorney and registered patent practitioner. The views expressed herein do not necessarily reflect those of any past, present, or future client, associated attorney, or affiliated law firm.

Sincerely,
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