



The proposed changes are particularly objectionable in the instance of a first action indication of allowability of all claims and simultaneous issuance of a Right of Appeal Notice. In such a situation, a patent owner could be denied its statutory right to propose amendments during reexamination (see 35 U.S.C. 314), as amendments to claims are expressly barred once the Notice of Right to Appeal is issued.

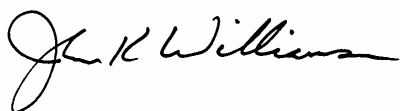
As background discussion, it is noted that if an examiner initially believes art cited in a third party request for *inter partes* reexamination does not raise a substantial new question with respect to patentability of the issued claims, the third party request should be denied (Section 1.923), and reexamination SHOULD NOT BE ORDERED. Conversely, where the examiner believes a substantial new question as to patentability is raised in the request, the order for reexamination should contain the first office action on the merits (see Section 1.935), which presumably in most cases would NOT be a notice of patentability of all claims. While it appears that a “first action on the merits” determination of patentability of all claims after ordering reexamination would be an unusual situation, the comments in the proposed rules clearly do acknowledge such possibility, and make it clear the proposed changes are intended by the PTO to be applicable in such a circumstance.

We suggest that the PTO’s objective of streamlining prosecution after a determination of patentability of all claims has been made could be achieved (in a manner consistent with the patent owner’s statutory right to propose amendments during reexamination) by providing a patent owner an opportunity to expressly waive its right to submit comments/amendments under current Section 1.949 upon receipt of a notice of allowability of all claims. Such an express waiver by a patent owner would preclude any opportunity for third parties to respond, such that a Right of Appeal Notice could be immediately issued.

Finally, we note that the proposed rule changes appear to raise a question (presumably inadvertently) as to a lack of any express requirement for an examiner to set forth grounds for not making any third party proposed rejections (as required in existing Section 1.949) upon a determination of patentability of all claims (which would only be covered in Section 1.953 in the proposed rules).

In view of the above comments, we request that the PTO not adopt the proposed amendments to Sections 1.949 and 1.953.

Sincerely,

A handwritten signature in cursive script that reads "John K. Williamson". The signature is written in black ink and is positioned above the printed name and title.

John K. Williamson  
President