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Box Comments-Patents

Assistant Commissioner for Patents

Washington, D.C. 20231

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Attention: Jeffrey V. Nase

Dear Sir:

Re: Section 1.116

In the commentary on Section 1.116, there appears the very sensible paragraph that follows:

> "Section 1.116, as proposed, would not affect the authority of an examiner to enter in an application under final an amendment that places the application in condition for allowance, but does not strictly meet the requirements of § 1.116(a). That is, in instances in which the applicant and examiner agree on an amendment that would place the application in condition for allowance, the examiner would retain the authority to enter the amendment, notwithstanding the requirements of § 1.116(a)."

But this is not what proposed Section 1.116 says. In pertinent part, Section 1.116 says the following:

> "(a) After a final rejection or other final action (§ 1.113), amendments are limited to cancelling claims or complying with any requirement of form expressly set forth in a previous Office action.
>
> * * * * *
>
> (b) Any amendment not in compliance with paragraph (a) of this section must be submitted with a request for an application under § 1.53(b)(3) to ensure its consideration."

Let us take an example of what would happen:

An application is placed under final rejection and an interview is held with the Examiner who has charge of the application. Certain changes in the claims are proposed which are of a substantive nature, and the Examiner agrees that these would place the application in condition for allowance. But because the amendment is not limited to cancelling claims or complying with any requirement of form expressly set forth in a previous Office Action, the Examiner cannot enter the amendment unless a request for an application is filed under Section 1.53(b)(3).

Why should a new application be filed when agreement has been reached on the old one?

Under those circumstances, why would an Examiner grant an interview, when even complete agreement at the interview could result only in the filing of a new application?

And why would an applicant request an interview, when even the most successful interview can only result in the filing of a new application? When the new application is filed, then the applicant is entitled to a non-final first action. That would be the time to hold the interview, not in the parent application.

The result will be this: in those original applications that are disposed of following the first action, the practice will be unchanged. But in those cases in which a final rejection is entered, the application will almost automatically proceed through refiling, followed by a first non-final action on the merits, followed, if necessary, by a final rejection.

The result would be roughly a 50% increase in an Examiner's work load. This would be more than paid for, by the fact that two filing fees would be received by the Patent Office. But how can it be argued that this is in compliance with the Commissioner's mandate to improve service to the public at the lowest cost? Are three actions on the merits instead of two, an improvement of service? Is the resulting delay in prosecution and the increase in pendency a service either to the applicants or to the public?

Therefore, I suggest that, at the end of the first sentence of Section 1.116(a), that is, following "in a previous Office action", the following be inserted:

> --, but in instances in which the applicant and the Examiner agree on an amendment that would place the application in condition for allowance, the Examiner retains the authority to enter the amendment--.

Even this would be useful only in those cases in which agreement was reached at the interview to allow the application. Examiners being normally and reasonably and sensibly cautious, such a commitment is not usually made. The usual result of an interview is that no agreement is reached but that the Examiner considers the matter after the amendment is filed. In fact, I often tell Examiners at an interview that they should not decide in the heat of the moment, but rather should decide only after reflection on the subsequently-filed amendment.

But should we have to pay a filing fee for such reflection? Ordinarily, after an interview, nothing more is needed than a perusal of the amendment, and a review of the cited references.

If you want to make a charge for this, fine, but don't charge a filing fee. Instead, charge a petition fee. Thus, an amendment filed following an after-final interview, where no agreement was reached, would be accompanied by a petition and a petition fee of $130, whereupon the Examiner would make the required perusal and would determine whether the amendment did or did not place the application in condition for allowance. If it did not, then upon notification the request for an application under Section 1.53(b)(3) could be filed.

In such cases, the applicant should have the option of the less expensive petition for consideration of the amendment after final, or the more expensive CPA. This could be provided by amending Section 1.116(b) by inserting, after "submitted" in line 3 thereof, --with a petition under Section 1.182 or--.

Authority to decide such petitions would of course be delegated to the Examiner who had conducted the interview, who would be required to give only a simple yes or no to entry of the amendment, with no reasons to be given in support of the decision. It would be reasonable to require such a simple response within one month of filing of the petition and amendment; but of course none of this need be recited in the rule.

Insertion of the petitions option would have the advantage, to applicants, of hastening issuance and reducing cost; and it would have the advantage to the PTO of reducing workload, shortening pendency, and at the same time adequately compensating the PTO for a brief consideration of a post interview amendment after final.

In my 48 years in patents I have conducted well over 5,000 interviews after final rejection; and in light of that experience, it seems to me that the PTO and the applicants and the public would all benefit from the above refinements.

Alternatively, as has been suggested by others, the present practice could be left as it is for the first amendment after final, and the proposed new rule could be applied only to any subsequent amendment after final. In my view, this too would be a completely acceptable solution to the problem of multiple amendments after final.

Respectfully submitted,

By

Robert J. Patch

RJP:sg