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To: regreform@art.uspto.gov  
Subject: Comments on proposed change to 37 CFR 1.116

Please consider the following comments on the PTO's proposal to amend 37 CFR 1.116 to further restrict the circumstances under which a reply after final rejection would be considered. I oppose the proposed amendment to Rule 116.

First, with respect to the amendment to Rule 116 that deletes the phrase "Amendments presenting rejected claims in better form for consideration on appeal may be admitted," I do not understand the need to make such an amendment. The PTO apparently contends that the current procedure of entering such amendments delays the ultimate issuance of the application for a patent, since applicants will have to await a ruling on whether to obtain the entry of such amendment. Any such delay, however, is of the applicant's own doing. Clearly, if applicants do not wish to cause such a delay they do not have to file such an amendment. The PTO also contends that the current practice places a significant burden on Office resources. As a former Examiner, I do not know what resources are being referred to. The burden on the Examiner is very small in this regard and ultimately may reduce his or her burden if an appeal is eventually filed. Certainly the Board of Appeals will have an increased burden if the proposed rule change is implemented since the Board, as well as the Examiner and the applicant, will have to address issues that could otherwise have been eliminated by an amendment entered following an appeal. Further, such amendments are not entered until a Notice of Appeal is filed. If the burden the PTO refers to is related to entering the amendments, perhaps they should not be entered until an appeal brief is filed.

Second, with respect to the amendment to Rule 116 that limits amendments after final to those "cancelling claims or complying with any requirement of form expressly set forth in a previous Office Action," I believe that this change shall result in the forced filing of many more file wrapper continuation applications (or continued prosecution applications). In the many years I have practiced before the office, I have obtained the allowance of at least forty applications as a result of filing an amendment (or response without amendment) after a final rejection in which I did not merely cancel claims or comply with some requirement as to form expressly set forth in a prior office action. I had also allowed many applications after final rejection as an Examiner. Had the proposed Rules been in affect during those years, I would have had to file a file wrapper continuation application or file an appeal to have these applications allowed. How does the current practice cause delay in these circumstances?

Typically, claims are added or amended following a first office action which commonly results in a new ground of rejection presented in a final office action. By not allowing applicants to submit arguments against these new grounds of rejection in an after final response, the PTO is ensuring that an applicant will have no recourse but to file a file

wrapper continuation when they amend or add claims in response to a first office action. Additionally, I often file the arguments that I plan on presenting in an appeal brief in a response after final to allow the Examiner to consider the arguments so that I can determine whether a time-consuming appeal is necessary. Clearly, the proposed change to Rule 116 will NOT reduce any delay in pendency periods. Further, the addition number of file wrapper continuations applications and appeals that will be filed will add to the PTO's burden, not lessen it.

Regarding the supposed quid pro quo of expressly eliminating the possibility of a first action final rejection, I believe that most practitioners would rather have the ability to file responses after final rejection rather than be assured that they will not receive a first action final rejection. Because most skilled practitioners may easily avoid a first action final rejection, I do not believe that giving up the ability to file a response after final is a fair tradeoff.

Respectfully submitted,

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