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To: BPAI Rules
Subject: Comment regarding Proposed Bd.R. 41.39

Revolving Door of Prosecution

*Provide that any new evidence relied upon in a rejection set forth in an examiner's answer shall be designated as a new ground of rejection (the notice also includes a good survey of case law to help determine what constitutes a new ground of rejection) (Referring to Proposed Bd.R.41.39).

Examiners frequently encounter new arguments, interpretations of law, which are raised for the first time on appeal. Therefore, they must frequently introduce new evidence to properly address new arguments, new defintions, or new determinations levels of skill of those skilled in the art, any or all of which were not raised by applicants during prosecution. It is often the case that, had the appellants raised the new arguments/definitions/determinations during the period when prosecution was open, the matters could have been trivially addressed using extrinsic evidence for both factual matters (such as published dictionaries) or legal matters (such as the MPEP or Chisum on Patents for esoteric interpretations of statutes by attorneys). Raising the hurdle for bringing the case to the Board for such common circumstances risks rewarding an applicant who unnecessarily prolong prosecution. Moreover, the rule is abusable for apellants who introduce dillatory arguments in order to delay prosecution.

The specific discussion for the new proposed rule at 75 Fed. Reg. 219, 69838 states:

If new evidence (such as a new prior art reference) is applied or cited for the first time in an examiner's answer, then Proposed Bd.R. 41.39(a)(2) requires that the rejection be designated as a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection and be designated as a new ground of rejection. *In re Hoch,* 428 F.2d 1341, 1342 n.3 (CCPA 1970).

Mere citations to dictionaries, encyclopedias, recognized legal references, hornbooks, and concievably even the MPEP, appear to trigger the "new evidence, thus new grounds of rejection required" interpretation. Under this interpretation, Proposed Bd.R 41.39 provides appellants a "Revolving Door of Prosecution" where appellants may purposely introduce a deliberate misintepretation of jargon/well known terms, a

completely new argument that is nonetheless supported by different (but equally valid) portions of the same prior art reference already made of record, or other such procedural manipulation, and thereby "Revolve" the state of prosecution between legitimate closure and procedural loophole reopen. This wastes the time of the examiner who must provide new office actions without credit or alternatively present to the director why this "new grounds" should proceed to the Board, the director who must review and approve these cases, the office (which pays for the former two), and perhaps even the applicant who may not be dictating prosecution tactics.

The currently notice further enumerates several factual situations that constitute a new grounds of rejection, and several that do not constitute a new ground of rejection. However, the common theme amongst these examples involve different intepretations/portions of prior art of record, and therefore do not shed light on extrinsic evidence introduced to clarify this potential procedural abuse.

For the foregoing reasons, the currently proposed rule both introduce unnecessary burdens to the office and permit procedurally sanctioned delays in prosecution.

Alternatives

The notice in the Federal Register states that the purpose of the proposed rule is to resolve the apparent contradition where:

> Thus, applicants are able to present rebuttal evidence in response to a final rejection,
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> while they are not permitted to do so in response to an examiner's answer on
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> appeal, unless an answer is designated as containing a new ground of rejection.

This is an important goal. However, it is respectfully submitted that a more complete goal would be to create a situation where both appellants may completely and efficiently respond to newly raised arguments and evidence by examiners, and examiners may completely and efficiently respond to newly raised arguments and evidence by appellants.

One simple solution would be to allow not permit appellant briefs to introduce new arguments or substantively change preexisting arguments. Appellants would thus be required to only appeal with arguments for which the examiner had an opportunity to properly rebut during open prosecution. This would not prejudice appellants from introducing arguments since anyone wishing to appeal a case where prosecution has been closed may file an RCE with accompanying remarks before the appeal is filed.

A more narrowly tailored solution in the same vein would be to permit, by default, the examiner to introduce new evidence. However, when writing their brief, appellants have the option of triggering Proposed Bd.R. 41.39 by pinpoint citation of remarks previously submitted during open prosecution. Any argument or aspect of an argument in the brief that is significantly identical to those at the provided pinpoint citation would be protected from new evidence to which they cannot respond.