

From: Jeffrey Grayzel [mailto:grayzel@verizon.net]
Sent: Thursday, October 01, 2015 1:45 PM
To: Trialrules2015
Subject: PTAB suggestion for new rule

Dear PTAB,

I was listening in on the PTAB Boardside Chat today. I posed a question which was not fully answered so I would like to pose a more detailed suggestion again for consideration.

The PTAB needs to consider a rule relating to an Examiner introducing a new reference or new grounds of rejection in his/her Examiners Answer. In my particular case, after 4 rounds of office actions the Applicant decided to take the matter to the PTAB. In the Examiner's Answer the Examiner introduced both a new reference and a new grounds of rejection. First, the present rules should be changed to disallow this unfair practice by rogue Examiners. If they have done their job properly, the Examiner should have applied all relevant art during prosecution and should not be allowed to change the grounds of rejection during the trial process. The Appeal should proceed only on the grounds argued during the preceding office action, which is what prompted the Appeal in the first place. Second, the present rules place the burden on the Applicant to file a form requesting that that the prosecution be reopened when the Examiner has introduced a new reference or a new grounds of rejection. Again, this is unfair to the Applicant who is dealing with a rogue Examiner. The rules should be updated such that prosecution is automatically reopened when either a new reference or new rejection is applied by the Examiner in their Examiners Answer.

Also, can you please provide me the names of the judges that were part of today's Boardside panel. These names really should be listed somewhere within the WebEx application but I could not locate them. Please make sure to include this information in future WebEx presentations.

Thank you for your consideration.

Sincerely,
Jeffrey Grayzel
Independent Inventor