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From: Lee Heiman [mailto:LHeiman@Nathlaw.com]  
Sent: Wednesday, February 22, 2006 5:37 PM  
To: AB93Comments  
Subject: Proposed Rulemaking

Gentlemen:

In response to the solicitation for comments directed to streamlining prosecution, I suggest that consideration be given to amending the rules relating to submissions of prior art by third parties. At present, I would characterize the very limited opportunity for third party submissions as being skewed very substantially toward protecting an Examiner from having to consider third party submissions during active prosecution, resulting in highly relevant prior art, particularly newly discovered or newly available prior art (i.e. recently issued patents, non-English documents, documents newly discovered in foreign prosecution, and the like).

In contrast, it is my personal experience that applications are essentially never in the substantive examination process in the very short post-publication time window during which submissions are permitted, nor usually for some time thereafter. Given that the Office is considering adding a process akin to European oppositions, it seems that this is an area where earlier disclosure of relevant references, which are not otherwise found by the Examiner or disclosed by applicant, will both improve the quality of examination and reduce the need for continuing applications and reexaminations.

One exemplary approach to implementation of a modified third party submission program would be to follow the contours of the current plan for IDSs submitted during prosecution: submissions would be freely permitted if made prior to the later of the first office action on the merits or two months after publication; before final rejection, submissions would be made upon payment of a fee equivalent to the RCE fee if another non-final office action must be issued; after final rejection, submissions would be accepted in the discretion of the SPE, also upon payment of a fee equivalent to the RCE fee if another non-final office action must be issued; and after allowance, submissions would be accepted in the discretion of the Group Director, also upon payment of a fee equivalent to the RCE fee if prosecution must be re-opened. (Fees would be determined by the size of the third party, not the applicant).

Thank you for the opportunity to participate in this process. Please

feel free to contact me if further discussion on this subject is warranted.

Best regards,

Lee C. Heiman, Esq.  
Nath & Associates  
112 S. West Street  
Alexandria, VA 22314  
703-548-6284  
703-683-8396 fax