

**From:** Bruce Lilling [mailto:[Bruce@lilling.com](mailto:Bruce@lilling.com)]  
**Sent:** Thursday, March 30, 2006 7:06 PM  
**To:** AB93Comments  
**Cc:** 'Jackie Zion'; 'Sean Kelleher'  
**Subject:** Changes To Practice For Contiuing Applications, etc

The basic objection to this rule is that it will frequently require us to criticize examiners.

In the more than 30 years I have been practicing I have been scrupulous to avoid criticizing examiners and I do not let our employees criticize examiners.

A first reason is that, just as we have respect for federal judges when we are in court, we have respect for examiners, who are government employees. It is not our style to go around criticizing people. Besides, the PTO rules require a level of decorum, and properly so, when dealing with examiners.

Besides, from a practical perspective, criticizing the person who is handling your case is not generally a preferred way to get the examiner to agree with you and to allow a case.

Do you know how often under the guise of saying an amendment raised new issues, examiners do a new search, find a new reference and make a final rejection when they should be making a non-final action.

Often if we are requesting a second RCE, we will now under this rule be forced to say it is due to the fact that the examiner did a lousy job of examination and did not do a complete search and we could not present this amendment and argument previously because the examiner did not cite this reference earlier.

How does this type of dialogue help prosecution?

It doesn't

Instead, how about a rule that if an examiner cites a reference for the first time he cannot make the action final unless he explains in detail why he did not find the reference during his original search, and he should be required to say something more extensive than just the boiler plate language that the search was required by the amendments.

In our experience, the amendments usually do not create new issues and they are clarifying the previously stated position.

Do these rules pertain to divisional applications?

Why should they pertain to CIP applications?

To me any rule which raises the specter of having to criticize examiners is not beneficial to anyone. I do not want to criticize examiners, but this rule will force us to do so from time to time and that is very, very counterproductive.

Bruce E. Lilling  
Lilling & Lilling, PLLC  
Suite 401  
7-11 South Broadway  
White Plains, N.Y. 10601  
914 684-0600 ext 1  
Fax: 914 684-0304

