

Dey, Terry

From: Philip Meyers [pmeyers@dhc.net]
Sent: Friday, April 28, 2006 7:31 PM
To: AB94Comments
Subject: Comments on Proposed Rules

Jon Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office

Re: Comments on Proposed Rules: "Changes to Practice for
Continuing Applications" 71 Fed. Reg. 48 (January 3, 2006)

Dear Sir:

I am concerned that the proposed changes to continuation and RCE practice are not counterbalanced by changes in 37 CFR 1.113, which permit examiners to make any second action final. The following is a common scenario: an examiner makes a rejection based on one set of prior art, applicant responds to it effectively and amends the claims. The amendments could be extensive or minor. The examiner then rejects the claims a second time, relying on different art and rendering the first examination and response moot. In making the second rejection, the examiner's action states that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a)."

There is no limit to the number of times the examiner can change his or her mind on what prior art to cite. Accordingly, an examiner can keep on making new rejections with new art until the applicant runs out of continuations and RCE's and has no effective way to respond to the ever-changing rejections. Rule 113 needs to be changed so that examiners cannot manipulate the prosecution in this fashion. I suggest at a minimum that examiners be prohibited from relying on new prior art in a final rejection, or after an appeal has been taken.

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