

From: Sean P. Suiter [sps@suiter.com]

Sent: Friday, February 26, 2010 4:58 PM

To: BPAI Rules

Subject: Written Comments to the Proposed Modification to the Final Rule

Dear Director Kappos,

In regard to the proposed Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals, Section 41.39 (Examiner's Answer), this rule would legitimize and make easier the current (and all too common) examiner practice of wasting applicant resources. Some rejections are illegitimate and often appear as premised only on an examiner's need to produce a rejection. It is difficult to overcome such a rejection without an appeal. Once an appeal has been filed and briefed, an examiner capable of such conduct is then confronted with exposure before the Board (or SPE). Under the proposed rule such an examiner will simply avoid exposure and the task of writing a brief by entering new grounds for rejection. Such conduct must be exposed and punished--not enabled.

The proposed rule (41.39) is also contrary to current 37 CFR 1.104(a)(1) and (b).

The proposed rule would reward bad behavior and further erode confidence in the patent process. The proposed rule would not produce any desirable result or effect. Examiners must be encouraged to meet and exceed their requirements under 37 CFR 1.104(a)(1) and (b).

If an examiner has made a mistake, only legitimately discovered on appeal, they may, under the current rules, enter a new grounds of rejection by consulting with their SPE (this commentator believes Director approval should be required; MPEP 1207.04). This requirement is not too onerous given what such a mistake causes an applicant (it is often the difference between success and the failure of their project, e.g., two or three years into a project with no patent and exhausted funds guarantees no further funding and support).

Wasting resources should not be dismissed or excused because examiners are challenged and the office is busy and some applicants have sufficient resources.

In 1995 more than 21% of all patents were owned by individuals. As of December 31, 2008 this number had fallen to 17% (by 2025, at this rate of decline, individuals will constitute less than 12%). Examiners must be

encouraged to take all applications seriously and approach them with the care and effort their duty requires.

Acting in my individual capacity:

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