

Subject: Comments on Proposed Rule Changes

Commissioner for Patents,

It is respectfully requested that you consider the following comments with respect to proposed rule changes of September 12, 2003:

Rule 1.105

The examiner has the burden of establishing a prima facie ground of rejection under the patent statute (or applicable case law, i.e. double patenting). Existing rule 1.105 already allows the examiner to obtain needed factual information by asking for field of search information, references and other factual information which enables the examiner to review and consider pertinent facts to help in establishing a prima facie ground of rejection. Such a prima facie ground of rejection requires a response by the applicant which may require the applicant to address issues presented in the proposed rule amendment.

However, the proposed rule 1.105 amendment additionally allows the examiner to ask for "Technical information...concerning the interpretation of...". This in fact is a general asking of an interpretation (i.e. opinion) of the specified items. In the absence of any prima facie ground of rejection (which the examiner has the burden of advancing) the "interpretations" required by the proposed rule amendment amount to no more than an attempt to force the applicant to make prejudicial statements on the record with no statutory basis for doing so.

Rule 1.111(a)(2)(i)

The proposed rule change in relation to supplemental responses after a non-final action would essentially prevent the filing of any supplemental response even where the examiner has not taken the earlier response up for consideration (i.e. even where there would be no additional burden on the examiner). This would force postponing even minor corrections until after a final rejection (with entry then being at the examiner's discretion). As such, this rule change represents an unneeded narrowing of applicant's procedural ability to prosecute the application with no real benefit to efficiency in the prosecution process (and with possible lengthening and increased expense of the process). If a bright line rule is needed to reduce examiner burden in some way, a reasonable time limit for submitting a supplemental response might be proposed (e.g. 3 months after the first response).

Rule 1.17(f)

The proposed amendment to this rule would raise Petition fees to obtain a filing date to \$400 (from \$130). This is satisfactory provided that the PTO will refund the fee when the failure to award a filing date was the result of PTO error (e.g. lost papers in the PTO). Otherwise charging applicants for PTO errors would be inappropriate.

Respectfully submitted,

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