(17)

WIGMAN, COHEN,
LEITNER & MYERS, P.C.

HERBERT COHEN
VICTOR M. WIGMAN
GEORGE C. MYERS, JR.*
SAUL LEITNER
EDWARD J. PARRELL
MICHAEL C. GREENBAUM
JAN CHRISTENSEN
DOROTHY H. PATTERSON
MICHAEL D. WHITE
JONATHAN M. COHEN*
JANICE WALLACE*
SUZANNE F. GISLER METZLER*
KARL O. NEIDERT*
JOSEPH O. SEEBER
*BAR MEMBERSHIP OTHER THAN D.C.

ATTORNEYS AT LAW
THE FARRAGUT BUILDING
SUITE 1000
900 17TH STREET, N.W.
WASHINGTON, D.C. 20006
(202) 463-7700

INTELLECTUAL PROPERTY LAW
INTERNATIONAL TRADE LAW
OF COUNSEL
DONALD R. GREENE
FACSIMILE: (202) 463-6915
E-MAIL: iplaw@laser.net

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BOX COMMENTS - PATENTS
Assistant Commissioner for Patents
Washington, D.C. 20231

Attention: Jeffrey Nase

FAX: (703) 308-6916

Re: Comments on Proposed Revision to PTO Rules

Dear Sir:

The proposed amendments to 37 CFR §1.116 are overly restrictive and should be reconsidered. The effect of these rule amendments will be to effect a change from compact prosecution to hyper-compact prosecution. Moreover, the asserted quid pro quo of no first action final rejection under proposed amended 37 CFR 1.113(c) for a continued prosecution application filed under 36 CFR 1.53(b)(3) is illusory.

First, as now proposed, §1.116(a) expressly limits amendments after final rejection to "cancelling claims or complying with any requirement of form expressly set forth in a previous Office Action." The proposed rule expressly deletes the provision that "Amendments presenting rejected claims in better form for consideration on appeal may be admitted." Proposed 37 CFR 1.116(b) provides that "Any amendment not in compliance with paragraph (a) of this section must be submitted with a request for an application under §1.53(b)(3) to ensure its consideration." As a consequence of these proposed changes, entry of amendments after final which solely correct rejections under 35 USC §112, second paragraph, must be made by refiling the case as a continued prosecution application. The Examiner either has no discretion in this matter, or, if he still has any discretion, it clearly will

not be an abuse of that discretion to require the case to be refiled just to overcome a §112, second paragraph, rejection.

The consequence of this proposed requirement is extremely harsh in that in order to place the case in condition for allowance if a §112, second paragraph, rejection is the only remaining rejection, the case must be refiled. Moreover, the Examiner benefits immensely. If a §112, second paragraph, rejection is made of claims which are submitted with a first amendment (responsive to a non-final first action) in the parent application, the Examiner will get credit for three (3) counters upon the filing of the continued prosecution application which overcomes the §112, second paragraph. rejection: one counter for the express abandonment of the parent under 37 CFR 1.53(b)(3)(i)(B); one counter for a first action in the CPA application; and one counter for the disposal of the CPA upon allowance. Under the current rules and practice, if the only remaining rejection is under §112, second paragraph, since no new issue is raised and the amendment will place the case in condition for allowance, amendments after final which overcome §112, second paragraph, rejections are virtually uniformly entered and considered. Under the current rules, when that happens and the case is allowed, the Examiner gets credit for one counter (disposal).

Thus, the proposed after final rule may encourage abuse. It is almost all "quid" (applicants paying more fees under the CPA practice) and very little "pro" (the sole benefit being no first action final rejections).

Second, under the proposed after final rule, just to place a case in condition for appeal will require the case to be refiled if there are §112, second paragraph, rejections. Again, that is subject to abuse. The Examiner is credited with a counter for the express abandonment and a second counter upon entering the §112, second paragraph, rejection and repeating the previous prior art rejection. The Examiner gets credit for two counters so that the applicant can have the privilege of taking the application to appeal.

Therefore, it is urged that proposed §1.116(a) be revised to read:

> "(a) After a final rejection or other final action (§1.113), amendments are limited to cancelling claims, complying with any requirement of form expressly set forth in a previous Office Action, or overcoming rejections under

35 USC §112, second paragraph. Amendments presenting rejected claims in better form for consideration on appeal may be admitted."

Respectfully submitted,

Michael D. White

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MDW:jm