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From: dickapley@aol.com [mailto:dickapley@aol.com]

Sent: Tuesday, July 12, 2005 4:47 PM

To: AB79 Comments

Subject: Comments on Proposed Rule

The following comments are directed to proposed rule making RIN 0651-AB79.

The proposed rule making states, *inter alia*, that the Office will consider an application to be "taken up for examination" when the application is placed on the examiner's docket for action.

This proposed rule is inadequate and unfair for the following reasons.

First, the proposed rule seems to violate the language and intent of the Consolidated Appropriations Act which states in relevant part that the filing of the declaration of express abandonment occur before an examination has been made of the application under 35 U.S.C. 131. 35 U.S.C. 131 states that the Director shall cause an examination to be made of the application. Both sections of the statute refer to an examination.

The rule implementing express abandonment (37 CFR 1.138(d)) must be read within the context of the statute. Therefore, when Section 1.138(d) states "...before the application has been taken up for examination" it means before an examination is made. It does not mean "when the application is placed on the examiner's docket."

Second, the stated rationale for proposing this definition is that the legislation expires in September 30, 2006 and the IT investment needed to do it the right way is not warranted. This is an inadequate reason to circumvent the clear intent of the statute. The USPTO should devise a more appropriate method that is closer to the intent of the statute. My proposal to accomplish this appears at the end of this commentary.

Third, the criteria for determining when an application is placed on the examiner's docket for action will be once the status of the application is "Case Docketed to Examiner in GAU" as shown in PALM. The problems associated with this criteria are as follows: #1) pro-se inventors without knowledge of customer numbers and private PAIR will not be able to access their application; #2) it fails to address transferred cases since the original docket assignment may be changed after the transfer so which date controls?; #3) the proposed rule does not address the filing of a request for a continued examination which usually remains on the examiner's docket in PALM and would seem to suggest that the declaration of express abandonment be filed earlier than the filing of the request for continued examination; and #4) the time an application is placed on an examiner's docket varies dramatically from Art Unit to Art Unit and from Tech Center to Tech Center thereby establishing differing standards for the same rule.

PROPOSED NEW RULE to implement the patent search fee refund: *

The Office will consider an application to be taken up for examination FOURTEEN months after the filing date for an original application; or THREE months after either the filing of a request for a continued examination or the filing date of any continuing application that claims the priority of the parent application or the date of entry of the national stage in an international application.

The Office will notify the applicant if an examination of the application will occur earlier than any of the specified time periods and give the applicant ONE month to submit a declaration of express abandonment. No extensions of time are permitted for filing a declaration of express abandonment are permitted under Section 1.136.

* The intent of the proposed rule is to ensure a fixed or known time period, rather than the USPTO proposed variable and unknown time period. The fourteen months was chosen from the Term Adjustment section of the statute for a first Office action; and the three months was chosen for consistency from IDS Section 1.97 and to permit the filing of a request for nonpublication since the combined time periods(14 + 3 + 17) was chosen to be less than eighteen months.

Respectfully submitted by,

Dick Apley
Reg. # 51,316
Email: Dickapley@aol.com