

**Horner, Linda**

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**From:** Pich, Ponnoreay

**Sent:** Wednesday, November 17, 2010 10:02 AM

**To:** BPAI Rules

Proposed Bd.R. 41.41(b)(2) would provide that any argument which were not raised in the appeal brief and are not made in response to arguments raised in the answer would not be considered by the Board, absent a showing of good cause. This rule disallows new arguments in the reply brief not responsive to the examiner's answer. I think this is a good rule considering the examiner would no longer acknowledge the reply brief and thus would no longer have a chance to respond to any new arguments raised in the reply brief.

Consider though that a similar rule should be adopted for the appeal brief itself. Consider the situation of an original claim having limitation A, B, and C. In response to the non-final, applicant argues the examiner's rejection of limitation A and does not amend the claim. The examiner traverses applicant's argument and issues a final office action. Applicant subsequently files an appeal brief and then argues limitation C.

Should the examiner not have been given the opportunity to respond to an argument to limitation C prior to the filing of the appeal brief? If it turns out that the argument for limitation C was persuasive, the examiner would re-open prosecution. The general perception then is that blame for unnecessarily extending prosecution lies solely on the examiner's side and that it took the filing of an appeal brief before the "unreasonable" examiner took his/her job seriously enough to issue a proper office action.

In the example above, applicant could have presented arguments for limitation C after the non-final rejection or even via an after final response. Instead, by not arguing until the filing of the appeal brief, prosecution is unduely extended and the client has had to pay the Office's notice of appeal fee as well as the associated attorney's fee to write the appeal brief, and further, much Office resources has been wasted due to having to hold an appeal conference to consider an argument which could have and should have been presented earlier.

Adopting a similar rule to the above also for the appeal brief itself would encourage more timely submissions of relevant arguments which would decrease cost to the client and in some cases prevent undue extension of prosecution. The Office discourages piecemeal prosecution by examiners--piecemeal prosecution by attorneys should also be discouraged.

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I would also like to propose a change to 37 CFR 1.111 so that it applies also to all Office actions, not just non-finals. Particluarly, rule 1.111(b) currently requires that applicant specifically point out error in the examiner's position (for non-finals). Doesn't it make sense for this also to apply to finals and examiner's answers? If an examiner cites element X from a reference to meet a claimed limitation, applicant should not at any point be attempting to argue that element Y from the reference does not meet the claimed limitation especially if the examiner has responded back several times already that X was relied upon to meet the limitation, not Y. Such prosecution by applicant's representative seems to purposely ignore the examiner's position and muddle prosecution records.

1/18/2011