From: Warren Wolfeld <wwolfeld@hmbay.com>
Sent: Thursday, September 13, 2012 12:12 PM
To: fee.setting
Subject: Comment on proposed cost increase for second and subsequent RCEs

Dear Ms. Picard:

The new fee structure proposes to increase the cost of second and subsequent RCEs. The Office has indicated its desire to offset the impact of this increase by improving processing options, such as by improving the ability to submit IDSs without requiring an RCE, and by further incentivizing examiners to continue working with Applicants after final rejection.

I would like to suggest that another critical process improvement would be to stop examiners from automatically making second Office actions "final".

Examiners often justify finality of an Office action on the ground that "Applicant's amendment necessitated the new ground(s) of rejection." However, this justification is often made when the Applicant made no amendment at all, or when the Applicant made only a formalistic amendment which did not change claim scope in any way that the Examiner did not already presume or expect.

The Office may not be aware of the prevalence of this dubious practice, because Applicants have no practical recourse when it occurs. It is rarely cost effective to challenge finality, so it rarely reaches a level at which it will be noticed by policy makers.

As a practitioner, I would not find the cost increase for second and subsequent RCEs quite as objectionable if Examiners would be more judicious in evaluating whether it really was the Applicant's amendment that necessitated the new ground of rejection.

Thank you

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