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March 4, 1991

P and T INTERNATIONAL PATENT OFFICE
Post Office Box 32-148
Taipei, Taiwan
REPUBLIC OF CHINA

Re: HU, Pin-Yao- USSN 07/443,403
SINGLE HAND OPERATING PORTABLE AUTOMATIC SCREW SUPPLYING AND BOLT FASTENING MACHINE
Your Ref.: T-245.7/10019920
Our Ref.: HU=2

Gentlemen:

Enclosed herewith is a copy of the Examiner's February 13, 1991, Final Office Action.

Unfortunately, as you will note, the Examiner has virtually ignored our December 10, 1990, response and repeated her earlier rejections.

In order to properly report to you and ascertain the possibility of allowance, we spoke to the Examiner on February 28, 1991, and re-emphasized the position we took in our December 10, 1990, response. We are sorry to report that the Examiner remained adamantly opposed to allowing this application. The primary basis for her position is her indication that she "does not understand how the invention works" and her insistence that supplemental drawings to assist in understanding the invention are necessary.

I asked if such drawings (which we contended were unnecessary), if provided, would be approved. She indicated that they would be considered new matter and not approved. In light of this response, I suggested to the Examiner that it did not appear that she was leaving any means to overcome her rejection. She agreed, and only suggested the filing of a CIP.

Given the Examiner's unduly harsh handling of this application, we view the following to be the only viable options:

1) File a response for the purpose of putting the claims in better condition for appeal;

2) Refile the application as a CIP with ~~a better drawing and explanation of the slideway in which the screws are gathered and are fed to the trough;~~ new claims or

3) Abandon the invention in the U.S.A..

We would advise against pursuing option (1) above, because we believe the Examiner will not allow the application for the reasons noted above and, in order to prevail the client would need to incur the expense of an appeal. Morever, we could make our case stronger so as to have a good chance of success, if your client can show that the explanation of the operation of the slideway that the Examiner demands is known in the prior art.

Assuming your interest in pursuing this case, we would recommend option (2) above, since we believe that amended claims are patentable over the prior art now cited by the Examiner. Further, given the possibility of the case being assigned to the same Examiner, her request for supplemental drawings can be met.

The CIP may be entitled only to the new filing date. If so, it is important to determine whether the invention was "on sale" in the United States over one year prior to the new filing date, was disclosed by publication over one year prior to the new filing date, or was patented anywhere in the world. Any of these events could result in rejection of the application on the basis of prior art.

A shortened statutory period for response has been set to expire in three months, i.e. the last day of the term will be May 13, 1991, unless the term is extended upon petition and payment of an appropriate late fee. As is usual in the case of final rejections, we recommend that if you wish to proceed to file a response for purposes of appeal, the response should be filed within only two months, namely by April 13, 1991. In order to enable us to have sufficient time to prepare and file a response, we would appreciate receiving your instructions by

April 3, 1991.