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From: Clarke, Robert

Sent: Thursday, May 04, 2006 9:08 AM

To: AB93Comments; AB94Comments

Subject: FW: Comments on Proposed Changes to Practice for Continuing Applications

-----Original Message-----

From: Kerry Broome [mailto:klbroome@hotmail.com]

Sent: Wednesday, May 03, 2006 11:06 PM

To: Clarke, Robert

Subject: Comments on Proposed Changes to Practice for Continuing Applications

Dear Mr. Clarke,

Attached are comments in response to the Proposed Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims, Notice of proposed rulemaking, first published in the Federal Register at 71 Fed. Reg. 48 (January 3, 2006).

Sincerely,

Kerry Broome

Reg. No. 54,004

The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property and Director of the United States Patent
and Trademark Office
Mail Stop Comments
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Robert A. Clarke
Deputy Director
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Comments on Proposed Rules: “Changes to Practice for Continuing Applications,
Requests for Continued Examination Practice, and Applications Containing
Patentably Indistinct Claims” 71 Fed. Reg. 48 (January 3, 2006)

Dear Under Secretary Dudas:

I submit the following comments in opposition to the proposed revision of the patent rules of practice entitled “Changes to Practice for Continuing Applications, Requests for Continued Examination (RCE) Practice, and Applications Containing Patentably Indistinct Claims” (the “Proposed Revision”), published by the U.S. Patent & Trademark Office (“USPTO”) on January 3, 2006, at 71 Fed. Reg. 48. While I wholeheartedly support the USPTO’s goals of increasing efficiency, improving the quality of issued patents, and promoting innovation, I respectfully disagree with the Proposed Revision because it is not consistent with those goals.

First, the Proposed Revision would impose on patent applicants and the USPTO an additional layer of procedural review that will decrease efficiency at the USPTO. Instead of streamlining continuing applications or RCE procedures (collectively “continued examination practice”), the Proposed Revision increases procedural hurdles. The Proposed Revision will force patent applicants to submit an additional round of arguments in a petition to show that an “amendment, argument, or evidence could not have been submitted prior to the close of prosecution in the application” and require the USPTO to spend valuable time deciphering an issue tangential to merits-based prosecution.

The USPTO will spend valuable time in weighing the numerous petitions because of the ambiguity of its proposed standard. This ambiguity of its proposed standard exists where the USPTO must evaluate the showing by a patent applicant that an “amendment, argument, or evidence could not have been submitted prior to the close of prosecution in the application....”

This standard leaves the USPTO with little guidance and will likely produce one of two results: (1) petitions will be regularly granted after a cursory review or (2) the USPTO will have to commit substantial resources to conducting an in depth review and analysis for each petition. If

the petitions receive only a cursory review, then the entire exercise is an illogical burden to impose on both the patent applicant and the USPTO in the name of efficiency.

If, on the other hand, the USPTO decides to commit the resources for a full review and analysis of each petition, then the USPTO will have simply transferred the resources that it could have spent making progress on the merits of a continuation patent application or RCE to a procedural hurdle that moves a patent application no closer to resolution. Either way, the Proposed Revision decreases efficiency in the examination process.

Implementing the Proposed Revision would also result in a deterioration of the quality of issued patents. Continued examination practice is widely recognized as a critical component of successful patent prosecution. The current practice of permitting a reasonable number of continued examination filings allows Examiners to become familiar with the subject matter of a patent application, and to gain a more clear understanding of the prior art. I have first hand knowledge that continuation patent applications can permit an Examiner to become “comfortable” with subject matter being claimed.

I have first hand knowledge that continuation patent applications can permit an Examiner to become “comfortable” with the subject matter being claimed because I was a former junior Patent Examiner between 1993-1996 in the USPTO Examining Corps. I served under Mr. Donald Hajec, who was my SPE at the time, and Ms. Janice (Howell) Falcone, who was the Director of Group 2500.

During my employment as a junior Patent Examiner, I found that continuation patent applications allowed me to spend more time on a particular subject matter. I discovered that continuation patent applications allowed me to improve on my searches of claimed subject matter because I was already familiar with entire disclosure of a parent patent application.

With continuation patent applications, I also became very familiar and acquainted with the style and personality of the prosecuting lawyer for the patent applicant. It was usually after a second or third continuation patent application that I became familiar with the prosecuting lawyer and his or her style.

With my increased familiarity of the prosecuting lawyer, the claimed subject matter of a particular continuation, and the prior art, I found that I would sometimes allow broader patent claims. And I believed that the patent applicant was entitled to these broader patent claims after fully evaluating the information that I learned from parent patent applications and the existing continuation patent application.

Therefore, with continued examination filings, I believe that patent applicants can craft more precise claims that give the public accurate notice of a patent applicant’s invention. Indeed, the USPTO acknowledges in its Proposed Revision that continued examination practice “allow[s] applicants to craft their claims in light of the examiner’s evidence and arguments, which in turn may lead to well-designed claims that give the public notice of precisely what the applicant regards as his or her invention.”

The Proposed Revision will hinder the allowance of “well-designed claims” at a particularly critical time. Both the number of patent applications and the number of patentees asserting their legal rights are on the rise. The average cost of litigating a patent runs in the millions of dollars and, more importantly, litigation can be an economic life or death matter for both the patent holder and the alleged infringer. Protecting the full scope of an applicant’s invention may be critical to business success, and those found to have infringed a patent face astronomical damage awards and a crippling injunction.

In this high stakes legal environment, allowing “well-designed claims” that can be developed through continued examination practice should be the top priority of the USPTO. Unfortunately, the Proposed Revision’s restrictions on continued examination practice represent a departure from that goal.

The Proposed Revision may exceed the boundaries of some current statutes. Therefore, we urge the Under Secretary to give serious thought to his statutory authority for the Proposed Revision. Specifically, the language of 35 U.S.C §§ 120, 121, and 365(c) make it clear that an applicant "shall" be entitled to claim priority if certain conditions are met, and the imposition of additional conditions through these rules arguably denies this right of priority.¹

In addition to the possibility that the Proposed Revision may exceed statutory authority, implementing the Proposed Revision will likely increase the cost of patent prosecution for all patent applicants, including small businesses. The requirement of submitting an additional round of arguments to petition for continued examination would not only add the \$400.00 petition fee as stated by the Proposed Revision, but would also require additional attorneys’ fees to prepare the petitions.²

Finally, it is critical that the United States patent system continue to promote innovation. The patent system will only operate as an effective incentive, however, when inventors know that they will be rewarded for the full scope of their inventions. In the nearly one hundred and fifty years since Godfrey v. Eames, 68 U.S. (1 Wall) 317, 325-26 (1864), inventors in the United States have relied on full consideration of their innovations through continued examination practice.

The Proposed Revision would sacrifice that long established precedent -- and with it a critical component of the patent system’s incentive to innovate -- for the mistaken belief that the restrictions would improve efficiency at the USPTO. While improving the speed with which an application proceeds to issue is certainly important to inventors, protecting their legal rights through well crafted and thoroughly examined patent claims is paramount. Any efforts to improve efficiency must not come at the expense of restricting access to continued examination practice and the concomitant setback to innovation in the United States.

As stated above, I support the USPTO’s goals of efficiency, quality, and innovation. The Proposed Revision, however, runs contrary to those goals. Therefore, I respectfully request that the USPTO to not adopt the Proposed Revision.

¹ See also AIPLA’s comments on Proposed Rules; April 24, 2006, pgs. 5-6.

² See also U.S. Small Business Administration’s (“SBA”) comments on Proposed Rules; April 27, 2006.

If Under Secretary Dudas or any of his subordinates would like to discuss any of the issues that I present in this letter, please call me at my Atlanta office number listed below. Please note that the information and opinions expressed in this letter are my personal views and they do not reflect the positions or views of my employer.

Respectfully Submitted,

Kerry L. Broome
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