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From: David Lewis [mailto:davidlewisnmn@yahoo.com]

Sent: Sunday, January 22, 2006 5:59 PM

To: AB94Comments

Subject: Proposed new rules

Dear Sirs/Madams;

The proposed changes to continuation practice, limiting the claims actually examined to the 10 that are designated as representative, and restriction practice, with all due respect, appear to be misguided. The argument that increasing the number of Examiners will not accommodate the increase in volume of applications is unconvincing. These proposed changes significantly limit an applicant's opportunities to obtain good patent protection. The large number of essentially unexamined claims in an application that will most likely result are likely to have a weakened presumption of validity as compared to were the claims examined.

The PTO could increase the fees for filing the third and subsequent continuations and for large numbers of claims. The PTO could also credit Examiners according to the number of claims disposed instead of according to the number of applications disposed. Further, hiring more Examiners will indeed help deal with the PTO's increases in volume. Preventing invalid patents from issuing requires better training of Examiners and giving the Examiners the time to do their work - not penalizing applicants regarding the numbers of claims that are examined and the number of continuations that can be filed. If anything, a continuation in which there is only a small change to the claims is beneficial to the PTO, because such continuations are easy to examine. The ratio of the cost of the Examination to the fees paid is higher, and the Examiner can dispose of them quickly by either making a small change to his/her prior rejection or allowing the case (if the small change makes the case allowable). Since the fees are supposed to pay for the Examination, continuations should result in a net surplus that can be used to fund the more time consuming applications. (If the fees do not pay for the Examination then the fees should be raised instead of deciding not examining certain patent applications.)

Many prospective patent applicants are afraid to file, because they are afraid that someone will make a small change and be able to circumvent their applications. Currently, I can ease the applicants concerns by explaining that if they are entitled to broad protection that is not as likely to happen. Additionally, if they are not entitled to broad protection filing many claims of differing scope may limit the likelihood of such an occurrence. However, broad claims usually require a longer prosecution (despite the tradeoff as to the breadth of protection actually obtained if there is a lot of prosecution history), and limiting the total number of claims (or the total number of claims with a strong and independent presumption of validity) increases the ease of circumventing claims.

In addition to actually weakening the patents that will issue, the proposed rule changes further perpetuate the negative public image of patents being easy to circumvent, which in-and-of-itself further weakens our patent system.

Additionally, many small applicants do not have the money for lots of claims at the time of filing, and need to be able to file a continuation at a later date with more claims after (and if) they receive more funding. Also, currently with small inventors (after counseling them that they will probably lose money on their invention, if they nonetheless still want to file), I can counsel the applicant to file a small number of claims (e.g., 20) at first, so that they can cut their losses (by having a smaller initial investment) if it turns out that they are not able to make money on their invention (which unfortunately is usually the case with small inventors). Currently, if their invention begins to make money while the application is still pending, they can then file a continuation (or two) with additional claims to get the coverage they truly deserve. However, the proposed rule changes encourage the small inventor to put more claims in the first application (because of the uncertainty of whether they will be allowed to file enough continuations later), and therefore the proposed rule changes are likely to cause bigger losses of money to the large numbers of small inventors that are not able to make money on their inventions.

Sincerely,
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