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**From:** Kurt VanVoorhies [mailto:vortekx@lighthouse.net]

**Sent:** Wednesday, May 03, 2006 11:49 PM

**To:** AB93Comments; AB94Comments

**Cc:** Spar, Bob

**Subject:** ATTN: Messrs. Robert W. Bahr and Robert A. Clarke

Attached please find combined comments on the following proposed changes:

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

Proposed Changes to Practice for the Examination of Claims in Patent Applications (71 Fed. Reg. 61 (January 3, 2006)

Thank you very much for your consideration of these comments.

Respectfully,

Kurt L. VanVoorhies

Reg. No. 38,643

906-297-8011

**Comments on Proposed Changes to Practice: 71 Fed. Reg. 48, 61 (January 3, 2006)**

The following submission is a combined response to the following OG Notices dated 24 January 2006:

**Proposed Changes to Practice for Continuing Applications, Requests for Continued Examination Practice and Applications Containing Patentably Indistinct Claims (71 Fed. Reg. 48 (January 3, 2006)**

**Proposed Changes to Practice for the Examination of Claims in Patent Applications (71 Fed. Reg. 61 (January 3, 2006)**

The USPTO has made a compelling case that changes are needed in the patent system order to manage the increasing numbers of applications being filed with associated increased pendencies of applications under examination. The stated objectives of the proposed changes are 1) to make better use of the limited examination resources for examining more “new” inventions rather than “reworking” continued examination filings, 2) to improve quality of the issued patents and promote public certainty, 3) to improve the efficiency of the examination process by requiring more focus on important patentability issues during the first examination of an invention, and 4) to provide a better, more thorough, and reliable examination quality through focused initial patentability examination of a limited number or representative claims selected by applicant.

However, the proposed changes to the rules of practice will seriously erode the opportunities for the applicant to perfect their rights to their invention, by limiting their opportunity to present and perfect claims that would likely be held by a Court of Law -- and upheld by the CAFC – to be valid and literally infringed by another who is practicing that which the inventor has invented. Furthermore, the standard of quality does not appear to fully account for applicant’s interest that their claims be held valid and infringed by one who is practicing that which the inventor has invented. Yet further, it would appear that the concentration on continuing applications and excess claims is misplaced, because the average amount of time spent per excess claim in an application, or per claim in a continuing application – where the examiner already has familiarity with the disclosure and references, and a substantial understanding of the invention, -- must be substantially less than the average amount of time spent per claim in a new application. All parties having an interest in the patent system – i.e. the USPTO, the applicant and the

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public – would benefit from a different approach, a suggestion for which will be provided separately as public input to the USPTO Strategic Plan.

The proposed changes to **37 CFR § 1.78(d)(1)** will limit continuing applications to one of the following four conditions: 1) only one RCE, Continuation or CIP is permitted, 2) only involuntary divisional applications are permitted, and a divisional may claim benefit of only a single prior-filed nonprovisional application, 3) a continuation or CIP application may claim benefit of only a single divisional application provided that no RCE was filed in the prior-filed divisional, and 4) if none of the three previous conditions are met, then a continuation application is permitted with fee and a petition showing that the amendment, argument or evidence **could not have been submitted during prosecution of prior-filed application**. Similarly, the proposed change to **37 CFR § 114** permits a second or subsequent RCE in a non-continuing application or in a divisional application, or any RCE in a continuation or CIP application, only with a fee and a petition showing that the amendment, argument or evidence **could not have been submitted prior to the close of prosecution in the application**.

The standard “**could not have been submitted prior to the close of prosecution in the application**” is excessively stringent, and more so than the standard for filing a reissue application. This standard defies human nature, expecting practitioners to be perfect, even when dealing with imperfect examiners. The standard “**could not have been submitted prior to the close of prosecution in the application**” requires superhuman prescience to anticipate necessary claim language that might otherwise require 20/20 hindsight to later recognize. A patent drafter might not fully appreciate everything that can be claimed of the invention at the time it is first prosecuted. The patent drafter may later discover other references or competitive products that provide a greater appreciation of the distinction between the inventor’s invention and the prior art, so as to be able to more carefully craft a claim that provides a broader or different scope that still narrowly avoids the prior art, and which would likely be held valid and infringed. It would be substantially more efficient for the USPTO to accommodate claim refinements in a continuation application – regardless of how many continuations are filed, – at a time when the application is relatively fresh in the mind of the examiner, rather than to reopen the case years later in the context of a reissue application. With a

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continuation application, the examiner is already familiar with the invention and the prior art, and therefore can address the claim amendments with substantially less time and effort than would be required to examine new claims of a new application to a new and different invention.

The proposed changes to **37 CFR §§ 1.78(f)(3)** and **1.75(b)(4)** enable the Office to require elimination of **patentably indistinct** claims from all but one of several non-provisional applications, including applications for which there is presumed or actual double patenting. The standard “**patentably indistinct**” is overly stringent and might jeopardize an applicant’s ability to ensure that their claims will be held valid and infringed by one who is practicing that which the inventor has invented. The difference in language between two “patentably indistinct” claims may make the difference between literal infringement and prospective infringement under the Doctrine of Equivalents, the latter of which may be next to impossible to find if there had been any amendments to the determinative elements of the claim.

The proposed changes to **37 CFR § 1.78(b)(1)** requires an applicant to submit an examination support document if they wish to have more than 10 claims included as representative claims, without having to submit a suggested requirement for restriction without traverse. The examination support document under **37 CFR § 1.261** is a formidable hurdle for any applicant interested in having their claims held valid and infringed in a Court of Law and under appeal to the CAFC -- even the USPTO representative describing the proposed changes observed that applicants would not likely want to submit such an examination support document. Accordingly, an applicant with a complex invention with more than 10 aspects separately providing for novelty of the underlying invention would be faced with the otherwise excessively expensive proposition submitting to restriction and the resulting multiplication of filing, issuance and maintenance fees, for claims that would logically be incorporated in a single application, albeit with substantial excess claims fees in view of the latest USPTO fee increases. For example, if one or more independent claims in the application as filed are rejected for novelty, the remaining dependent claims – which could likely exceed 10 in number – could each provide a subsequent independent basis for novelty. However, in view of the requirement to select 10 representative claims, if all of the representative

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claims are then subsequently rejected, then there would be no examination of the remaining dependent claims even though these may have provided a separate basis for novelty. In view of the proposal to limit the number of continuations and RCE's, the applicant will have been put in the unfortunate position of having their first and only chance for examination of the non-representative claims to be in either an RCE or a continuation, without further prospects for the continued examination thereof if the results of the RCE or continuation are unsatisfactory to the applicant.

The proposed changes to the rules unduly burdens and limits the applicant, and likely reduces the prospects of having their claims held by a Court of Law or the CAFC to be valid AND infringed by one who is practicing that which the inventor has invented, particularly for a complex invention. How does this "promote the Progress of Science and useful Arts" as mandated by the Constitution?

The undersigned strongly urges the USPTO to **not** adopt the proposed changes to the rules, but instead to consider other options that address the real problem, which the undersigned respectfully submits is the examination of patent applications for inventions that are either never reduced to practice or which are never commercialized, and for which there is never a real need to perfect the associated rights of exclusion that a Letters Patent would provide. If applicants are given a right to delay examination indefinitely over the 20 year life of the non-provisional application, provided that the application is published, and if the public is given the opportunity to initiate a request for examination of an application, then applicants will benefit from not having to incur the costs of examination and issuance of patents for which they are uncertain of the merits of their invention, the public will benefit from the publication of the application and the opportunity to initiate examination if they have a commercial or competitive interest in the invention and wish to know the metes and bounds of the claims, and the USPTO will benefit from not having to examine so many applications to new inventions. This will free up examination resources to work on the examination of applications for commercially important inventions for which the right to exclude is necessary, and to examine any continuations that the applicants believe are necessary to secure their full rights to exclude others from practicing the invention that they have invented. This would also free up examination resources to provide for the reexamination of patents

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under infringement litigation, so as to assist the Courts in objectively verifying that the claims at issue are patentable, and perhaps to assist the Courts in an objective interpretation of those claims. These and other suggestions will be expounded upon in forthcoming comments to be provided in response to the USPTO's request for public input on the new USPTO Strategic Plan.

Pareto's principle, also known as the law of the vital few or the 80-20 rule, provides that in anything a few (20 percent) are vital and many (80 percent) are trivial. In view of this principle, it may be suggested that a relative few of the patent applications have vital commercial importance, and should not be encumbered by the proposed changes to the rules. Instead, other changes can be crafted which will be beneficial to all of the interested parties, and which will provide for a substantial reduction to the burdens of the USPTO.

Respectfully Submitted,

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