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**From:** Rich Additon [mailto:[additon@summalaw.com](mailto:additon@summalaw.com)]

**Sent:** Tuesday, May 02, 2006 4:25 PM

**To:** AB93Comments

**Subject:** Request for Comments

Please consider the attached comments regarding the U.S. Patent and Trademark Office's proposed rules—continuing applications (71 Fed. Reg. 48) and claim examination (71 Fed. Reg. 61).

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May 2, 2006



John J. Doll, Commissioner for Patents  
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VIA EMAIL

Attn: Robert W. Bahr, Senior Patent Attorney  
Office of the Deputy Commissioner for Patent Examination Policy

Sir:

This responds to the U.S. Patent and Trademark Office's request for comments regarding its proposed rules with respect to continuing applications (71 Fed. Reg. 48; January 3, 2006) and claim examination (71 Fed. Reg. 61; January 3, 2006).

I am a registered patent attorney and member of the American Intellectual Property Law Association (AIPPLA). I fully support the AIPPLA's analysis of and opposition to these proposed rules as set forth by Mr. Michael Kirk, the AIPPLA's Executive Director, in two April 24, 2006, letters. The AIPPLA's assessment of these proposed rules demonstrates that the proposed rules are arbitrary and capricious. The PTO should heed the AIPPLA's advice with respect to each of these proposed rules.

I write to express my concern that the conceptual framework of the proposed rule changes to continuing application practice is irreparably flawed. I urge the PTO to abandon its proposed changes to continuing application practice.

\* \* \*

In brief, the PTO seems to be ignoring the reality that implementing rules that will compel inventors to prosecute fewer claims and fewer applications will lead to less patent protection for inventors. In effect, the PTO is proposing a rationing scheme for patent examination, a function that is exclusive to the federal government.

On one hand, the PTO proposes to limit its initial examination of claims to no more than ten representative claims. As a conceptual matter, focusing on independent claims at the outset of examination is sensible. (This is particularly so if the PTO were to encourage rather than discourage the filing of multiple dependent claims and perhaps relax its prohibition against multiple dependent claims that depend on other multiple dependent claims.)

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On the other hand, the PTO proposes to limit inventors who, via continuing applications, seek to fully protect their inventions. The PTO's rationale seems to be that it is unnecessary and perhaps unreasonable for inventors to pursue protection for their inventions in multiple continuing applications. This reasoning fails to appreciate that many inventions, if not most, are developed incrementally.

By pairing a reduction in the initial examination of claims with an arbitrary restraint to continuing application practice, the PTO is proposing changes to patent practice that would impede inventors who seek full patent protection for their inventions. Contrary to the PTO's assertion, it is the proposed rules, not the existing rules, that will impose a burden on innovation. Global competitors to U.S. technology should be pleased that the PTO has decided to limit U.S. patent rights rather than meet its Constitutional responsibility.

\* \* \*

Of these two sets of proposed rules, the proposed changes to continuing application practice are especially troublesome. The PTO's justifications for radically changing continuing application practice, however, are unpersuasive.

*The proposed rules ignore the 20-year patent term*

In its notice of proposed rule making (71 Fed. Reg. 48) the PTO cites a 1966 (!) report that recommends restricting continued examination filings. Forty years ago applicants could extend the effective patent term by filing continuing applications, each of which would carry a 17-year patent term as measured from its date of issuance.

The present 20-year patent term, which is measured from the earliest claimed priority date, effectively precludes applicants from extending patent term in this way. Unlike prior statutory law, the 20-year term generally encourages applicants to seek earlier patent protection rather than later patent protection (*i.e.*, delaying prosecution shortens patent term). The PTO's concern that too many applicants are delaying the conclusion of examination is unpersuasive in the framework of a 20-year patent term.

*The proposed rules fail to appreciate the effects of international prosecution*

Moreover, the PTO appears to ignore the inherent unfairness of its proposed rules for applicants who simultaneously prosecute U.S. and PCT applications. PCT applicants sometimes receive international search reports, written opinions, and international preliminary reports on patentability after a notice of allowance has been received for a counterpart U.S. application. In accordance with current patent practice, such applicants are compelled to file a request for continued examination to disclose to the U.S. examiner information pertaining to the counterpart PCT application. Under the proposed regulatory scheme, the filing of an RCE to make of record a post-allowance information disclosure statement (*e.g.*, disclosing information relating to the counterpart

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PCT application) would exhaust an applicant's single continued examination opportunity.

*The proposed rules are the wrong mechanism for providing public notice*

The PTO states that multiple applications may leave the public uncertain as to the coverage of a patent family and suggests that this burdens innovation. Public access to U.S. patent prosecution records, however, has never been more open. Indeed, the Patent Application Information Retrieval (PAIR) system facilitates public access to published applications.

Rather than so radically altering continuing application practice, the PTO's concerns about public notice might be better addressed by making immediately available on PAIR any continuing application that claims priority to a published parent application (*i.e.*, rather than upon the child application's publication). The PTO could also move toward a post-grant, European-style opposition period during which the public could oppose issued patents.

Curtailing continuing application practice (and thereby limiting the ability of inventors to pursue full patent rights for their inventions) is not the appropriate solution to a perceived public notice problem.

*The proposed rules fail to acknowledge that applicants may be justified in seeking patent rights sooner rather than later*

Implementing the proposed rules with respect to continuing applications would disadvantage inventors; achieving adequate patent protection will become more difficult. For instance, individual inventors and smaller companies without comprehensive patent portfolios must ensure that the patents they do acquire are commensurate with their inventive contributions. At the same time and for various reasons, such small entities feel pressure to attain patent protection sooner rather than later if their inventions are to succeed commercially.

For instance, where pending applications include both allowable and rejected claims it is often prudent for such small entities to achieve patent protection sooner for the allowable claims and to pursue the rejected claims later in continuing applications. This is hardly a misuse of continuing application practice. First, it encourages inventors to bring new technologies to market sooner. Second, it is the inventors (or their sponsors) who sustain the costs to prosecute these continuing applications and to maintain multiple issued patents.

*The proposed rules fail to appreciate that many inventions are developed incrementally*

Inventors—particularly individuals and small entities that typically do not have the resources or expertise to prepare for and prevail in interferences with larger

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competitors—sometimes file patent applications for inventions that are in development to secure an earlier filing date for the completed inventive aspects. Under the proposed rules, however, inventors would be faced with the untenable decision of either securing an early filing date for those aspects of an invention that are complete (and perhaps being precluded from seeking additional patent protection by way of one or more continuing applications) or delaying filing until an invention is deemed to be “finished” (and perhaps losing rights altogether to aspects of the invention).

The proposed rules regarding continuing application practice fail to acknowledge that many inventions are developed incrementally. It is a strength of the U.S. patent system that inventors are able to seek additional protection for their inventions by way of multiple continuing applications. Rules that provide by right only a single continued examination opportunity are misguided.

*The proposed rules involve unfair retroactivity*

Finally, whereas the proposed claim examination rules (71 Fed. Reg. 61) are mostly procedural, the proposed continuing application rules are largely substantive. Changing continuing application practice as proposed will certainly lead to a loss of inventor rights. This is so not only for new applications but also, as the PTO makes clear, applications that are now pending before the PTO. This retroactive effect is unfair—it will preclude inventors from achieving patents rights to which they are entitled.

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In closing, the PTO admits it “has no authority to place an absolute limit on the number of copending continuing applications originating from an original application.” This is as it should be. The PTO should withdraw its proposed rules pertaining to continuing application practice and focus its efficiency efforts elsewhere.

Respectfully submitted,



Richard L. Additon