

From: Bob Barton [mailto:bob_barton@charter.net]
Sent: Tuesday, April 18, 2006 9:43 AM
To: AB93Comments
Subject: Continuation Application comment

Hello,

I am a Pro Se inventor having a published patent and have submitted one continuation application and plan to submit another.

The benefit of continuations, specifically CIPs, is that the inventing and commercialization process is fraught with time and financial pressures. In the effort to commercialize a first patent, inventors typically fully disclose to potential competitors details of the current invention, show working samples and discuss how to improve the current invention in an effort to bring it to market. During those times, new information, market concerns, cost issues, etc, lead the inventor and the competitors to think about how to improve the existing design which often leads to patentably different inventions. It also leads the inventor to discover weaknesses in the original filing that were part of the original invention's thought process but never included in the application. Items and functionality that are also patentable.

In order to overcome these weaknesses as well as protect any new approaches to improve upon the current invention, a new application must be filed to protect the intellectual property of the patentable components of the improvements. A continuation-in-part is the process of choice because it allows for improvement in quality of the original invention as well as improved quality of the patent itself, even though it relies on the prior patent.

To require the submission of a statement of 'why the amendment or evidence could not have been submitted with the previous application' may affect a new iteration of arguments which could lengthen the examination period and take up even more examiner's time, thus having the opposite effect stated in the summary of proposed rule changes.

Answering the question of 'why' does not contribute to the patentability of the new material. The applicant must still meet the requirements of novelty, best mode, etc. which still define patentability. The requirement of answering the question allows the reviewer to take a position that the statement is a good reason - or not - increasing time and energy spent on arguments, not decreasing it. I submit that since the examiner wasn't part of the process which led to the CIP, they are at a disadvantage to make such an assumption of a good reason why.

I don't pretend to know the patent system well, but I need to be assured that any new and useful improvements over my original patent can be protected. I know there is abuse of the system - any system, but answering the question of 'why' seems irrelevant to patentability - it's just another point of argument which could lengthen the time it takes to prosecute the application. Your goal is to simplify the examination and the prosecution proceedings and I applaud that, but please do not make the determination of patentability include a rule which dilutes the real requirements of patentability.

Respectfully submitted,

Robert A. Barton