

Chang, Joni

From: Korzuch, William
Sent: Wednesday, April 26, 2006 9:47 AM
To: AB93Comments
Subject: FW: Proposed Continuation Rules

Here are some comments that were submitted related to the proposed continuation rules.

Thanks – Bill Korzuch
Detailer, Office of the Commissioner for Patents

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

From: George Blasiak [mailto:blasiak@wallmarjama.com]
Sent: Monday, April 24, 2006 1:21 PM
To: Doll, John
Subject: Proposed Continuation Rules

Mr. Doll,

I am a partner at an IP firm in Syracuse, NY.

I have read through the proposed new rules and the Office's PowerPoint presentation materials.

One weakness of the proposed rules that I see is that they do not take into account continuations or RCE's that are regularly filed by applicants for purposes of having additional art references considered after close of prosecution. Such RCEs and continuations may be termed "enforceability-saving" RCEs and continuations.

Currently, an applicant who wishes to have a new reference considered after an issue fee is paid or after the close of prosecution where a statement under 37 CFR 1.97(e) cannot be made must file an RCE or continuation to have the reference considered. Note that the statement under 37 CFR 1.97(e)(2) cannot be made where an applicant was previously aware of the existence of a reference but becomes aware of a reference's materiality after the close of prosecution. Thus, if an applicant is aware that the 100 column Jones reference exists, but only becomes aware that there is a material teaching in one column of Jones after the close of prosecution, the applicant must file an RCE or continuation under current rules to have Jones considered or else any issuing patent is by definition unenforceable.

There are numerous situations in which applicants may be required to (or may wish to for issue removal purposes) cite art references after the close of prosecution. Late art references may include art from a foreign counterpart applications, art from a tangentially related US cases, art uncovered pursuant to a due diligence sweep by the applicant, and art strategically foisted on the applicant by a would be infringer after payment of the issue fee.

Dealing with these late appearing references is already extraordinarily burdensome for applicants. When a late appearing reference turns up it often means thousands of dollars in additional cost to the applicant and a delay in issuance of months or even years. The proposed rules would make dealing with late references even more burdensome for applicants. Apparently, under the proposed rules, an applicant would be forced to "use up" a free RCE/continuation if a late reference appears. I have the following questions.

1. Can you please explain where the proposed rules take into account the fact that applicants must regularly file RCEs and continuations in order to have additional art references considered by the Office for purposes of preserving an application's enforceability?
2. Has the Office ever considered implementing a rule wherein an applicant's duty to disclose ceases at the close

of prosecution?

3. When can the public expect to know after May 3, 2003 whether the proposed rules will be implemented?

Best regards,

George

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