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From: Block, Jim [mailto:BlockJ@diebold.com]
Sent: Mon 5/1/2006 3:21 PM
To: AB93Comments
Cc:
Subject: Comment Regarding 71 Fed. Reg. 48 (03 January 2006)

Dear Madam or Sir:

I would like to comment on the subject proposal and strongly urge that the proposal NOT be adopted.

I am directly associated with the innovation and intellectual property processes for a large US company who designs a variety of technology-based products for the global market. However, I believe the opinion expressed in this note is equally valid for individual inventors as well as business of all sizes.

Innovation is a critical success factor today in business today, whether from a lone inventor or a large corporation. Obtaining rights to novel, useful, inventions is one of the most important safeguards against losing the advantages innovation brings. For this reason, it is increasingly important to apply for those rights as soon as possible after an invention can be characterized and formulated into an application. But the innovation process isn't always obvious, and what begins as a set of novel and useful claims can be discovered over time to actually contain more novel and useful claims than originally thought (more than originally applied for). As designers are added or otherwise come and go off a multi-person project, it is a natural byproduct of imaginative people to see possible unique claims that others up to that point had not seen relative to the invention.

If the practices of the proposal were to be realized, it would be essentially required that the inventor...desiring to make his/her application as quickly as possible to protect the claims they initially see...include as many unique claims as can be imagined in the shortest time possible. If the proposal were to be enacted, it would either suppress the possibility of additional innovative claims discovered later in the project, or require a new application to be filed with these additional unique claims. The former works against the goal of encouraging innovation and the latter essentially exacerbates the stated problem of backlog the proposal is trying to address - resulting in additional 'first applications'.

Additionally, any additional legitimate claims made in a first application would potentially be suppressed by the element in this proposal that aims to require applications with near-same filing dates, overlapping disclosure, common inventor, and assignee be made in the same original application (the *'patentably indistinct claims'* portion of the proposal). This presents quite a disadvantage to the inventor. They must foresee all of the unique claims of their original invention very early in the process which is often not possible...yet any not included could not be claimed without the considerable cost of convincing the USPTO of their case.

Though I acknowledge that the 'first application' backlog essentially stifles innovation itself by impeding prompt attention to those new applications, innovation is also stifled by restricting continuation applications - as the subject proposal would certainly do.

If the purpose of improved efficiency in the USPTO is to improve the ability to keep up with the ever increasing pace of innovations by inventors, then stifling innovation ANYWHERE is counter-productive to that end.

Please do not enact the proposed practice...it will surely stifle innovation.

Thank you for your consideration of these comments.

Sincerely,

Jim Block
Diebold
Director, Global Advanced Technology
Tel: 330-490-4688 (Eastern U.S. Time Zone)