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**From:** Steven Colby [mailto:scolby@carrferrell.com]

**Sent:** Fri 4/28/2006 5:33 PM

**To:** AB93Comments

**Cc:**

**Subject:** Comments on proposed rules relating to continuation practice

Dear Commissioner:

I believe that the proposed rule changes relating to continuation practice would have serious unintended consequences that have not been fully thought out. As both an inventor and a practicing patent attorney my practice would change in ways that only increase the work load at the USPTO. For example:

1) Instead of filing continuations I would be forced to both petition and appeal final office actions. By filing even a first continuation, I may be seriously limiting my clients' future rights. Thus, appealing will almost always be the more prudent alternative. The result will be a substantial shift of work from the examination corps to the appeal boards. It will also significantly raise the cost of patent applications (e.g., by \$8000 to \$10,000 per appeal) and thus particularly hurt those applicants that are individual inventors and start-up companies.

2) The prosecution times of applications will be extended. Under the current rules when some claims are allowed it is common practice to take those claims and pursue any un-allowed claims in a continuation. Under the proposed rules, this practice will be ended. Instead, I will continue prosecution of the un-allowed claims in the same application. Thus, it will be common for allowable material to be delayed in issuing as a patent. I foresee applications wherein most claims are

allowable going through an expensive appeal process merely to preserve the possibility of getting a couple of additional claims.

3) The number of patent applications filed will jump sharply. Under the current rules, an applicant can postpone costs by filing a series of continuations over time. Under the proposed rules, I will be advising applicants, who can afford it, that they file multiple applications including different claim sets based on the same specification on the same day. This will be the only way that I can attempt to cover all inventions that may be included in a specification. The fact that divisionals could be allowed under the new rules will not matter because I will have no way of knowing in advance what future claims would be considered by the USPTO to be continuations rather than divisionals.

This issue is already affecting my practice. I currently have a client who has a series of 7 provisionals that were filed starting on May 6<sup>th</sup> of last year. These provisionals are loosely related in that they are based on the same fundamental breakthrough and cover application of this breakthrough to different applications. Under the old rules, I would have filed a non provisional on the anniversary of the first provisional and then a series of CIPs on the anniversaries of the other 6 provisionals. Now I'm advising my client to file all 7 applications at once, even though the last provisional was filed just a month ago. This advice is based on the possibility that the proposed rules may be approved and we would be prevented from filing later applications that took benefit of the earliest filing date. In this case, even if the claims in later applications were directed at clearly

different inventions, I cannot depend on filing divisionals because there isn't such a thing as a divisional-in-part. All CIPs, even on unrelated inventions, will count toward the "one allowed continuation."

4) There will be a significant ambiguity as to what constitutes a divisional vs. a continuation. Unless the USPTO can devise a very clear bright line, significant USPTO resources will be spent handling petitions, appeals and even Federal Circuit cases related to this issue. It will be years before the court could create a bright line, if such a bright line is even possible. The fact that guidance on this issue is not included in the proposed rules is evidence that such a rule will be very difficult to devise. This will introduce a great deal of ambiguity in the patent process. Further ambiguity is the last thing that either the USPTO or applicants need at this point.

The criteria included in the MPEP for determining restriction requirements is focused on searches that an examiner may or may not have to make. These criteria are related to the patent classification system, which is an artificial classification system that doesn't always reflect how similar two claimed inventions are. These criteria would, thus, be inappropriate for determining if an application is a continuation or a divisional.

Further, restriction practice appears to increase and decrease periodically and to vary significantly between examiners. Patent prosecutors assume that there has been an internal USPTO seminar on the subject every time there is an increase

in restrictions. It hardly seems proper that substantial patent rights, such as the ability to file further claims, should depend on these somewhat arbitrary factors.

Because of the above issues, I strongly urge that the proposed rules regarding continuation practice not be adopted. Their effect on patent prosecution will result in more work and expense for all parties. At the USPTO work that is now done by the examination corps will be shifted to the appeal boards. This is a much less efficient use of resources and will result in extended prosecution times. Further, there is likely to be an increased number of nonprovisional applications that will reduce any benefit gained from limiting continuations. Finally, the proposed rules will significantly hurt applicants with limited financial resources, e.g., individual inventors and start-up companies.

Sincerely,  
Steven M. Colby  
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