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From: Mike Curtis [mailto:Mike@greenwin.com]

Sent: Tuesday, May 02, 2006 1:15 PM

To: AB93Comments

Subject: Comments opposing rule changes

Dear Commissioner Doll,

These comments are presented on behalf of Greenlee, Winner and Sullivan, P.C. opposing the United States Patent and Trademark Office's Notice of proposed rules changes entitled "Changes to Practice for Continuing Applications . . ." published January 3, 2006, at 71 Fed. Reg. 48. Our firm represents clients that include universities, non-profit research organizations, large corporations, small businesses and independent inventors. In the interest of our clients, we believe the proposed rules limiting continuation applications and Requests for Continued Examination are ill advised and would significantly harm patent practice.

Today's applications often must be very complex to adequately describe and capture the full extent of the invention. Applicants must describe the invention in sufficient detail to satisfy the written description and enablement requirements of 35 U.S.C. 112. At the same time, the Patent Office discourages applications containing a large number of claims, such as through excess claims fees. This puts the applicant in a precarious position because subject matter that is disclosed in the patent application but not claimed may be considered dedicated to the public and lost, Maxwell v. J. Baker, Inc., 86 F.3d 1098, 39 USPQ2d 1001 (Fed. Cir. 1996). Despite spending considerable time and resources to develop an invention, an applicant may not know at the time of filing which embodiments of the invention represent the best commercial embodiment, what claims are financially feasible to prosecute, or how a competitor may attempt to copy the invention or circumvent patent protection. Continuation practice has, up until now, allowed an applicant to pursue initial claims to their invention while also preserving the ability to pursue additional patentable subject matter that is later discovered to be economically important. As the Patent Office noted, the Federal Circuit considers the addition or amending of claims to encompass the devices and processes of others to be a legitimate practice, PIN/NIP, Inc. v. Platt Chemical Co., 304 F.3d 1235, 64 USPQ2d 1344 (Fed. Cir. 2002). The proposed rules would force applicants to increase the number of claims filed in the initial application for fear of not being able to capture otherwise patentable claims in a continuation. This pressure to increase the number of claims in the initial application is inconsistent with the Patent Office's other proposed rule changes that seek to limit the number of representative claims. While the proposed rules may decrease the backlog of continuation applications, they would also increase the effort needed to examine initial patent applications.

A chief concern of the Patent Office is that such continuation practice defeats the public notice function of the initial application and prejudices the public. However, this is not the case. The public is made aware of the invention when an application is published and is further made aware of the enforceable claims when a patent issues. If the issued claims are not substantially identical to the claims of the published application, the applicant is

not entitled to provisional rights provided under 35 U.S.C. 154(d). In addition to receiving the benefit of the invention's disclosure on publication of the application, the public can determine whether a continuation application has been filed through the public PAIR system, or when the continuation or continuation-in-part applications are themselves published. Thus, the public has adequate notice of the applicant's invention, enforceable claims, as well as any pending application that might produce additional claims. Furthermore, Congress amended the patent laws so that the patent term of a continuation expires twenty years after the filing date of the initial patent application. Any applicant that delays examination through continuation practice does so at the expense of patent term.

The Patent Office recognized in the Notice of proposed rules changes that applicants often use continued examination practice to obtain further examination rather than file an appeal. Filing a Request for Continued Examination (RCE), for example, is cheaper, faster and more efficient than going through the appeal process. Contrary to the Patent Office's concern, the arguments presented in such continued examination often do advance prosecution of the claims and often are used to overcome improper rejections by the examiner. The proposed rules would merely shift, not decrease, part of the backlog to the appeal process. While the new appeals procedures instituted by the Patent Office are certainly a step in the right direction, they do not adequately reduce the current backlog of appeals or the increased backlog that would result from the proposed rules. Even with the Patent Office's efforts to improve the appeal process, it remains much more efficient for both the applicant and the Patent Office to address questionable rejections through continued examination practice rather than through appeals.

The proposed rules would also greatly increase the backlog for the Office of Petitions. Requiring applicants to file a petition for a second or subsequent continuation application or RCE will likely translate into thousands of additional petitions per year. The proposed rules would again merely shift, instead of decrease, part of the backlog from the examining corps to a different branch of the Patent Office. The increase in petitions also means applicants as a whole will have to pay hundreds of thousands of dollars in additional petition fees per year. The effect of this additional cost on non-profit organizations and small businesses should not be underestimated by the Patent Office. An applicant who files the petition and corresponding fee will further face a great deal of uncertainty whether or not the petition will be granted. During this time the applicant would be in limbo regarding the status of their invention before the Patent Office. Complicating matters is the fact that the Patent Office has not provided guidelines clarifying under what circumstances a petition for additional continuation practice would be granted, or when a petition would be denied.

The proposed rules effectively limit the opportunity for an applicant to convince the examiner that the claims are patentable. If the Patent Office were to limit the number of continuation applications and RCEs, then the quality of examination must first be improved. Often applications receive piecemeal examination, where all of the available rejections are not presented in a single office action, or a low quality examination, which prevents the applicant from crafting well-designed amended claims or advancing

prosecution. It should be noted that many of the public comments already received by the Patent Office have placed a large amount of responsibility for the number of continuation applications and RCEs on improper rejections by the examiner. Similarly, examiners currently have an incentive, namely receiving an additional count for a disposal, to refuse amendments or arguments in order to force the applicant to file a continuation application or RCE. This incentive for examiners to force an applicant to file a continuation application or RCE must be removed before the Patent Office places restrictions on continuation practice.

Any significant barrier in the cost or procedure of patent prosecution caused by the proposed rules will have a chilling effect on patent applications and innovation, especially by universities, non-profit research organizations and small businesses that are likely to have limited resources. While it is an admirable goal to decrease the backlog of patent applications, such action should not be done at the expense of legitimate patent interests or increase the difficulty of obtaining meaningful issued claims. Accordingly, we urge that the Patent Office not enact the proposed rules.

Sincerely,

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