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Sent: Tuesday, May 02, 2006 12:14 PM

Subject: rule change comments of John James McGlew

Please find attached (pdf) the comments for John James McGlew as to <http://www.uspto.gov/web/offices/com/sol/notices/71fr48.pdf> Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims, Notice of proposed rule making

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**DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
37 CFR Part 1**

[Docket No.: 2005-P-066]  
RIN 0651-AB93

**Changes To Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims  
COMMENTS SUBMITTED BY JOHN JAMES MCGLEW**

The USPTO is responding to the apparent difficulty in providing quality examination at the rate applications are being filed. The solution proposed attempts to limit examination by limiting continuation applications and requests for continuing examination (RCE). The rationale for this is based on considering each application examined as a unit with the rule forcing less application units. However, the USPTO does not provide any basis for the unit approach. Individuals that are involved in prosecution consider the work on such continuations to be a fraction of the work involved with new applications. The concept that each continuation examined can be replaced with an examination of a new patent application is clearly flawed. However, the deeper problem is that no one, including the USPTO, can predict the effect such changes will have on overall work and overall costs. Since such continuations serve a purpose, one can conclude that if the existing continuation practice is ended, the quality of the overall product will be affected negatively.

As many aspects of patent prosecution are interrelated, changes to continuation practice will affect other things. More new applications could be filed. The changes could result in claims being drafted seeking a restriction requirement. Petitions regarding whether claims are patentably distinct could increase drastically. Many more cases may be appealed. Some cases may be appealed simply to preserve pendency. The applicant may be forced to appeal instead of accepting coverage, instead of working further with the examiner in a continuation or RCE. Possibly, the rules will lead to situations with an appeal on the original application and an appeal on the first and only continuation application. A great deal of resources may be used for considering ancillary issues, examination problems, and petitions. The solution proposed may well raise the overall operating costs of the USPTO.

The proposal takes away continuation practice without taking away the practice of finally rejecting claims based on a new ground of rejection (that can include previously unknown prior art). Compact prosecution allows the USPTO to make rejections final that are a first rejection, namely a new ground of rejection. The applicant has always been given the opportunity to amend the claims in response to a final rejection that is a new rejection. Making a new rejection and not allowing further amendments is not a viable system. Further, the new rules present an opportunity for abuse and potentially unfair results. At the very least, if the rule change is adopted, the USPTO should change its guidelines so that no rejection may be made final that is based on a new ground of rejection.

The proposed rules do shift resources from an area of expertise, namely examination, to an area of fact finding and ruling on non substantive issues. The USPTO has in the past noted it

is not equipped to properly handle fact inquires. The USPTO has noted it has expertise in prior art evaluation and examination on the merits. The administrative burden on the USPTO as to decisions on form and fact issues, such as petitions, has grown over the years. The proposed rules effectively add further matters to be decided on petition, effectively shifting resources from an area of expertise to an area the USPTO has in the past admitted, it is not equipped to handle. The USPTO should move in the opposite direction, limiting matters of form and limiting petitionable matters. The focus must be on building up the Examining Corps and more and better examination on the merits with simple examination procedures.

To allow new applications to be picked up more quickly, the USPTO could give priority toward examination of new applications. Examination Groups could be given the latitude to pick up RCEs or continuations in a delayed manner. This could be linked to how many continuations have already been filed (e.g., a third continuation or RCE could be queued for examination after new applications filed at the same time). Instead of focusing on building up the Examining Corps, the proposed changes essentially seek to limit the depth and extent of prosecution and examination. Resources should be directed toward examination. If the outcome of the change is not certain, as is the case, the USPTO should not deflect its resources away from maintaining a solid Examining Corps. A good Examining Corps is a national resource. If the new application backlog is growing, the USPTO has faced this problem before. The traditional approach of growing the USPTO and building up the Examining Corps provides more certainty than rationing examination.

It could be said that besides the growing backlog of cases, there is another linked problem, namely political pressure focused on numbers rather than quality of examination. This is particularly a problem with there being no link between revenue from fees and the funds available to maintain the Examining Corps. The real thing that needs to be changed is to hire and train more Examiners and to make the USPTO a place where technically trained people want to work. Examiners must feel that there is a significant purpose to what they do and be rewarded financially and by a sense of job well accomplished. The staggering rate at which Examiners have left in recent years points to not only a problem of pay but also of work environment.

The rules should not be changed as proposed. The USPTO proposal is too drastic with the result unknown. The USPTO needs to be patient. New technologies should still have a significant positive impact on costs and efficiency, as new systems become more familiar. With electronic filing now more user friendly, there will be time savings for the USPTO and the applicants. Foreign office searches can never be given full faith and credit (because of law differences and claim differences). However, systems that present the US examiner with all prior art considered in related matters will have a positive effect as to efficiency. Shrinking and stabilizing the backlog is possible. More resources should be directed now toward the Examining Corps.

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