-----Original Message-----
From: Stevens, Richard L. [mailto:RLSTEVENS@PARTNERS.ORG]
Sent: Wednesday, May 03, 2006 3:55 PM
To: AB93Comments
Subject:

MASSACHUSETTS
GENERAL HOSPITAL

Corporate Sponsored Research & Licensing
Thirteenth Street, Building 149, Suite 5036
Charlestown, Massachusetts 02129-2000
Tel: 617.726.8608, Fax: 617.726.1668

May 3, 2006

Robert W. Bahr
Mail Stop Comments-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Mr. Bahr:

The recent attempt by the United States Patent and Trademark Office (the Office) to address the projected, sustained and substantial influx of patent applications filed at the Office and the associated effects of said influx, e.g., the backlog of unexamined patent applications, that is reflected in the Proposed Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims (The Proposed Changes), Notice of proposed rulemaking as set forth in the Federal Register at 71 Fed. Reg. 48 (January 3, 2006) is acknowledged and appreciated by the Corporate Sponsored Research and Licensing Office (CSRL) at the Massachusetts General Hospital (MGH).

As a non-profit academic teaching hospital that engages in a high volume of internally and externally funded research, MGH regularly generates discoveries that have the potential to improve healthcare. CSRL functions to support such research and enable the translation of the discoveries into products than can potentially improve patient care. In most cases, enabling translation of the discoveries requires filing at least U.S. patent applications on the discoveries (the Applications) and then subsequently licensing the Applications to entities deemed best suited to successfully translate the discoveries.

In some instances, seeking comprehensive patent protection for the discoveries may require filing multiple continuing applications, e.g., continuations and/or continuation-in-part applications or requests for continued examinations, on the Applications and/or multiple applications that: 1) have the same effective filing dates as; and 2) share common inventorship with the Applications (Unrelated Applications). This is especially true for the discoveries that are biotechnological in nature in view of the recognized complexity and flux of the biotechnological patent law *and the fact that many of such discoveries are early stage and under progressive and optionally multi-party collaborative development*. [Emphasis added.] Successful attraction of licensees to the

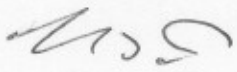
actual or potential claims of the Applications, or multiple continuing applications thereon, or the Unrelated Applications is in part significantly enhanced when the licensees can reasonably project the cost of enforcing such claims. Content that is added superfluously to the prosecution histories of the Applications and/or the multiple continuing applications thereon and/or the Unrelated Applications will detract from the licensees' ability to reasonably project the enforcement costs of the aforesaid claims thereby resulting in a decreased likelihood that the Applications and/or the multiple continuations thereon and/or the Unrelated Applications will be licensed.

It is the opinion of CSRL that, if adopted, the rules set forth in the Proposed Changes (the Proposed Rules) would require the addition of superfluous content to the prosecution histories of the Applications and/or multiple continuing applications thereon and/or the Unrelated Applications because: 1) it would at least force applicant rebuttal to what appears to be a flawed Office established presumption that the filing of a second continuing application or request for examination indicates an attempt to frustrate the advancement of the case to final agency action by the applicant[1] and; 2) it would force applicant patentability arguments with respect to the claims filed in the Unrelated Applications prior to receiving a first Office action on the merits based on what appears to be a flawed Office established presumption that claims in applications that share effective filing dates and common inventorship are patentably indistinct.

In view of the foregoing, CSRL is opposed to the adoption of the Proposed Rules in their entireties as it believes such adoption would reduce the likelihood of successfully attracting licensees to the Applications and/or continuing applications thereon and/or the Unrelated Applications thereby resulting in stunted translation of the discoveries yielded from research that is conducted at MGH into products that have the potential to improve patient care.

Despite the above, CSRL is cognizant of and sympathetic to the fact that the Office has been faced with substantial operational issues that have at least been caused by the aforementioned influx of patent applications at the Office. It is CSRL's belief that if the Office: 1) created and adopted rule(s) that would allow deferred examination of applications; and 2) granted authority to the examiners of crowded art units to delegate their search duties to employees that have been specifically retained by the Office to conduct prior art searches the operational issues confronting the Office would, at least partially, be resolved.

Respectfully submitted,



Richard L. Stevens, Jr.
Intellectual Property Manager

---

[1] The Office notes on page 49 in the Proposed Changes that, "*...a small minority of applicants* have misused continued examined practice with multiple continued examination filings in order to simply delay the conclusion of examination." [Emphasis added.]