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To: AB93Comments

Subject: Comments on proposed rules changes for continuation practice

One of the justifications advanced by the USPTO for the limitations on continuations is that some applicants are abusing the system by filing repeated continuations in order to delay issuance for as long as possible (the "submarine" strategy). This is exactly the behavior that was already addressed by Congress when it adopted the 20-years-from-filing system, and when it authorized publication of most applications 18 months after filing. In addition, the doctrine of prosecution laches has been judicially revived in recent years to address this issue. The USPTO does not need to impose draconian limits on all applicants in order to address the misbehavior of a few, when other adequate avenues exist.

The USPTO acknowledges that federal case law makes it clear that it has no authority to place absolute limits on continuation practice. Instead, it has made the acceptance of continuations (subsequent to the first) discretionary with the Office, while making it clear that the requirements for acceptance will be stringent. It is by no means clear that the Office has the authority to so drastically limit the statutory rights granted under 35 USC 120. If the Office believes that such limits are necessary, it should seek authorization from Congress, rather than attempting to change the patent statutes by administrative fiat.

The proposed limits on continuation practice are particularly troubling when taken in combination with the proposed changes to examination. In particular, when only independent (or designated) claims are initially examined, it can be expected that it will take more exchanges between applicant and examiner to determine proper claim scope. In current practice, if a broad claim is rejected, the applicant has a choice of amending or arguing. The interaction and dialogue with the examiner frequently leads to filing an RCE before agreement on claim scope is reached. Under the new examination rules, the applicant will no longer have the guidance of a full search and examination to decide on a strategy for amendment, argument, or a combination. Therefore, the application is even more likely to come to a final rejection, with no way to obtain additional examination without filing the one and only available continuation or RCE.

Faced with this eventuality, practitioners are likely to file petitions to remove finality (which are now rarely filed because they typically cost more to prepare than the fee for filing an RCE) and/or appeal briefs. The Office can thus expect to see a massive increase in petitions to remove the finality of a rejection, as well as the number of appeals. It is already widely perceived within the patent bar that examiners are increasingly reopening prosecution after filing of appeal briefs (the AIPLA Comments on Continuing Application Practice cite one firm that received only 9 Examiner's Answers in response to 121 Appeal Briefs over a 27-month period). Thus, filing an appeal brief may come to be seen as a way to get additional examination without the need to "burn" the only available continuation or RCE. Both petitions and appeal briefs are wasteful of both practitioners' and USPTO efforts, and detract from the core mission of the USPTO to examine applications for patentability. The enormous increase in appeals that can be expected if the new rules are adopted would also overwhelm the newly-cleared appeal docket and take us back to the days of multi-year waits for resolution of patent appeals.

Even as practitioners use petition and appeal to try to mitigate the costs of the rule changes, the ultimate effect will be that patents will issue with narrower claims (which will in turn lead to an increase in filing of broadening reissues, further burdening the Office). Rather than adopting strategies that penalize applicants who attempt to obtain the full scope of patent coverage to which they are entitled, the USPTO needs to refocus on its core mission: issuing patents covering that which has actually been invented, no more and no less.

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