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Pages to Follow: 2 **Today's Date:** 05/01/2006 **Time:** _____

TO: Robert W. Bahr

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EST 1880

May 1, 2006

Mail Stop Comments - Patents
Commissioner for Patents
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Attn: Robert W. Bahr

Good Morning:

The United States Patent and Trademark Office (PTO) published a Notice of proposed rule making on January 3, 2006 entitled, "Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims." I am writing to express the opposition of the Intellectual Property Law Section of the Ohio State Bar Association to these proposed rule changes.

A fundamental goal of the patent laws is to enable inventors to protect their inventions. Many times when a new product is being developed all of the patentable inventions that may be associated with that product are not immediately apparent. In addition, after the first patent applications are filed on a product that is being developed, numerous significant improvements are often made, which improvements may also be separately patentable. Under current PTO rules and applicable law, inventors can obtain patent protection for these later recognized and/or subsequently developed related innovations through the filing of amended or different claims in Requests for Continued Examination (RCEs), continuations or continuation-in-part applications.

The proposed rule changes will prevent many patent applicants from obtaining patent coverage of the full scope to which they are entitled. The proposed rule changes would require patent applicants to prove they could not have presented their new claims earlier, in order to have the claims considered in a second RCE or continuing application. That test will often be impossible to satisfy. In addition, applicants' claims of different scope in subsequent applications are often prompted by actions by the PTO, such as the citation of prior art or the presentation of different arguments as the basis for rejecting claims. As such, the proposed rule which would preclude patent applicants from presenting claims of different scope in an RCE or continuing application would unfairly deny many applicants the ability to obtain patent coverage of the full scope to which they are legally entitled. The proposed rule changes would be particularly harmful to small businesses.

Also opposed are the proposed rule changes that would create a presumption that patent applications claim patentably indistinct subject matter if they are co-owned, name a common inventor, relate to similar subject matter and are filed within two months of one another. Forcing a patent applicant to prove that the claims in each of an inventor's patent applications are patentably distinct from all others would constitute an unfair burden and impose an unreasonable additional cost. Products are usually developed through the efforts of teams of inventors. The same inventor may contribute to many

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different inventions included in patent applications related to a single commercial product. The proposed requirements to track patent applications naming any common inventor, and to prove to the Patent Office that each patent application is patentably distinct, will require resources which will add to the already high cost of patent prosecution. The Patent Office's current rules related to obviousness type double patenting adequately address this issue and should be maintained.

These rule changes if adopted will prevent many patent applicants from adequately protecting their inventions. These proposed changes will also add further cost and complexity to the already complex and expensive patent prosecution process. The proposed rules would be particularly harmful to small businesses. For these reasons the proposed rule changes should be rejected.

The PTO's own Notice of proposed rule making explicitly states that these proposed rule changes will impact only a small number of patent applicants. As the stated purpose of the proposed changes is to help the PTO reduce its backlog of unexamined patent applications, the Notice of proposed rule making itself shows that the proposed rules only have a minimal impact on the problem that the PTO is seeking to address. We encourage the PTO to reject these proposed rules and to continue its efforts to hire and maintain an adequate staff of patent examiners. We also encourage the PTO to reduce the issuance of repeated nonfinal actions and prosecution reopenings after appeal, to help reduce the current patent backlog of unexamined patent applications.

The PTO should not ignore the widespread public opposition to these proposed rules. The recent statements by PTO officials that the PTO will enact these rules despite overwhelming opposition, and despite the PTO's acknowledgment that the proposed rules will provide no benefit to patent applicants, suggest a need for a different approach to managing the PTO.

The Ohio State Bar Association Intellectual Property Section has more than 800 members who represent businesses of all sizes, independent inventors, and academic institutions. The Ohio State Bar Association, founded in 1880, is a voluntary association representing approximately 25,000 members of the bench and bar of Ohio, as well as nearly 4,000 legal assistants and law students. Through its activities and the activities of its related organizations, the OSBA serves both its members and the public by promoting the highest standards in the practice of law and the administration of justice.

Sincerely,

Jane Taylor

E. Jane Taylor
President

cc: The Honorable Mike DeWine
The Honorable George Voinovich
Howard S. Robbins, Esq.
Ralph E. Jocke, Esq.