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May 3, 2006

Robert J. Spar, Director
Office of Patent Legal Administration
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RE: Comments on Proposed Changes to Practice for Continuing Applications,
Request for Continued Examination Practice, Applications Containing
Patentably Indistinct Claims as Presented in the Federal Register Volume
71, No. 1 of Tuesday January 3, 2006

Dear Mr. Spar:

The Webb Law Firm is a mid-sized law firm with an exclusive domestic and international practice in intellectual property representing a diversity of clients ranging from large corporations to individual inventors. We have the following comments based upon our experience with such clients:

A primary purpose of the proposed rule changes for continuation practice is to assist the Office with reducing the backlog and the pendency of patent applications filed with the USPTO.

Problem: The Office has stated that it is impossible to “hire our way out” of this and is committed to hiring 1,000 patent examiners during each of the next four years. However, the Office is experiencing exceptionally high attrition and, as a result, even with such ambitious hiring goals there is concern that only a fraction of those examiners may remain with the Office for a substantial amount of time.

Suggestion: Regardless of any rule changes that may reduce the number of patent filings, which itself seems to be counter to the goal of the USPTO, or make the examination of patents easier for the Office – any such changes will be meaningless if the Office

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cannot retain the critical number of Examiners to handle the patent filings. The cost of living in the Washington area, its location on the eastern edge of the United States, and the transient population living in that area are disincentives for many potential employees to consider the Office as a place of employment. Therefore, although it may occur over a long time, we suggest that the Office consider establishing satellite offices in different cities to tap a large resource of talent currently unavailable. Something seems askew when the Office is offered a windfall of new work and tells the customer that it could not manage its affairs (i.e. "cannot hire its way out" of this) and, as a result, restricts the customers' opportunity to give new work to the Office. Hiring and retaining qualified Examiners is imperative to the success of the Office.

Problem: It appears the challenges the Office is currently facing have developed over the years and, at least in part, because of the significant diversion of funds by the Department of Commerce for unrelated projects.

Suggestion: For the Office to be a viable operating entity with the ability for long-term planning, it is imperative for this fee diversion to cease.

Problem: The Office spends a large amount of time examining continuing applications, to the exclusion of examining new applications and, as a result, there is a large backlog of new applications that are not being examined in a timely manner. Under the proposed rules, a second or subsequent continuation or continuation-in-part application and second or subsequent request for examination of an application must include a showing as to why the amendment, argument or evidence presented could not have been previously submitted.

The Office has indicated that about 53,000 requests for continued examination in fiscal year 2005 were received, which accounts for about 30 percent of the Office's examining resources. However, this statistic is silent on the number of those continuing applications that are second or later continuing applications and would be restricted under the proposed changes. Therefore, based upon the statistical information provided by the Office, it is difficult to determine the effectiveness of limiting the filing of a second or later continuation. It seems the number of applications affected by this change may be small. Most of our clients are not willing to put forth the expenses associated with the government fees and the attorney time to file multiple continuations unless their invention is deemed to be very valuable and important. Hence, this filing option should not be restricted.

From our experience, most continuations are filed in the form of RCEs. The time an Examiner takes to evaluate an RCE is in general substantially less than the time required to examine a new application. As a result, it would appear that an RCE not only requires significantly less effort on behalf of the Examiner, but furthermore, provides significant revenue to the Office.

In the instance where a client wishes to file a second or subsequent continuation, as an advocate for our client we would file a petition presenting reasons why such an application

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could not have been presented earlier. As a result, there will be an increase in the petitions filed, and to a degree, work within the Office would merely be shifted to a different group.

Furthermore, there appears to be no statutory support for such a change.

Suggestion: The client is paying a new and substantial filing fee for each continuation. Use this income to address the problem. If the income does not adequately reflect the cost/effort put forth by the Office, revisit the amount of the fee.

Overall, we do not believe a blanket restriction on continuation practice will provide a long-term solution to reducing the pendency and backlog of patent applications before the Office. Hiring and retaining a larger, competent examining corps, establishing satellite locations in cities having a lower cost of living, and if absolutely necessary, consider charging an enhanced fee for second and subsequent continuing applications may be implemented to remedy a problem that has been long in the making.

Respectfully submitted,

/JGP/

James G. Porcelli

JGP:cac