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From: James Yang [mailto:protectmyidea@yahoo.com]
Sent: Friday, April 28, 2006 8:05 PM
To: AB93Comments
Subject: Comments on Proposed Rules published at 71 Fed. Reg. 48 (January 3, 2006)

Dear Under Secretary Dudas:

This communication relates to the proposed rules published at 71 Federal Register 48 (January 3rd, 2006) directed to current continuation practice. I support the Office's effort to provide quality examination and a more expedient examination process. I believe that the patent system is a vital part of the economy of the United States. Great care and thought should be given when proposing broad sweeping changes.

According to the USPTO, the proposed rules are required because there is an enormous backlog of patent applications. These applications are not being examined within the ideal length of time for examination as set by the United States Patent and Trademark Office.

Many reasons exist for the enormous backlog of continuation applications. Some of the reasons are justified whereas others are not. Please be aware that some inventions do require extensive communications (i.e., more than one continuation as of right) with the Examiner to obtain sufficient coverage for exploiting the invention. After all, the patent system is a quid pro quo (i.e., disclosure in exchange for limited monopoly).

Regardless of the reasons for the back log, the results of the proposed rule **merely shift the benefit** of the patent system from one industry to another. From the comments that I've read on the USPTO website, some industries support the proposed rules, whereas, other industries do not support the proposed rules. For example, it appears that companies involved in biotech do not support the proposed rules because delayed prosecution is beneficial to them due to the long period of time it takes to take a product to market. Simply put, biotech companies benefit from the current system. Conversely, it appears that companies involved in software support the proposed rules because quick prosecution is beneficial to them due to the short product cycle of software. Simply put, software companies may benefit from the proposed rules.

Other shifts may also occur. For example, the proposed rules appear to **merely shift the load of the work** from Examiners to the appeals process and the petition process because of the reasonable reaction of patent practitioners to zealously represent their clients and obtain broad patent protection.

I do not suggest adopting the proposed rule changes. Although the presentation slides state that the USPTO cannot hire its way out of the backlong, I believe that the USPTO can to a certain extent. Additionally, to the extent that delayed prosecution is a problem for applicants, they already have a vehicle to speed up the examination process through a petition to make special based on a prior art search. The harm to businesses due to the fear of infringement caused by delayed prosecution is illusory to me at this point because no studies or statistics have been provided to show that a significant amount of people are not engaging or expanding their business due to such fear. I strongly suggest taking a measured approach to reducing the backlog.

I appreciate the opportunity to provide comments on the proposed rules.

Very truly yours,

James Yang