

From: cdmjc [cornishj@erols.com]  
Sent: Wednesday, January 04, 2006 7:42 PM  
To: Comments@uspto.gov  
Cc: AB94Comments  
Subject: Sweeping Changes to Examination Rules

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a. . « PT0 Requests Input on Its Subject Matter Eligibility Guidelines | Main | Supreme Court: LabCorp Briefing Round I [UPDATED] »  
Jan 04, 2006  
Patent Office Proposes Sweeping Changes to Examination Rules (Comments Welcome)  
Buoyed by the evidence presented by professors Mark Lemley and Kimberly Moore, the PT0 has proposed a set of sweeping changes to curb the "problem of continuation practice."

CHANGE IN CONTINUATION PRACTICE: The First proposed rule change would make the following changes:

1. . Any second or subsequent continuation, CIP or RCE must include "a showing to the satisfaction of the Director as to why the amendment, argument, or evidence could not have been submitted prior to the close of prosecution after a single continuation, CIP or RCE"; and

2. . Multiple applications that have the same effective filing date, overlapping disclosure, a common inventor, and a common assignee must include either (i) an explanation to the satisfaction of the Director of how the claims are patentably distinct, or (ii) a terminal disclaimer and explanation to the satisfaction of the Director of why patentably indistinct claims have been filed in multiple applications.

CHANGE IN EXAMINATION OF CLAIMS: The PT0 has proposed that examiners focus their initial examination solely on a set of "representative claims" that are designated by the applicant for initial examination. According to the PT0,

The changes proposed in this notice will allow the Office to do a better, more thorough and reliable examination since the number of claims receiving initial examination will be at a level which can be more effectively and efficiently evaluated by an examiner.

Applicants that do not include designations of representative claims will be delayed.

The PT0 has requested comments that can be e-mailed to AB93Comments@uspto.gov and AB94Comments@uspto.gov for the continuation practice changes and claim examination practice changes respectively by May 3, 2006.

## Comments

Posted by: C.D.M. Judge Cornish | Jan 05, 2006 at 08:22 AM

Patents, trademarks and copyrights are fundamental to the sword and shield of the First Amendment as visualized by the First Amendment, which in 1793 displaced the first patent act of 1790 and its aborted attempt to edit patent applications for "important" inventions. The result under the First Amendment is always a stringent test for what can be suppressed prior to publication by a government editor. Obviously, falsehood and fraud as to the identity of an inventor's claim to be the true, first inventor of the subject matter claimed is frowned on by the Supreme Court. The public policy of the First Amendment is clearly to protect the government's awarding of their imprimatur as to the identity of the true, first inventor. Inventorship not ownership is protected in the U.S. as opposed to what is protected in foreign countries. In the U.S. anything under the sun made by man is available under the sword of the First Amendment for a claim of inventorship and a

government imprimatur to prove it.

Moreover, it is a well established, long standing principle of the law and public policy that the Patent Office is charged with encouraging the use of the Patent Act sword for the freedom of speech by what has turned out to be the largest, most active publisher and publishing system in the world. The administration of the interference proceedings by the patent office is but only one device used by the patent office to help determine the identity of the inventor of a claimed invention. The use of some similar device or procedure, possibly a parallel procedure, would be much better for sorting claims for publication, rather than, and opposed to, the editing system proposed by a Government sponsored editing of First Amendment speech, which is always suspect.

Posted by: judge cornish | Jan 05, 2006 at 09:17 AM cornishj@erols.com; (202) 429-9705; 1101 New Hampshire Ave., NW, Washington, DC 20037;

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Patent Legislation

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