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To: AB93Comments; AB94Comments

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Subject: Kodak Comments to Proposed Rules

Attached you will find Kodak's comments to the recently proposed rules relating to continuations and examination of claims. Kodak has combined its comments so that this is being sent to both e-mail addresses.

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Comments of Eastman Kodak Company Regarding Proposed Changes to Practice for the Examination of Claims in Patent Applications and Proposed Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims

Introduction

Eastman Kodak Company acknowledges there is currently a backlog of unexamined patent applications pending in the U.S. Patent and Trademark Office (“USPTO”), and that changes within the patent examination system need to be made in order to reduce the backlog. Such changes must be made within the confines of the legal authority granted to the USPTO, and without shifting the legal duty of examination of applications from the USPTO to applicants. Eastman Kodak Company provides the following comments regarding the likely effects the proposed rules will have on applicants, the likely effects the proposed rules will have on the public notice function, and suggested changes to the proposed rules. The rules are addressed jointly herein because the full effect of each rule can be understood only when considered in combination with the other proposed rule.

Stated Goals

The USPTO emphasizes compact prosecution and improved public notice as objectives for the proposed rules changes. The objectives further the USPTO goals of increasing examination efficiency, decreasing patent pendency, and improving examination quality, leading to certainty in issued patent claim construction.

There is no indication that the proposed rule changes would actually further the goals of the USPTO. Further, the authority of the USPTO to make many of such proposed changes has been repeatedly questioned in USPTO Town Hall meetings and comments submitted on the proposed changes. While Eastman Kodak Company agrees with many of the submitted comments that promulgation of the proposed rules changes appears to exceed the legal authority of the USPTO, the grounds for such arguments will not be repeated here.

The USPTO alleges that continuing applications and Requests for Continued Examination (RCEs), or “rework,” have presented it with a “crippling” burden. The USPTO states that about 30% of the Patent Office resources are expended on continuing application examinations. However, this calculation appears to assume that there is a one-to-one correspondence between resources spent on examination of a new application

and resources spent on examination of a continuing application. The USPTO has not established that such a one-to-one correspondence exists. For example, continuation-in-part applications are included in the “rework” calculations, without regard for whether wholly new matter added in the filing of the continuing application was claimed (and thus, clearly not “rework”), as opposed to matter set forth but not claimed in the parent application. Contrary to the assertions of the USPTO, it would appear that significantly fewer resources should be spent on examination of any type of continuing application relative to that required for examination of an original application, and also for RCEs relative to that required for other types of continuing applications.

The USPTO has not established that the majority of continuing application examination practice is a “crippling” burden. In fact, the USPTO admits that the proposed rules changes will affect only about 12,000 continuations and about 10,000 RCEs. To the extent the position of the USPTO is based on continuing applications being “counted” as equivalents of original applications for Examiner production/disposal considerations, that is an internal problem of the USPTO, and is not a reason to compromise applicants’ rights by changes to the rules.

Further, rather than reducing the prosecution burden, as will be discussed in more detail below, the combined effect of the proposed rules packages will likely lead to an increase in appeals and petitions in various stages of prosecution. It is unclear how such proposed rules changes can provide any meaningful relief to the USPTO examination burden when the corresponding associated increase in work caused by an increase in petitions and appeals practice is taken into consideration. Such additional petitions and appeals will slow prosecution, increasing pendency rather than shortening it, contrary to the assertions of the USPTO. Efficiency of prosecution will be lost, not gained, by the proposed changes, increasing rather than decreasing pendency of patent applications.

The USPTO alleges that each subsequent continuation provides ‘diminishing returns.’ However, the patent prosecution process is, by nature, an evolutionary process best accelerated by complete Office Actions rather than obligating applicants to conceive of and anticipate all possible rejections an Examiner might make. Many inventions need several iterations between an applicant and an Examiner to reach an understanding of all the issues. The USPTO has not established that the need for several iterations in examination is due, in any meaningful way, primarily to conduct or inaction by applicants. To the contrary, iterations including filing of RCEs and continuations often are due to an Examiner’s refusal to enter an amendment after final that furthers prosecution, reduces issues, and places the application in condition for appeal, or due to an Examiner raising a substantive rejection or new argument for the first time on final rejection. The USPTO has the ability to significantly reduce the number of RCEs and continuing applications by addressing improper after-final examination practices and improving examiner training, and is urged to do so rather than change the current rules to the detriment of applicants.

The proposed rule changes would effectively limit the number of claims applicants can submit for a full search and examination to no more than ten (the remainder not being

searched, and only being examined under 35 U.S.C. §112), would limit continuing applications to one per non-provisional application or divisional, and, where applicant requires more than ten claims examined or a second or further continuing application, shifts the burden of examination squarely onto applicant. The limited examination and the shifting of the examination burden to applicants decrease public certainty in the scope and validity of issued patent claims, actually defeating the public notice function of a patent.

As stated above, the goals set forth by the USPTO of increasing examination efficiency, decreasing patent pendency, improving examination quality, and increasing public certainty in issued patent claim construction are not likely to be met or achieved by the proposed rules changes. Rather, the proposed rules changes are likely to further distance those goals by reducing efficiency of the examination process, increasing pendency, improperly shifting examination burden to applicants, and reducing public certainty in the validity of issued patents, as discussed in further detail below.

Proposed Rules Regarding Continuing Applications

As a justification for the proposed limitations on continuing applications, the USPTO has cited failure of the public notice function in the case of continuing applications because such applications can be filed at any time during the pendency of an application, and because there is no limit to the number of continuations or RCEs that can be filed during the pendency of any one application. The public notice concerns include pendency of “submarine,” or unknown, applications, and uncertainty as to claim scope. These concerns have been addressed by recent changes to the statutes and USPTO practices.

Late filing of continuing applications leading to “submarine patents” was addressed by Congress in 35 U.S.C. §154(a)(2), which, subject to patent term adjustments, limits the term of a patent to twenty years from its earliest claimed priority date. Thus, there is no longer a patent term extension benefit to be gained by applicants in prolonging prosecution through use of continuing applications or RCEs because all applications sharing a priority date will expire twenty years from the priority date, subject to patent term adjustment.

The second concern, uncertainty as to scope, was addressed by statutory changes with respect to publication of applications (*see* 35 U.S.C. §122), and by the implementation of public PAIRS, through which anyone can monitor the correspondence between applicant and the USPTO once an application has published. At this point in time, the number of pending applications that are not subject to the publication requirement is in the minority. Thus, public notice is being served by early publication of applications, and thereafter making prosecution, including currently pending claim scope, transparent to third parties. It is noted that PAIRS further provides identification of all applications within the family of the pending patent application, informing the public and enabling viewing of all related applications.

Because the concerns of public notice have already been addressed by previous statutory changes promulgated by Congress and USPTO practice changes, there is no clear reason for the USPTO to promulgate these rules.

Other stated USPTO concerns include “rework,” that is, handling an application more than once. However, of the types of continuing applications, divisionals clearly are not rework, and it has not been shown that most continuations and continuation-in-part applications claim an identical invention as the parent application. There are, of course, exceptions, but in such cases, the parent application is typically abandoned, and only one application remains pending. RCEs are filed when issues are not resolved sufficiently for appeal, in which cases disagreement still exists between applicant and Examiner, and must be resolved. It has been the experience of Eastman Kodak Company that applications worthy of continuing through filing one or more RCE or continuation application are ultimately granted, indicating all issues were not previously reached. Because applicant is continuing to address issues raised by the Examiner, including issues newly asserted on Final Action, applicant is not creating rework, but continuing the discussion of patentability with the same Examiner, who is already familiar with the case, and need only address new arguments or amendments raised by applicant. An RCE should require less time on the part of the Examiner because the subject matter is familiar and search strategies have already been developed.

Because the proposed rules changes regarding continuing application and RCE practice effectively limit applicants to two cycles of consideration of an application, beyond which the USPTO may arbitrarily reject further continuing requests for examination in the forms of RCE, continuation, or continuation-in-part applications, the proposed continuation rules impose an unreasonable deadline for the prosecution of applications, conflicting with the applicant’s statutory right to file continuations and request reexaminations of claimed subject matter (*see* 35 U.S.C. §132 (a) and (b)). There is no clear guidance within the proposed rules as to what will constitute sufficient grounds for applicants request for a second continuing application or RCE to be granted. Applicants request continuing applications and RCEs for a multitude of reasons, including, for example:

- new rejections by the Examiner on final rejection, presenting issues not previously addressed;
- submission of new evidence not readily available previously;
- further amendment of claims needed after final rejection, making appeal improper;
- Examiner’s refusal to enter minor claim amendments after final rejection, necessitating a continuing application or RCE for consideration of amended claims placing application in condition for allowance;
- discovery of new art after final, of which consideration by Examiner is required;
- correction of critical, non-obvious errors in specification, particularly numerical data, structural data, or drawings; and
- recognition by applicants of critical importance of feature not previously claimed.

It is not certain whether any one of these factors would be considered acceptable by the USPTO in allowing a third cycle of examination in a particular matter.

According to 35 U.S.C. §132(a), the USPTO must provide the applicant with an Office Action setting forth the reasons of unpatentability, and the USPTO has the burden of establishing a prima facie case of unpatentability if it is going to deny a patent grant. On receipt of any Office Action, applicant may choose to respond to the points set forth in the Office Action, thus continuing prosecution. As indicated above, applicants are often forced to file RCE applications to address new issues raised by Examiners in final Office Actions, or to enter minor amendments refused by Examiners even when the amendments meet the requirements for entry after final rejection. The patent prosecution process is, by nature, an evolutionary process. According to the proposed rules, to justify a continuing application or RCE, an applicant must show that the amendment, argument, or evidence being submitted in the continuing application or RCE could not have been submitted prior to close of prosecution in the parent case. The applicant currently is not and should not be obligated to predict all possible rejections that an Examiner could or might make beyond those identified in the Office Action. If this were the case, Patent Examiners would have a disincentive to provide thorough examinations in the expectation that the applicant has the burden to come up with all possible rejections over cited prior art. This is a clear shift of the examination burden to applicant.

The most efficient form of examination process would be for Patent Examiners to provide complete Office Actions, thereby obligating the applicant to provide a detailed response addressing all issues. A complete Office Action should not only include a search based upon all claims presented, but also, as currently required but not always practiced, a search based upon all material in the specification that might reasonably be incorporated into the claims by Applicant in order to anticipate likely claim amendments by the applicant and further expedite prosecution. Removing the ability of an Examiner to raise a new rejection in a final Office Action would expedite prosecution and reduce rework by providing an incentive for the Examiner to reach issues early in prosecution.

As indicated herein, the USPTO has not provided conclusive evidence why the proposed changes to continuation practice are needed in view of already existing laws to satisfy public notice function; shown the burden to Examiners in “rework” as broadly classified by the USPTO is caused unduly by applicants as opposed to the actions of the Examiners themselves, particularly after final practice; or provided satisfactory guidelines in the requirements of the proposed rules for requesting continuing applications or RCEs, particularly where the proposed claims practice rules changes shift the examination burden to applicants (addressed below).

Most of the applications characterized by the USPTO as rework are applications to a new invention not previously considered by the USPTO, and therefore should not be classified as rework. To the extent such applications are closely related to parent applications, the same Examiner should be assigned, reducing work time because of familiarity with the specification and having already developed search strategies, which in many cases would merely need to be modified. Further, change of final Office Action and after final

practice to provide for final Office Action only in the case of maintaining the same rejection, and enforcing Applicants rights to have minor claim amendments that place the application in condition for allowance or in better condition for appeal entered after a final Office Action, would reduce rework as classified by the USPTO.

Because the proposed rules changes fail to further the stated goals of the USPTO, and in fact would increase Examiner workload, lengthen pendency, and shift the examination burden to applicants, the proposed rules changes should not be enacted.

Proposed Rules Regarding Disallowing Applications with Similar Disclosures

Prosecution of applications having similar disclosures, whether or not they have overlapping claimed subject matter, presents separate and distinct issues from continuing applications practice, with different effects on applicants' rights. The proposed rules changes on these issues should not be combined into a single rules package as done by the USPTO, but should be treated separately.

The Patent Office has not provided any evidence that multiple applications with similar disclosures present any meaningful burden to current examining procedures, or that disallowing them would improve patent quality or increase public notice.

Overlapping subject matter in an application specification occurs for a multitude of reasons, and is no indication of overlapping claim scope. Often, the similarity in specifications is due to the application subject matter being in the same art, wherein much of the materials or methods needed to enable the description of the invention are the same. An example would be ink jet printer applications, wherein one application is directed to a nozzle assembly, and the second application is directed to the means for moving media through the printer. A basic description of the printer and all of its parts is necessary to enable both applications. It is uncertain if such applications would trigger the proposed rules for having sufficiently "similar" disclosures.

The current rules provide means to address applications with claims to overlapping subject matter wherein at least one inventor is in common and assignment is to the same assignee. The applicant can argue the differences in claim scope, or submit a terminal disclaimer.

The proposed rules shift the burden of examining the claimed subject matter to applicants, and require justification on the record of why two similar disclosures have been filed, despite filing a terminal disclaimer, or explaining how the claims are patentably distinct. Because distinguishing the claims and filing a terminal disclaimer are means of overcoming double patenting rejections currently, it is uncertain how the USPTO believes basing such a rejection on the specification, rather than the claims, will reduce Examiner workload, decrease pendency, or increase patent quality or public notice. It is also uncertain whether the USPTO will remove current double patenting rejections in view of the proposed rules changes which would enable the USPTO to make functionally a double patenting rejection based on the specification without regard for the

claimed subject matter, even though such a rejection effects the claim scope and term of any resulting patents.

The USPTO has failed to establish how similar application disclosures indicate overlapping claimed subject matter. It would seem simpler to compare the claimed subject matter, as is done under the current rules, where the claims are typically a few pages in length, than to compare application specifications, typically 20 or more pages in length. The proposed rules changes increase Examiner workload.

Further, the proposed rules changes shift the burden of comparing the claimed subject matter to applicant, based merely on similar disclosures. If applicant chooses to argue the claim scopes are different, applicant is creating prosecution history estoppel and a record of claim interpretation that can later be used in litigation against applicant. If applicant files a terminal disclaimer, surrendering patent term length, applicant is still necessitated to disclose why two similar specifications were filed. Thus, applicant must again create prosecution history estoppel. Further, the USPTO will be obligated to read and pass judgment on every explanatory submission made with a terminal disclaimer, again lengthening pendency and increasing USPTO workload.

This proposed rule change will increase petition practice significantly, with applicants arguing that the specifications are “dissimilar” and no rejection should have been made. Such an increase in petitions practice will lengthen the pendency of applications, and increase Examiner workload, contrary to the goals of the USPTO.

For all of the above reasons, Eastman Kodak Company strongly urges the USPTO to remove at least this portion of the proposed rules changes. Current double patenting rejection practice achieves the same result with less time and effort by Examiners and applicants, streamlining prosecution. The proposed rules changes only burden this process, hampering prosecution.

Proposed Rules Regarding Claims Practice

With regard to the proposed changes to claims practice, the USPTO has stated that “[t]he changes proposed 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 examination.” By stating that applications will receive a “more thorough and reliable examination” and be “more effectively evaluated,” it is presumed the USPTO means that more time will be spent examining each claim. However, the USPTO has not established that this is the case. On the contrary, the USPTO has proposed to POPA, the Examiner’s union, that once the proposed rules are enacted, the amount of time to examine a case will be reduced, thus effectively maintaining or reducing the amount of time per claim an Examiner can spend. Accordingly, the Patent Office has not established that the rule changes will result in a more thorough, reliable, effective, or speedy examination.

The USPTO has indicated quality of examination will stay the same or improve under the proposed rules changes. However, under the proposed rules changes, dependent claims

will only be examined for compliance with 35 U.S.C. §112, and no substantive search and examination will be done. This will introduce uncertainty as to the novelty and non-obviousness of such claims, reducing public confidence in the quality of granted patents. Further, because dependent claims can be important in litigation, reissue, and reexamination proceedings, costs of such proceedings will rise due to the uncertainty of the patentability of the dependent claims, which will need to be examined for the first time in such proceedings. The proposed rules changes to examine only elected claims can only harm the public notice function, and reduce confidence in the quality of granted patents.

The USPTO cites the Board of Patent Appeals and Interference practice model of designating certain claims for consideration and argument as its model for the proposed claims practice rules changes. However, the comparison is inappropriate. The Board considers issues only after they have been clearly defined through prosecution, which is not the case when filing an application. At filing, the applicant is not aware of all issues that may arise in prosecution. Further, on appeal before the Board, an applicant can choose to group claims in any way suitable to an argument, and may choose to argue all claims independently. The USPTO realistically is offering no such choice in the proposed rules because no applicant is likely to file an examination support document in view of current case law. Thus, the USPTO is using an inappropriate and unrealistic model for its proposed method of claims examination, with no benefit accruing to applicant.

It is argued by the USPTO that the proposed rules will reduce Examiner workload by enabling the Examiner to search and examine at most ten claims. However, should applicant later introduce new features from the specification or a dependent claim not searched by the Examiner initially into the examined claims, the Examiner will need to construct a new search strategy and search the revised claims. This is inefficient as compared to the present system, wherein the Examiner is obligated to search each and every claim submitted, and all material set forth in the specification that may reasonably be claimed. The proposed rules ask the Examiner to search multiple times at different stages of prosecution, where the time needed for each search will delay prosecution. Further, because new issues and rejections will be continuously set forth by the Examiner after each new search, prosecution will again be delayed.

Applicant currently pays a basic filing fee that is designed to cover the costs of searching up to three independent claims and any number of dependent claims up to a total number of twenty claims. For each additional independent or dependent claim, and for every multiple dependent claim, applicant pays a fee presumably designed to reflect the cost of search and examination of that additional claim. The latest changes to claim fees are a deterrent to filing more claims than believed to be necessary for an applicant to adequately cover his invention. The USPTO has not given the fee changes adequate time to determine their effect on the number of claims filed. The USPTO also has not explained their authority to reduce examination from all claims submitted to a select number of claims, when applicant clearly pays for all submitted claims to be searched and examined. If the number of claims examined will be reduced by implementation of

the proposed rules, the claim fees should likewise be reduced. Preferably, to the extent the current fee schedule is found to not adequately reflect the incremental costs actually incurred by the Office for examining claims filed beyond the number covered by the basic filing fee, or for examining the number of claims covered by the basic filing fee, this should be addressed through further fee changes.

The proposed rules changes require that, on indication of more than ten claims for examination, applicant must submit an examination support document requiring a search of every claim separately, features that may be claimed, and a statement of the differences of all art found over each and every claim. This clearly shifts the burden of examination to the applicant, and provides no incentive for the Examiner to thoroughly search and examine each and every claim. Under current case law, it is likely no applicant will submit such a document because of the prosecution history estoppel created, and the potential for accusations of unethical behavior or fraud on the USPTO should applicant fail to find or report a reference that later in prosecution or litigation is found to be relevant. Effectively, the proposed rules changes bars any election of more than ten claims by applicant. Even should an applicant choose to submit an examination support document, which is unlikely, the quality and consistency of such documents will vary greatly, even among those submitted by a single applicant, based on the search queries used and the individual attorney determination of relevant references. The proposed rules further have uncertainties with regard to what databases applicant must search. For small entities, the costs of a search equivalent to that purportedly done by the USPTO, including all US and foreign patents, as well as literature and sales documentation to the extent searchable, is prohibitive. This acts as a bar on innovation. Thus, the proposed requirement of an examination search document switches the examination burden to applicant, is cost prohibitive for many inventors, and will create prosecution history estoppel and fodder for litigation, increasing applicants' costs of both patent procurement and enforcement.

Submission of an examination support document is also in conflict with patent examination harmonization goals. Only a few countries require applicant to submit known art to the national patent office. The proposed rules changes impose a duty on all applicants who would obtain a patent in the United States. This is an unfair shift of burden to applicants, and is inconsistent with the move to global harmonization of patent systems.

In toto, the proposed changes to claims practice are a drastic shift in USPTO policy, which shift Eastman Kodak Company does not believe is supported by existing law. The proposed changes significantly shift the examination burden to applicants where more than ten claims are to be examined. If no more than ten claims are elected for examination, the proposed rules introduce uncertainty as to the validity of the remaining claims, failing the public notice function of a patent. The only option applicant has is to restrict submitted claims to ten or less so all claims must be examined, in contravention to the basic filing fees that purportedly pay for the costs of searching up to three independent and at least seventeen additional dependent claims, up to a total of twenty claims. The shift in examination burden to applicant, and the alternate restriction of

applicants' ability to fully claim all to which applicant is entitled, is not legal, and the proposed rules should not be enacted.

Retroactivity of Proposed Rules Changes

It is indicated that both of the proposed rule changes will be enforced retroactively on all pending applications. This is an unfair practice, and unduly harms applicants' rights.

Retroactively enforcing the continuation practice proposed changes will jeopardize applications currently pending because applicant may no longer be able to take further action in the form of a continuation, continuation-in-part, or RCE application, which under current practice is not limited. This is a dramatic shift in prosecution strategy, and without a concurrent drastic shift in examination practice, will unfairly cause loss of applicants' patent rights. No pending applications should be subject to the proposed changes in continuation practice.

Retroactively enforcing the claims practice proposed changes will disadvantage pending applications with more than ten claims. According to the USPTO presentation at the October 2005 AIPLA meeting in Washington, D.C., only 20% of all applications have ten or fewer claims, while more than 50% of applications filed have no more than 20 total claims. Retroactive implementation of the proposed claims practice rules would effect 80% of all pending applications, creating more work for the USPTO in reviewing and sending notices of need to elect claims for examination in the majority of pending applications, and further lengthening pendency. Further, it has not been indicated how applications having already received a restriction requirement or substantive examination will be handled. Applicants will be forced to elect claims for examination in cases where it was expected that all claims would receive a full examination by the USPTO. The USPTO has not indicated examination and search fees will be refunded to such applications, or that fees will be reduced commensurate with the reduced search and examination.

Overall, implementation of either rules package retroactively creates more administrative work for the USPTO, and disadvantages applicants by hindering or removing their rights to full examination of all claims presented for so long as applicant wishes to pursue a claimed invention. If implemented, the rules should be applied only prospectively on newly filed patents, providing sufficient time for applicants to amend claim sets in application drafts not yet filed.

Conclusion

Eastman Kodak Company does not support promulgation of the current proposed rules packages because they do not meet the stated goals of the USPTO of increasing examination efficiency, decreasing patent pendency, improving examination quality, and increasing certainty in issued patent claim construction. The proposed changes will create more work for both USPTO staff and applicants, create inefficiencies and uncertainties in the examination process, increase pendency, and result in uncertainty as to the validity of all claims in issued patents. Many of proposed changes are addressed at issues already sufficiently covered by current practices, such as automatic publication of

applications, institution of public PAIRS, double patenting rejection practice, and fee separation and increases. The number of applications effected by the change to claims examination practice will be 80% according to the USPTO statistics, which is hardly insignificant. Given the above reasons, the proposed rules need to be redrafted to address applicants' concerns, and/or dismissed until such time as the USPTO evaluates the effect the latest changes in fees and efforts at improving Examiner hiring and training have on application pendency. Should the USPTO choose to redraft the proposed rules in view of comments received, we ask that substantive changes from the current proposed rules again be given a public comment period, such that the public can evaluate the proposed substantive changes and provide adequate feedback to the USPTO before any final rules are promulgated.

For those rules not specifically addressed by the above comments, Eastman Kodak Company offers the following rule-by-rule commentary.

Continuing Applications Proposed Rules Changes

1.78(d)(3) Other than a continuing patent application under 37 CFR 1.53(d), a non-provisional application or international application claiming benefit of one or more prior copending application must contain or be amended to contain reference to the application(s) and identify the relationship. If the continuing application is a continuation-in-part, applicant *must* identify which claims(s) are disclosed under 35 USC 112, first paragraph, in the prior application.

While this is something within applicants' knowledge, the requirement is troublesome. The applicant is performing the analysis of meeting the 35 USC 112, first paragraph, requirement for the USPTO, without indication of whether the USPTO will rely on this information, or if the USPTO will confirm applicants statements. Further, the result of a misstatement or mistake on the part of applicant in prosecution, and after issuance of the patent in litigation, is unclear. As an alternative that still satisfies the goals of identifying which claimed subject matter is supported by new matter added in the continuation-in-part, and thus not entitled to the priority date of the parent application, it is recommended instead that, upon determination of an intervening reference, the USPTO request applicant to identify the new subject matter in the application, perhaps by submitting marked pages, thus simplifying the Examiner's job of verifying whether support for each claim under 35 USC 112, first paragraph, exists in the continuation-in-part specification alone, or also in the parent specification.

1.78(f)(1) If a non-provisional application is filed on the same date or within two months of the filing date of a pending or patented non-provisional application, and the applications have at least one inventor in common and are owned by or subject to assignment to the same person, applicant must identify each other application by serial or patent number within four months of the filing date.

It is unclear whether the two-month period is retrospective, prospective, or both. As written, Eastman Kodak Company interprets this to mean that, on filing an application, any other application filed within two months before or after the date of the

application meeting the specifications of the rule must be identified to the USPTO. Clarity is requested.

This rule, regardless of interpretation of the time frame, is ripe for accidental oversight by applicant. Corporations frequently employ internal as well as outside counsel, and the responsible attorney may not be aware of all other applications being filed by each and every inventor of a particular application, especially when multiple outside counsel firms are retained, as is common practice for corporations.

To the extent it has any possible merit, the requirement is duplicative of the existing requirement to disclose relevant, related applications. Further, the proposed rule, as worded, would require all applications, including those completely unrelated to the claimed subject matter, to be disclosed to the USPTO. This will burden the Examiner with having to review numerous *unrelated* applications to check for double patenting, slowing the Examiner's review of the case, and adding to the Examiner's workload, which is counter to the goals of compact and speedy prosecution.

This is an added, unnecessary burden to both the applicant and the Examiner. The Examiner can, and currently does, search for related applications in the appropriate class and subclass(es) when reviewing an application. This appears to still be the most efficient method of identifying possible double patenting situations, as a check on applicants' already existent duty to disclose such related applications. It also appears the Examiner could just as efficiently perform an inventor name search to identify all applications filed within two months if the USPTO really wants to review all such applications regardless of relevancy.

Further, disclosing all such other applications places the listing of other applications on the public record, and makes all such other applications available for inspection by the public once the initial application is published. This defeats applicant's ability to prevent publication of one of the other applications by expressly abandoning it before its publication date.

1.78(g) If applications or patents under reexamination are owned by the same party, name different inventors, and contain patentably indistinct claims, and there is no statement on the record that they were subject to assignment to or commonly owned by the same entity at the time of the later invention, the USPTO can require the assignee/owner to state whether the applications were commonly owned/subject to assignment at the time the later invention was made and, if so, can require the owner to indicate which inventor is the prior inventor.

To accommodate any obviousness-type double patenting issues, a terminal disclaimer should continue to be allowed. It is noted that this situation can occur for various reasons, including acquisition of one company by another company, wherein both companies are pursuing the same field of research.

1.78(h) If the application discloses or is amended to disclose parties to a joint research agreement, e.g., under 35 USC 103(c)(2)(C), the joint research parties are considered to be the same person for purposes of this section and must identify all non-provisional applications pursuant to section (f)(1) of this rule unless identification is or has already been submitted within the 4 month period of (f)(1).

This proposal presents all of the concerns as set forth for section (f)(1). This places an undue burden on applicant to identify all applications by all parties to the joint research agreement. Additionally, there is a confidentiality issue for parties to the joint research agreement. By requiring disclosure of all applications with overlapping inventorship, regardless of relevance, potentially non-related filings will be disclosed. Because many of these filings will be unrelated to the joint research agreement, the USPTO is forcing disclosure of confidential information to a third party (other members of the joint research agreement) before such information is otherwise publicly available. The current practice of having the Examiner issue a double patenting rejection, should ownership appear to be the same, or issuing an appropriate rejection under 35 U.S.C. §102 or §103, better meets the goals of applicant confidentiality before publication.

Claims Practice Proposed Rules Changes

1.75(b)(2) - Under this section, a claim referring to another claim but not incorporating all features of the first claim will be considered to be an independent claim for fee and count purposes, and any claim referring to another claim of a different statutory class will be considered independent for fee and count purposes.

Reclassification of claims as independent will increase the cost associated with filing an application and create situations where designated claims exceed ten and trigger the requirement of providing an examination support document without applicant being provided with the opportunity to respond to the reclassification of the claims. Also, the USPTO will need to classify the claims of the application multiple times, initially to determine class and subclass, then a second time to determine which claims should be considered independent. This introduces opportunities for applicants to petition the reclassification of the claim as independent. Overall, the proposed rules changes will create inefficiencies, more work for the USPTO, and lengthen pendency.

1.75(b)(3) - Under this section, applicant will be notified of the need to comply with designation of claims for examination or submission of an examination support document, and has a one month non-extendable period without cause in which to respond.

In the event this rule is adopted in its present form, guidance must be given as to what type of cause is to be considered adequate for requesting an extension of time. A one month nonextendable time period represents a significant change in USPTO policy as currently applied in closely analogous situations. For example, the time period to reply to a restriction requirement is one month but is extendable. The time period to pay an issue fee is nonextendable but applicant is given three months to reply. It should be noted that the work associated with preparation of an examination support document greatly exceeds the work associated with paying an issue fee.

Because the filing of an examination support document is very burdensome to applicant, the time period for reply when applicants elect to file an examination support document should be set at three months and should be extendable. Alternatively, applicant could be given a one month time period to reply whether electing claims, including the election, or stating applicant will submit an examination support document. If electing the latter, applicant can automatically receive two months from the date of

applicant's reply, extendable to five months total, to file an examination support document.

1.75(c) - This section addresses multiple dependent claims.

The last sentence of Section 1.75(c) reads: "A multiple dependent claim shall be construed to incorporate by reference all of the limitations of each of the particular claims in relation to which it is being considered." In its present form, this sentence could be interpreted to mean that the features of all claims referenced in the multiple dependent claim will be included in the multiple dependent claim for examination purposes as compared to considering the features of each claim referenced in the multiple dependent claim in the alternative for examination purposes. Clarity is required should this change be enacted.

1.261(a)(6)(c) - This section provides one month to file a corrected or supplemental support document, which period is nonextendable.

This may not provide applicants sufficient time to comply, depending on the insufficiencies cited by the Examiner. The insufficiencies will need to be cited with specificity by the Examiner. Because applicants do not wish to lose patent term adjustment during prosecution by their actions, there is no incentive for applicants to needlessly delay prosecution. This response period should be lengthened, and made extendable.

The above comments are submitted for consideration by the USPTO regarding the proposed rules changes. Eastman Kodak Company asks that the USPTO carefully consider the comments when deciding whether to enact the proposed rules, and, if the proposed rules are to be enacted, in making any amendments thereto. It is respectfully requested that any substantive changes to the proposed rules be given a public comment period in order for the public to address any concerns raised by such changes before enactment.

Respectfully submitted,



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