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From: Miller, Robert A. [mailto:rmiller@oliff.com]

Sent: Wednesday, May 03, 2006 1:33 PM

To: AB93Comments; AB94Comments

Subject: Submission of Comments

Sir or Madam:

The attached comments are being submitted to both addresses as I believe there is an inter-relationship between the proposed rules that can not be addressed if the comments are separated.

Respectfully submitted,

Robert A. Miller

Reg. No. 32,771

3146 Ironhorse Drive
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May 3, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
ATTN: AB93 Comment@USPTO.gov and
AB94 Comment@USPTO.gov

RE: Comments Relating to Proposed Rules Docket Numbers:
2005-P-066 and 2005-P-067

Sir:

Please consider the following comments relating to the January 3, 2006 Proposed Rules entitled "Changes to Practice for Continuing Applications, Requests for Continued Examination, and Applications Containing Patentability Indistinct Claims "and" Changes to Practice for the Examination of Claims and Patent Applications." Subsequent comments will address various issues related to the individual rule changes. However, before doing so, one must consider their interrelationships.

I. Purpose of the Patent System.

A. The Creation:

The Patent System is a result of Article I, Section 8, CL8, which states that Congress shall have the power... "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." From that, the U.S. Patent and Trademark Office was created. Under 35 U.S.C.

§2, the U.S. Patent and Trademark Office (hereinafter "Patent Office"), subject to the policy direction of the Secretary of Commerce, is responsible for granting and issuing patents.

B. Shared Burden:

Nowhere is there anything that states that examination is a shared "burden" with Applicants to examine applications for patents. There is, for Applicants, a duty of honesty and candor in practice before the Patent Office. There is also a duty to disclose information a reasonable Examiner would find material to examination. However, the duty, or "burden", of examination is the Patent Office's alone.

The system was designed such that if one created something new and useful that would benefit the citizens of the United States, one would be able to capitalize on one's industriousness for a limited period of time without competition, and such would not be a restraint on trade. The current rules appear to both abrogate that protection and create a situation where the Applicant is required to (1) limit his invention, either in the form of potential continuation or divisional applications, or continued prosecution to obtain protection; or (2) in how the claims and number of claims can be presented. All of this is being done in the name of "expediting examination."

Although all would desire examination to go more rapidly than it does today, that does not shift the governmental burden onto the Applicants. The goal of the patent system never was to expedite examination, rather it was to permit inventors to enjoy the fruits of their labors.

C. Related Rules:

Further, these rules appear to ignore a proposed change in the law wherein the United States goes to first to file, rather than first to invent. Although first to file will follow what the rest of the world does, as practically all Applicants, practitioners, and potential infringers know, a first to file application is drawn to a very broadly conceptualized invention. The actual fruits of labor result after an attempt to actually develop the invention, which entails engineering, cost and facility considerations, and many other practical aspects that actually define the invention as a product or method in the commercial environment. It is this product that is the fruit of the inventor's labor and that which inventor's, or their assignee's, are attempting to protect in the spirit of the U.S. Constitution and the law establishing the Patent Office. This may entail continuation applications, continuation-in-part applications, and other actions on the part of Applicants to properly protect that which goes to market, regardless of the burden that may place upon the U.S. government and its agency, the Patent Office, to comply with the U.S. Constitution and statutes. If these rules are adopted, and if the Congress passes a first to file law, the U.S. patent system, given court interpretation of patent documents, will produce a sham system that provides little to no protection for inventors and totally abrogates the provision of the U.S. Constitution.

II. General Comments.

I will not address the specific wording of the proposed rules, as their premises are faulty. The premises are: 1) expedited examination is more important than protection of inventors'

rights, and 2) there is a shared burden of examination. The law says that neither of these premises is correct.

Further, the proposed rules are based on a number of unsupported assumptions. For the most part, it is the premises and assumptions that will be addressed as well as the limited data used to support both.

III. Changes to Practice for Continuing Applications.

A. New and Old Applications:

The discussion of the proposed rules indicates that there is a difference between a "new" application and a continuation application. Continuation for purposes of this discussion includes divisionals and continuation-in-part applications. Nothing could be further from the truth. All are new applications. All have the mandatory fees required for examination paid. All are being submitted to protect an invention.

The reasons why they may be submitted vary, as they may result from a requirement of the Office, they may result because the Applicant needs to enforce something to protect his rights, and thus chooses to pursue broader protection in a subsequent application while immediately enforcing more limited rights; they may result because ongoing evolution of the invention has led to modifications that require additional disclosure, and numerous other reasons. In all cases, they are "new" inventions. They either have never been examined by the Patent Office, or there is a disagreement between the Patent Office and the Applicant as to novelty or obviousness, which still needs resolution. The current rules provide for such by continuing practice and by appeal.

The Patent Office Summary argues that subsequent applications result in diminishing returns. For who? The purpose of patents is to protect inventions, not to facilitate actions of the Patent Office. If there are any diminishing returns, that actually is a benefit in that an Examiner looking at a divisional or continuation where he/she has examined the parent, should be able to examine that "new" application much more quickly, thereby leading to efficiencies. If there are abuses to the system, and there have been several that have made it into the news, the courts are there to address that issue. It is not the purpose of the Patent Office to say an inventor cannot continue to develop, refine, or improve his invention or inventions. The sole purpose of the Patent Office is to determine whether, in fact, the invention as presented in the application is patentable.

Further, the comment that Applicant should not rely on an unlimited number of continued examination filings to correct deficiencies in the claims begs the issue. Although Applicant may well believe the claims he/she has filed, prosecuted, and had issued as a patent do describe their invention, potential infringers do attempt design arounds. Thus, so long as an Applicant has an application pending and wishes to claim other aspects of his or her invention that may well encompass those design arounds, and are the only way to protect the invention in court, Applicant should have that right. The Constitution indicates such. Easing the burden on the Patent Office should not abrogate the constitutional obligation of the government.

B. Purpose of Patent Office:

There is an expression used in cases like this, it is known as "the tail wagging the dog." In this case the tail is "expedited examination" and the dog is Applicant's constitutional

right to enjoy the fruits of his/her discovery. The Patent Office's comments appear to acknowledge Applicant's needs, but minimize them by saying that they are improper grounds for continuing application practice.

In response to the comment that adding claims to protect inventions is not calculated to advance prosecution before the Patent Office, the issue is not prosecution before the Patent Office, the issue is protection of the invention for the benefit of the inventor.

C. Patentably Indistinct Claims:

The summary also addresses other issues, such as patentably indistinct claims. A patentably indistinct claim by very definition is a subjective judgment. How many times is such an allegation by the Patent Office successfully rebutted? In those cases where a Terminal Disclaimer is filed, what is the reason? A Terminal Disclaimer admits nothing and may well be purely a choice of allocating resources.

D. Continuing Applications:

With respect to the comment that 30% of cases being examined are in some form a continuing application, the question becomes - so what? A fee has been paid to obtain that examination. If the Patent Office is incapable of obtaining the necessary personnel to examine applications, then it must address that issue with the Congress of the United States to adjust the salary structure or must make determinations within its organization as to the qualifications required for Examiners. Further, one method of simplifying and reducing the number of continuing applications would be to eliminate restriction practice or adopt a more broad based determination without using a very arbitrary classification/subclassification determination of

separate inventions. The almost automatic restriction practice dealing with apparatus and method claims, if eliminated, should reduce the number of continuing applications and would appear to be reasonably logical, as very few applications that comply with the law do not include both a description of an apparatus and at least a method of use and most times, a method of assembly. Thus, searching for any one of the alleged inventions would appear to encompass a search of the others.

E. Requests for Continued Examination:

With respect to Requests for Continued Examination, the Patent Office should look to the practice of its Examiners. Generally speaking, Applicants get one examination. That is, Applicants file an application and it is examined. An Office Action is issued. If Applicant amends, any subsequent Office Action is normally a final Office Action. A response to a final Office Action is not considered if it requires further consideration or an updated search. Thus, Applicant's only recourse is to file a Request for Continued Examination, or a continuing application, upon receipt of the almost automatic Advisory Action. It is most likely that this practice evolved as it did to ensure that the Patent Office receives sufficient funds to maintain the ongoing examination. Such may be appropriate.

However, when an inadequate search is initially conducted, which occurs on many occasions, the Applicant is punished as being unable to act on the second search that led to the final Office Action without following continuation practice. In many cases this can involve four, five, and even more actions by relatively inexperienced Examiners.

F. Summary:

The assumption of all of the remarks found in the Patent Office's comments accompanying the proposed rules concerning continuing application practice is that the Patent Office is efficient and no human endeavor is that efficient.

Lastly, the second rule being proposed limiting the number of claims under examination will force Applicants to file multiple applications for what Applicant anticipates the Patent Office will consider differing inventions or variations on the invention, to completely obtain the fruits of his/her discovery.

IV. Changes to Practice for the Examination of Claims.

A. Examining of Claims:

Firstly, as noted above, this flies in the face of the attempts to put limitations on continuation practice. It effectively produces a limit of ten claims in an application. The indication that the additional claims will be examined upon allowance of the originally selected ten claims has little meaning. Unless there is a large number of independent claims, far more than is common in my 18+ years of experience, the only claims that would not be initially examined are the dependent claims in excess of the ten claims. Thus, upon allowance of all the elected claims, including the independent claims, there would be no motivation or incentive for any Examiner to expend more than two minutes filling out the allowance form on the remaining dependent claims. As a result, the presumption of validity found in 35 U.S.C. §282, at least with respect to any claim that was not originally identified for examination, could be undermined.

Again, a rule is being promulgated for the benefit of the Patent Office, and not for the inventor, who is supposed to receive protection for his/her discovery.

B. Beyond Patent Office:

Further, the requirement for self examination is not only erroneous, but the requirements go beyond those exercised by the Patent Office itself. If the Applicant desires to pursue more than ten claims, then the Applicant must provide, under the proposed rule, a detailed analysis of each claim and where it is supported within the specification; a detailed search report that includes the field of search by class and subclass, the date of search and the data bases searched; an Information Disclosure Statement, citing the references most closely related to each of the independent and designated dependent claims; and identification of all limitations in the independent claims and designated dependent claims that are disclosed by the references, along with a detailed discussion of how the claims are patentable over the references. This search of references is to include all U.S. patents, patent application publications, foreign patent documents, and non-patent literature. To conduct the analysis required would require translation of any foreign document that was not in the native language of Applicant. The Patent Office itself does not do such with foreign documents. How can the Patent Office demand that Applicant do more than the Patent Office itself does? In a rejection, the Patent Office does not comply literally, with most, if not all, of the requirements it is now proposing to place on Applicants.

C. Equating the Petition to Make Special:

This requirement has been equated to a Petition to Make Special an application for examination. Normally, the reasons for making an application special are different than for ordinary examination. In particular, to make special, it may be important to an inventor, or an assignee, to obtain a patent to stop a potential infringement, it may be because of the great cost or time involved in commencing manufacture, or it may be to attempt to close the market to competitors who have not gone to the expense of attempting to develop their own inventions. In such a case however, under the current continuation practice rules, the inventors would also be able to subsequently pursue additional patentable subject matter to protect against design arounds that any of those competitors might attempt to develop, so long as the subject matter of the claims was properly disclosed and enabled by the original disclosure. These rules, in combination, effectively close off or make extremely difficult, that protection to the inventors. Thus, the justification fallaciously equates a Petition to make Special with ordinary examination.

The Office also attempts to justify, or rationalize, its actions by stating that such an analysis for a Petition to Make Special only has a cost of approximately \$2,500 for a patentability search. Without defining what that patentability search encompassed, this statement has no merit. Many patentability searches and opinions are based only upon U.S. Patent documents. Where foreign documents are searched, many opinions are limited to what can be readily ascertained from the drawings and possibly an English Abstract. They are not considered by either practitioners or recipients to be all encompassing and a guarantee of patentability. They are intended to assess the probability of success for investment of capital. I

am not aware of any searches performed for the stated cost that would satisfy all of the requirements being placed on Applicants by the proposed rules.

Further, the document being demanded by the Patent Office in this rule opens both Applicant and practitioner to charges of fraud on the Patent Office if material or relevant art for some reason is overlooked, or if Applicants' and/or practitioners' evaluation of identified art differs from that of another observer.

D. Conflict of Interest:

To require Applicant to examine his/her own application creates a conflict of interest. As such, no one would consider any statement made by Applicant to be without question, and without at least a whiff of potential concealment or understatement. It is against Applicant's own interest to perform such a detailed analysis, and could almost be considered, at least in concept, a violation of the spirit of Amendment V of the U.S. Constitution, which in criminal cases, bars being a witness against yourself. It makes the Applicant take a detailed position far more adverse to him/herself than is required by current disclosure or even reexamination rules. The Patent Office was created to implement the government's duty of evaluating Applicant's invention and secure to the inventor the exclusive right to his/her discovery, not require Applicant to take a position adverse to his/her application. Examining the application for sufficiency is the Patent Office's job as an independent party.

E. Retroactivity:

Lastly, to make a rule change such as this retroactive, further means that the Patent Office believes that Applicants and their representatives should be able to predict the

future and write applications with the future in mind. When rules are changed in such a draconian manner, those subject to the rules must be permitted to react to them. It is impossible to react retroactively to such a rule change. Thus, any implementation of any such rules should only be done at least six months and probably a year from the date of announcement of the final rules.

V. Related Issues.

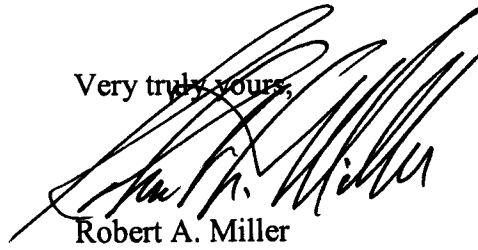
It would appear that the ultimate goal of the Patent Office is to consolidate all invention in corporations, and eliminate the independent inventor. To allege that these changes result in little cost or no cost to Applicants because no government fees are associated with many of these actions, ignores the fact that few independent inventors have the wherewithal to do the required tasks. Thus, they must hire professionals. That is costly. It is already very expensive to obtain a U.S. patent. For an independent inventor who normally cannot in fact produce and market his invention, to add the cost burden of these unnecessary new rules is to further drive the independent inventor out of the equation. Doing so will do great damage to the country as many of the United States' corporations, past and present, and their products started with an invention of an independent inventor.

VI. Conclusions.

A. The proposed rules ignore the government's constitutional mandate and are based on a concept of "shared burden" that was never envisioned by either the founding fathers or the U.S. Congress.

B. The rules as they currently exist adequately address the alleged problems. The fault, as a result of the rapidly increasing rate of technological change, appears to be an inadequacy in current examination procedures, either in numbers and/or qualifications of Examiners or in internal practices governing examination, or a combination.

Very truly yours,

A handwritten signature in black ink, appearing to read "Robert A. Miller", written over the typed name below.

Robert A. Miller
Reg. No. 32,771