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From: Guy Cumberbatch [mailto:guy@patent4you.com]

Sent: Wednesday, May 03, 2006 7:04 PM

To: AB93Comments

Subject: Proposed Rule changes re: Continuations and Claims

CORRECTION - please replace the earlier-sent email with this one.

Mail Stop Comments - Patents
Attention: Robert W. Bahr
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Proposed Rule Changes to Continuation and Claim Practice

Dear Mr. Bahr:

I have been practicing patent law as an agent and attorney for 15 years.

The goal of speeding up the examination process, especially examining new applications, is laudable. However, I write to strenuously object to the proposals involving continuation applications and claim number limitations, ostensibly to solve this problem. The two proposals work in tandem to greatly infringe on an inventor's freedom to claim her invention in different ways, as permitted by law. I suggest instead making examination of new applications a priority, so applicants will be on notice that their continuations will take longer, and will strive to be more efficient and timely in claiming the important aspects.

The proposed rules are couched in rationales that pay homage to the notice function of patents, however it appears that a subtext is a concern about "submarine" patents, which appear many years after development of a new technology. But this concern was addressed by the 1995 changes limiting patent term. The proposed changes suggest a policy change that disfavors numerous patents of similar scope, which up until now have been permissible. Such a policy change should be made by the Legislature not by a regulatory body. Changing the rules on continuations is not justified by statutory or case law. 35 U.S.C. §120 provides for the filing of continuations, and does not suggest that the patent office has the power to make changes as proposed. These change materially affect the permissiveness of Section 120.

What follows are a number of thoughts and reasons in opposition to the proposals.

One reason for filing multiple continuations is often to keep a case pending so that claims can be rewritten to cover competitors design arounds. There is no prohibition against that, and in fact the courts have sanctioned it.

Often, the disclosure is voluminous and the first-filed set of claims does not cover every aspect. Multiple continuations are often necessary to continue mining the disclosure for new claims.

For instance, what about an application resulting from a brainstorming session where there is a perceived novelty that branches out into 10 embodiments? Independent claims on more than a few of the embodiments will no longer be available, unless they are filed separately at the same

time. However, then the inventor would run headlong into the rule changes on limiting the number of claims that can be filed.

The parallel proposed rules about limiting the number of claims adds to the problem. If the new rules on continuations are implemented, but unlimited divisional applications (as different patentable inventions) are available, then all applicants will strive to file more claims up front. Of course, that would be foolish, the better tack is to file multiple separate applications simultaneously.

Often the Examiner views too many claims as a burden and issues multiple invention and species restrictions. The proposed rules do not appear to draw a distinction between divisionals and continuations.

There are countless reasons to file continuation applications, and if the applicant pays the filing fees then the office should be able to examine the claims. STOP FEE DIVERSION!!

To propose limits on RCE's is entirely reasonable. After one RCE filing, the applicant should go to the appeal process. This is especially reasonable given that the RCE cannot change claim type (i.e., the applicant cannot cancel claims in favor of a different type of claims in an RCE).

There does not seem to be any accommodation for the cases where Examiner's continue to find new rejections for claims. In other words, if at a final office action the Examiner shifts the rationale for rejection then the applicant must either file an appeal or file an RCE to argue against the new rejection. There should be a rule that prevents the Examiner from issuing any new rejections in an RCE, unless the claims are modified such as to raise new issues.

The proposed rules are unfair because they benefit some entities more than others by limited continuations. For example, medical device manufacturers face a patent life cycle well before any commercial realization. Typically, the patent is filed during the development stage, and just before a clinical trial or conference release. The regulatory path is so long that the product may take 10 years to reach the market. During that time, new developments may prompt a different claim focus, or serial CIPs may result. When it does reach the market, having a pending case may be invaluable to deter competitors.

There will be an incentive to sever the disclosure into separate components and claim those separately so as to be able to rebut the presumption of them not being patentably indistinct. I.e., system A-B-C-D will be filed, as well as any components A, B, C, etc. that separately are believed novel.

There is also a major disincentive for inventor is in that their intellectual property becomes less valuable. In the case of a small inventor or business, having a pending patent application is extremely valuable to a larger buyer who can write new claims. Limiting the number of continuations greatly reduces this value.

In short, I write to oppose the proposed rule changes both with regard to continuations and limiting the number of claims.

Sincerely,

Guy Cumberbatch, Esq.