

From: Chris Garvey [mailto:cgarvey@collardroe.com]
Sent: Fri 4/7/2006 6:55 PM
To: Clarke, Robert
Cc:
Subject: Oppose proposed changes to continuation practice

Sirs:

I oppose the proposed changes to the continuation practice. Prosecuting a patent is a process of negotiation. The applicant wants to obtain protection for his innovative contributions in return for granting the public access to the invention. The PTO wants to make sure that the applicant receives protection only for the new subject matter the applicant added to the public knowledge.

There was a time when Examiners would discuss the scope of the claims in good faith over multiple office actions, and could settle, in an interview, on mutually acceptable language.

The current PTO productivity scheme seems to discourage such give and take, encouraging the Examiner to focus only on getting to final rejection as quickly as possible, always on the second office action, regardless of whether or not he has ignored legitimate distinguishing limitations in the rejected claims.

While an interview might appear to bring an Examiner to agreement, he will often decline to formally agree, saying he wants to review the matter further.

A final rejection then follows, based on the same grounds the applicant thought he had overcome.

Continuation applications provide the applicant with a way to continue

negotiations after final rejections, short of the more adversarial processes of appeal or the District Court. The continuation practice (continuations and RCEs) is an integral part of this negotiation process and should NOT be changed.

The proposed business of having to write an additional brief of excuses for each continuation is mere busy-work. The fact that an applicant is paying a significant filing fee shows that the applicant thinks he can advance the discourse.

The proposed changes are a solution in search of a problem.

The founders of this country recognized the importance of investing in science and technology, and right now, one of the biggest industries and generators of wealth is technology (mechanical, electrical, biological, to name a few).

Popular political support for the patent system is largely based on the democratic idea that any individual inventor can get a patent, and earn his fortune. I have seen this done several times.

These changes will merely impose additional costs and barriers on the individual inventor of limited means. When the public perceives that the patent system only protects large corporations, broad political support for the patent system will disappear.

The PTO would be doing a great disservice to the inventors in this country by modifying the continuation practice as indicated.

Thank you for your kind attention.

Yours very truly,

Christopher B. Garvey