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Sent: Wednesday, May 03, 2006 5:27 PM

To: AB93Comments

Cc: CURTIS CASTLEMAN - LEGAL; Jeffrey Thurnau; PAUL DUNLAP

Subject: Comments concerning the proposed changes to continuation practice

Please find comments concerning the proposed changes to continuation practice attached.

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May 3, 2006

The Honorable Jon Dudas,  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office

Robert W. Bahr,  
Senior Patent Attorney  
Office of the Deputy Commissioner for Patent Examination Policy

RE: Comments on proposed: "Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims" (January 3, 2006)

Dear Under Secretary Dudas and Mr. Bahr,

First, the below named practitioners would like to point out that even comments provided by law firms in favor of the above-identified rule changes to continuation practice before the USPTO indicate that two continuations (or more) are sometimes required to obtain allowance of an application. To wit, numerous comments have discussed the time honored US patent practitioner practice of "taking allowed claims." This practice involves canceling non-allowed claims (and amending allowable claims), permitting allowed claims to issue, then filing a continuation application to prosecute the non-allowed claims. The proposed rule changes will greatly cripple this practice, which will not result in a reduction of backlog in the USPTO, but may well have the opposite effect. Practitioners may feel more pressure to entrench and argue a case to the bitter end, increasing the number of appeals and petitions (to remove finality, etc.) filed. Further, fair implementation of the continuation limitation rule changes will require a significant change in Examiner mindset, also discussed by numerous comments, in that Examiners currently encourage the above-described practice.

This brings to issue the erroneous equation of Requests for Continued Examination (RCEs) with Continuation patent applications by the promulgators of the proposed rules. Unlike the filing of a continuing application, the filing of an RCE also requires an applicant to advance prosecution of the patent application. The USPTO has over the years made continued examination easier to obtain, first with the File Wrapper Continuation practice (of old 37 CFR 1.60), then with CPAs (Continuation Patent Applications), then with the RCE. The proposed "pendulum-swing" back will not only be a change of business expectations for the USPTO's customers, but will require substantial changes of mindset in the Examiners, as discussed above.

Further, it is erroneous to "lump" Continuation-in-Part (CIP) applications in with Continuations and RCEs. As also discussed by numerous comments, CIPs are primarily used by Applicants when an improvement to an invention is developed and the Applicant needs to disclose and claim this improvement. These improvements often become the key feature of an invention which leads to its success.

Similarly, continuation applications are often filed to claim previously unclaimed subject matter when it is discovered that some particular aspect of the invention is what is important to users and/or the marketplace.

Thus, through the judicious, and quite legitimate, use of continuations and/or CIPS an Applicant can seek reasonable patent protection for a product as it evolves from the initially claimed (and disclosed) concept/prototype to a finished “on the shelf” product. Not only would the proposed rules make such continuity of protection difficult to obtain, the rule changes would also render such filings problematic if it became necessary to file an RCE for procedural purposes earlier in prosecution of the original application.

Hand-in-hand with the above discussed practices, the attentive practitioner will, in light of the present legal climate, create as little file wrapper estoppel as possible. Therefore, the diligent, legitimate use of mechanisms such as RCEs and “taking allowed claims” to avoid arguing more issues than is necessary is to some degree mandated by the sound practice of patent law as a profession. The proposed continuation practice rule changes would render such diligent practices impractical.

The Office cites the use (abuse) of the continuation practice by Applicants to implement submarine applications as one reason for the proposed rule changes. The below-named practitioners would like to respectfully suggest that the USPTO’s mandate is the issuance of patents for useful, novel, non-obvious inventions, not the enforcement of patents. The CAFC has addressed submarine patents in numerous cases using such legal mechanisms as laches. Further, as admitted by the Office’s own comments, the 20 year term law changes, implemented a little over a decade ago, particularly in conjunction with the application publication law changes, are already dealing with these issues, without resorting to the draconian administrative measures proposed and the resulting limitations on diligent practitioners of patent law.

The proposed rule changes would seem to encourage, if not require, an Applicant to claim all he can as early as he can and avoid the use of continuation applications, arguably not an undesirable goal. However, in contrast, the companion proposed “Changes to Practice for the Examination of Claims in Patent Applications” call for limiting the number of claims to be substantively examined, and thereby the number of claims a conscientious patent practitioner will include in an application (to avoid placing undesirable estoppel on the record). These two requirements are at odds, and especially at odds with the stated goal of reducing the USPTO’s backlog. It would seem that the prudent practitioner will file multiple concurrent applications with small number of claims to avoid these rules (and contend with the proposed new rules directed to a presumption of indistinctiveness by reciting different claim limitations by rote or by filing a terminal disclaimer ), thereby increasing the USPTO’s backlog.


Finally, the below named practitioners respectfully assert that the proposed changes to continuation practice may well be inconsistent with the intent, if not the actual language, of 35 U.S.C §120, as pointed out by the AIPLA in its comments, in that §120 places no limits on the number of continuations one may file. Additionally, the proposed rule changes relating to elimination of voluntary divisional applications may be in violation of Article 4G(2) of the Paris Convention which requires that: “The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional

application, the date of the initial application and the benefit of the right of priority, if any," as also pointed out by other comments.

For at least the foregoing reasons, the Office is respectfully urged to not adopt the proposed "Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims."

The views expressed above are not necessarily those of the below signed practitioners' employer, the Gates Corporation, or its parent company Tomkins plc.

Respectfully submitted by,



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