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From: Wieland III, Charles [mailto:wielandcf@bipc.com]
Sent: Monday, May 01, 2006 8:55 AM
To: AB93Comments
Subject: proposed rule changes regarding continuation practice (71 Fed. Reg. 48 (Jan. 3, 2006))

Sir:

With respect to the proposed rule changes regarding continuation practice (71 Fed. Reg. 48 (Jan. 3, 2006)), I am in general agreement with the IPO and AIPLA positions. I see no need to reiterate them here.

The purpose of this letter is to suggest an alternative procedure that would reduce the number of continuations by as much as 18,000 per year (according to PTO statistics) while benefiting both the Office and the public in several ways.

The proposed change can be understood as a CIP - RCE practice. Rather than require applicants to file a separate CIP application under Rule 53(b) to add "new matter" to an existing application, applicants could file a new, "substitute" specification with a marked-up copy showing changes (thereby identifying or highlighting the "new matter" which is not currently required) and an RCE-type form and fee.

Among the advantages to applicants is that the application would not lose it place in the examination queue and there would only be one application to prosecute. CIP - RCE's would be logical in the two most common situations that a CIP is desired or required. One situation is when one or more of the original or desired claims were not sufficiently supported in the original filing. The "new matter" is added to support the desired claims. The present practice of disrupting and delaying the flow of communication between the examiner and the applicant while waiting for the new Rule 53(b) CIP application to come up in queue is inefficient in many ways, particularly when the second CIP application is

not assigned to the examiner working on the original application, which is often the case.

The same is true if the CIP - RCE practice was adopted for the other common CIP situation, i.e., the invention was further developed in the normal course of business. Many applicants, particularly small entities, would find it logical and cost effective to have that "new material" added to an existing application already in queue, rather than filing a separate application. While there are circumstances where more than one application is desirable, the advantage of faster examination, more cost effective and double patenting free examination would likely be the stronger desire. Any concerns about causing the Examiner additional work would be addressed by the RCE mechanism, and there is of course a reduction is support staff burden by the maintenance of one rather than two separate patent applications.

Under both situations, the examination would be more efficient from the PTO's perspective in other ways. An examiner already familiar with the application would be in a better position to understand significance of the changes, and would be less likely to have to re-learn details of the application. In situations where the examination had not started, the Examiner/PTO would still be better off because there would be only one, instead of two, applications to examine and no double patenting issues.

By way of example, I am working on one series of applications were the invention was continually developed of the course of several years. In all, there are five applications still pending, four of which are CIP's with a chain of priority claims. There have been double patent rejections in a couple of the applications (which were contestable, but terminal disclaimers were filed), and no two of the applications has the same examiner. If there were a CIP -RCE practice available, I am confident the applicant would have elected single application to reduce cost and complexity, the result also being a clearer presentation of the appropriate filing dates respective claims should receive via marked-up specifications, as well as to have uniform, efficient examination devoid of double patenting issues.

Please consider this option. It presents a win-win opportunity for the Office and the applicants. Of course, the views expressed herein are my own, and not necessarily those of my firm.

Sincerely,

Charles F. Wieland III

(Reg. No. 33,096)