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From: Kevan Morgan [mailto:kevan@cojk.com]

Sent: Wednesday, May 03, 2006 4:40 PM

To: AB93Comments; AB94Comments

Subject: WSPLA Comments on USPTO Proposed Rules Changes (2006)

Robert W. Bahr, Senior Patent Attorney
Office of the Deputy Commissioner for Patent Examination Policy
Robert A. Clarke, Deputy Director
Office of Patent Legal Administration

Dear Mr. Bahr and Mr. Clarke,

Attached please find Comments of the Washington State Patent Law Association relative to the rules changes proposed by the United States Patent and Trademark Office at 71 Fed. Reg. 48 (January 3, 2006) and 71 Fed. Reg. 61 (January 3, 2006).

We have an active Legal Affairs Committee and Board of Directors who contributed to these comments. We appreciate the opportunity to have our thoughts and experience considered.
Sincerely yours,

Kevan L. Morgan
President
Washington State Patent Law Association

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May 3, 2006

Via E-Mail Communication Only: AB93Comments@uspto.gov
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Mail Stop Comments – Patents
Commissioner for Patents
P.O. Box 1450
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Attn: Robert W. Bahr, Senior Patent Attorney
Office of the Deputy Commissioner for Patent Examination Policy

Robert A. Clarke, Deputy Director
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To the Commissioner for Patents:

On behalf of the Washington State Patent Law Association, and representing the views of its Board of Directors, I respectfully submit the following comments regarding the Proposed Rule Changes To Continuation Applications of the United States Patent and Trademark Office (USPTO) 71 Fed. Reg. 1, 48 (2006), and the Proposed Rule Changes to Practice for the Examination of Claims in Patent Applications 71 Fed. Reg. 1, 61 (2006) (hereinafter referred to singly or in combination as "Proposed Rule Changes"). Although we appreciate the immense challenges faced by the USPTO and the Commissioner's genuine efforts to address those challenges, I wish to offer our perspective on the Proposed Rule Changes, and to explain why we oppose the Proposed Rule Changes as overly detrimental to many seeking to protect intellectual property, and thus, overly detrimental to innovation.

The Washington State Patent Law Association is an organization serving the needs of over 300 patent practitioners in and around the Pacific Northwest, a region widely recognized as a center of excellence and strategic importance for innovation and world trade. The Association holds regular continuing education seminars focusing on the changing interests and needs of our constituency. Our members are involved in both private and corporate practice and are actively



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engaged in all aspects of procurement and commercialization of patents, both domestically and internationally. As patent practitioners in one of the leading technology centers in the United States, the impact of the Proposed Rule Changes on many of our constituents would be direct, immediate, and highly detrimental.

The Washington State Patent Law Association opposes the Proposed Rule Changes for the following reasons.

1. Current USPTO practices compel applicants to file continuation and divisional applications.

Recent claim fee increases for examination of an application serve to penalize applicants who describe and claim multiple embodiments of technically complex inventions. Zealous use of restrictions and increasingly abbreviated prosecution through final rejection often require applicants to undesirably reduce the scope of the claims (often based on an examiner's subjective, seemingly arbitrary determination) and to resolve prosecution quickly, often at the expense of legitimate claim scope. These practices compel applicants to file continuation applications to ensure adequate portfolio coverage. Therefore, the Proposed Rule Changes are at odds with current USPTO practices that result in filing of continuation applications, and if adopted, will serve to weaken patent protection and discourage innovation.

As noted above, multiple continuation and (divisional) applications are filed, in part, because of the USPTO's restriction practice. For an applicant to prosecute all the "separate inventions," the applicant needs to file continuation and divisional applications. Many applicants choose to file these applications sequentially, in great part, because of budgetary constraints. In addition, as a result of the current fee structure, applicants file multiple applications with twenty or fewer claims because this filing strategy, in many instances, is more financially feasible and prudent than filing fewer applications, each with more than twenty claims. Sequential filing may also provide efficiencies, as lessons learned in prosecution of earlier applications are immediately applied in subsequent applications to speed prosecution.

The practical effect of the Proposed Rule Changes that (1) limit applicants to only those continuation applications that can be supported by a showing that the amendment, argument, or evidence



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presented could not have been previously submitted and (2) deny applicants the benefit of a parent application's filing date for divisional applications not filed during the pendency of the parent application denies applicants the right to patent their inventions, thus discouraging innovation. Particularly, applicants without abundant capital (such as individual inventors, small businesses, and start-up companies) would be significantly impacted. Moreover, if the Proposed Rule Changes are adopted, we assume that some, if not most, applicants will file multiple divisional applications to maintain the benefit of the claimed priority date; therefore, the workload of USPTO personnel will not decrease, but will likely increase.

2. Patent scope is being restricted by the courts.

The courts have become less inclined to interpret the scope of an invention beyond the literal meaning of the claims, precluding claim scope that at one time was captured under the Doctrine of Equivalents. As a result, applicants are forced to file continuation applications directed to multiple related embodiments to prevent competitors from usurping what patent exclusivity that patentees may have otherwise enjoyed. In view of the philosophy of restrictive claim interpretation by the courts, the Proposed Rule Changes, if adopted, will have an overly detrimental impact on patentees because limiting applicants to only those continuation applications that can be supported by a showing that the amendment, argument, or evidence presented could not have been previously submitted would eliminate a vast number of legitimate continuation applications needed to provide coverage of alternate aspects of an invention. Furthermore, requiring applicants to identify a subset of representative claims for initial examination unduly provides an infringer with an artificially-imposed defense to present to a court regarding what the patentee may have initially considered "representative" of the scope of the invention. Consequently, the courts will likely continue to interpret claims more narrowly, further discouraging innovation.

3. Incentives for companies dependent on R&D are reduced.

At the time of filing an application, the claim scope that provides the most suitable protection of the invention may be uncertain. Companies who diligently protect their intellectual property often file patent applications containing claims that encompass



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embodiments that later, for one reason or another, fail the rigors of product development. The applications, however, may also support alternate claims that are worthy of prosecution and entitled to patent protection. If the Proposed Rule Changes are adopted, the burden of compliance unduly penalizes applicants, particularly R&D companies innovating at the edge of uncertainty, and unfairly weakens the incentive that drives this sector of the economy: an opportunity to obtain adequate and appropriate patent exclusivity. Accordingly, if the USPTO institutes the Proposed Rule Changes, the question arises whether the government will be complying with the Constitutional mandate to promote the progress of science and the useful arts.

4. Additional bureaucratic review, arbitrariness, and delay will result.

The time for review of patent applications by the USPTO is already excessive. If the Proposed Rule Changes to the practice of continuation applications are effected, the change in procedures will further delay application review by necessitating review of petitions supporting the filing of continuation applications. Inevitably, the length of time for prosecution of an application will increase while decisions on such petitions are debated and appealed. The added layers of review and the arbitrariness associated with the new requirements will increase burdens on the USPTO.

5. The USPTO has other, more appropriate ways to improve its processes.

For the foregoing reasons, the Washington State Patent Law Association respectfully submits that the USPTO should look to other, more appropriate ways of improving its internal processes, including:

- (1) instituting a process by which applicants may elect to defer examination (perhaps with appropriate fee incentives for doing so), effectively reducing the number of applications examined, or requiring applicants to formally request examination within a certain timeframe;
- (2) revising the system for evaluation of examiner performance to remove aspects that may undesirably promote inefficiencies (e.g.

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(3) inappropriate restrictions, premature final rejections, etc.); and hiring additional examiners to adequately staff art units.

In conclusion, the Washington State Patent Law Association wishes to reiterate its appreciation of the challenges faced by the USPTO, and of the Commissioner's genuine efforts to address those challenges. We believe, however, that the Proposed Rule Changes are overly detrimental to the legitimate protection of intellectual property, and thus, to innovation.

Respectfully submitted on behalf of the Board of Directors of the Washington State Patent Law Association,



Kevan L. Morgan, President