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**From:** infiniteprogrss@comcast.net [mailto:infiniteprogrss@comcast.net]

**Sent:** Tue 5/2/2006 9:16 PM

**To:** AB93Comments

**Cc:**

**Subject:** Comments on Proposed Change to the Examination and Continuation Practice Rules

Dear Sirs:

Attached are comments from several practitioners before the PTO. The Comments address jointly the proposed changes to the Examination and Continuation Practice rules.

Sincerely,

Dale Cook

Attorney

PTO Reg. No. 42434

# Comments Opposing Proposed Rules of Practice in Patent Cases

The following comments are submitted by the persons listed below to the Proposed Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims (e.g., proposed changes involving 37 CFR 1.75, 1.78, 1.114, and/or 1.261), Notice of proposed rulemaking, first published in the Federal Register at 71 Fed. Reg. 48 (January 3, 2006) and then published in the Official Gazette at 1302 Off. Gaz. Pat. Office 1318 (January 24, 2006).

**The views expressed herein are those of the signatories in their individual capacities as lawyers and/or agents admitted to practice before the PTO, and are NOT to be taken as representative of the view of any client(s) of the signatories, past or present.**

Submitted by:  
Dale Cook

Joined in by:  
Fred Kaseburg;  
Charles Claunch;  
David Romney;  
Jonathan Olson;  
Leif Stordal;  
Glenn Foster;  
Corrie Vaa;  
R. Alan Burnett; and  
Margaret M. Anderson

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## Comments Opposing Proposed Rules of Practice in Patent Cases

### I. Proposed Rules Requiring "Examination Support Document" are in Opposition to Law of Prima Facie Case of Unpatentability and Law of Duty to Search

Proposed Rule 37 CFR 1.75(b)(1) (emphasis added) states as follows:

(1) An applicant must submit an examination support document in compliance with § 1.261 that covers each independent claim and each dependent claim designated for initial examination if either:

- (i) The application contains or is amended to contain more than ten independent claims; or
- (ii) The number of independent claims plus the number of dependent claims designated for initial examination is greater than ten.

. . .  
(3) The applicant will be notified if an application contains or is amended to contain more than ten independent claims, or the number of independent claims plus the number of dependent claims designated for initial examination in such an application is greater than ten, but an examination support document under § 1.261 has been omitted. If prosecution of the application is not closed and it appears that omission was inadvertent, the notice will set a one-month time period that is not extendable under § 1.136(a) within which, to avoid abandonment of the application, the applicant must:

- (i) File an examination support document in compliance with § 1.261 that covers each independent claim and each dependent claim designated for initial examination;
- (ii) Cancel the requisite number of independent claims and rescind the designation for initial examination of the requisite number of dependent claims that necessitate an examination support document under § 1.261; or
- (iii) Submit a suggested requirement for restriction accompanied by an election without traverse of an invention to which there are drawn no more than ten independent claims as well as no more than ten total independent claims and dependent claims designated for initial examination.

Proposed Rule 37 CFR 1.261 (emphasis added) states as follows:

(a) An examination support document as used in this part means a document that includes the following:

- (1) A statement that a preexamination search was conducted, including an identification of the field of search by United States class and subclass and the date of the search, where applicable, and, for database searches, the search logic or chemical

structure or sequence used as a query, the name of the file or files searched and the database service, and the date of the search;

(2) An information disclosure statement in compliance with § 1.98 citing the reference or references deemed most closely related to the subject matter of each of the independent claims and designated dependent claims;

(3) For each reference cited, an identification of all the limitations of the independent claims and designated dependent claims that are disclosed by the reference;

(4) A detailed explanation of how each of the independent claims and designated dependent claims are patentable over the references cited with the particularity required by § 1.111(b) and (c);

(5) A concise statement of the utility of the invention as defined in each of the independent claims; and

(6) A showing of where each limitation of the independent claims and the designated dependent claims finds support under the first paragraph of 35 U.S.C. 112 in the written description of the specification. If the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the independent claims and the designated dependent claims finds support under the first paragraph of 35 U.S.C. 112 in each such application in which such support exists.

(b) The preexamination search referred to in paragraph (a)(1) of this section must involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated source and includes such a justification with the statement required by paragraph (a)(1) of this section. The preexamination search referred to in paragraph (a)(1) of this section must be directed to the claimed invention and encompass all of the features of the independent claims and must cover all of the features of the designated dependent claims separately from the claim or claims from which the dependent claim depends, giving the claims the broadest reasonable interpretation. The preexamination search referred to in paragraph (a)(1) of this section must also encompass the disclosed features that may be claimed.

**A. Proposed Rules Requiring "Examination Support Document" are in Opposition to Law in that they Purport to Shift the Burden to Patent Applicant to Establish a Prima Facie Case of Patentability**

The PTO has recognized that the Federal Circuit's interpretation of statutory patent law clearly states that "the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. . . . If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent." *MPEP* § 2107 (emphasis added) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). This concept has recently been reiterated by the Federal Circuit as follows: "[d]uring patent examination the PTO bears the initial burden of presenting a prima facie case of unpatentability..... If the PTO fails to meet this burden, then the applicant is entitled to the patent." *In Re Glaug*, 283 F.3d 1335 (Fed. Cir., 2002). Furthermore, this concept is clearly resident in the patent statutes themselves in that 35 U.S.C. § 132 states, "[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement is made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or

without amendment, the application shall be reexamined" (emphasis added). Accordingly, as announced by the Federal Circuit, recognized by the PTO, and set forth in the patent statutes, unless and until an examiner presents evidence establishing prima facie unpatentability, an applicant is entitled to a patent on all claims presented for examination.

In contrast to the foregoing, proposed rule 37 CFR 1.75(b)(1) states that "[a]n applicant must submit an examination support document in compliance with § 1.261 that covers each independent claim and each dependent claim designated for initial examination if either: (i) The application contains or is amended to contain more than ten independent claims; or (ii) the number of independent claims plus the number of dependent claims designated for initial examination is greater than ten." Proposed rule 37 CFR 1.261(a)(3)-(4) states that "[a]n examination support document as used in this part means a document that includes the following: . . . (3) For each reference cited, an identification of all the limitations of the independent claims and designated dependent claims that are disclosed by the reference; (4) A detailed explanation of how each of the independent claims and designated dependent claims are patentable over the references cited with the particularity required by § 1.111(b) and (c)." Proposed rule 37 CFR 1.75(b)(3) states that "if an application contains or is amended to contain more than ten independent claims, or the number of independent claims plus the number of dependent claims designated for initial examination in such an application is greater than ten . . . to avoid abandonment of the application, the applicant must: (i) File an



examination support document in compliance with § 1.261 that covers each independent claim and each dependent claim designated for initial examination; (ii) [or] Cancel the requisite number of independent claims and rescind the designation for initial examination of the requisite number of dependent claims that necessitate an examination support document under § 1.261."

Simplified, the foregoing constellation of rules state that if an applicant desires examination of claims in excess of ten, then applicant must give a "detailed explanation of how each of the independent claims and designated dependent claims are patentable over the references cited." That is, that the applicant must establish a prima facie case of the patentability of such claims over ten in order for a patent to issue. This is in direct opposition to the Federal Circuit's statement, and the PTO's previous recognition of same, that under the patent statutes the examiner [PTO] bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. . . . If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent." Thus, the proposed rules purporting to require an "examination support document" are in opposition to the Federal Circuit's interpretation of the patent statute (and the PTO's express recognition of same) in that they purport to shift the burden to the patent applicant to establish patentability WITHOUT the requirement that the examiner

meet the statutorily mandated duty to establish a prima facie case of unpatentability. Since the authority cited by the PTO as authority to make the proposed rule changes, 35 U.S.C. 2(b)(2), does not extend to changing statutory and/or judge-made law, the proposed rules constitute an unlawful attempt to change the law in that they extend beyond the general rule-making authority of 35 U.S.C. 2(b)(2). Bernard Schwartz, *Administrative Law* (Agency power does not extend to power to change statute or judge made law.)

**B. Proposed Rules Requiring Submission of "Examination Support Document" are in Opposition to Law in that they Purport to Create a Duty to Search**

The Federal Circuit has repeatedly clearly stated that there is no duty to search prior art under the patent statutes. *Frazier v. Roessel Cine Photo Tech, Inc.*, 417 F.3d 1230 (Fed. Cir. 2005) ("this court has repeatedly reaffirmed the proposition that "[a]s a general rule, there is no duty to conduct a prior art search, and thus there is no duty to disclose art of which an applicant could have been aware." *FMC Corp. v. Hennessy Indus., Inc.*, 836 F.2d 521, 526 n.6 (Fed. Cir. 1987)).

In contrast to the foregoing, proposed rule 37 CFR 1.75(b)(1) states that "[a]n applicant must submit an examination support document in compliance with § 1.261 that covers each independent claim and each dependent claim designated for initial examination if either: (i) The application contains or is amended to contain more than ten independent claims; or (ii) The number of independent claims plus the number of dependent claims designated for

initial examination is greater than ten." Proposed rule 37 CFR 1.261(a)(1) states that "[a]n examination support document as used in this part means a document that includes the following: . . . [a] statement that a preexamination search was conducted, including an identification of the field of search by United States class and subclass and the date of the search, where applicable, and, for database searches, the search logic or chemical structure or sequence used as a query, the name of the file or files searched and the database service, and the date of the search." Proposed rule 37 CFR 1.261(b) states that "The preexamination search referred to in paragraph (a)(1) of this section must involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated source and includes such a justification with the statement required by paragraph (a)(1) of this section. The preexamination search referred to in paragraph (a)(1) of this section must be directed to the claimed invention and encompass all of the features of the independent claims and must cover all of the features of the designated dependent claims separately from the claim or claims from which the dependent claim depends, giving the claims the broadest reasonable interpretation. The preexamination search referred to in paragraph (a)(1) of this section must also encompass the disclosed features that may be claimed."

Simplified, the foregoing constellation of rules state that if an applicant desires examination of claims in

excess of ten, then the PTO has taken it upon itself to impose upon the applicant a duty to search that both is extensive and odious. This is in direct opposition to the Federal Circuit's statement that there is no duty to conduct a prior art search prior to filing a patent application (as an aside, we note that that is what applicant is paying the PTO to do - see, e.g., (37 CFR 1.16(k)). Thus, the proposed rules are in opposition to the Federal Circuit's interpretation of the patent statute in that they purport to give rise to a duty to search the prior art as a prerequisite to obtaining examination of presented claims. Since the authority cited by the PTO as authority to make the proposed rule changes, 35 U.S.C. 2(b)(2), does not extend to changing the statutory and/or judge-made law, the proposed rules constitute an unlawful attempt to change the law in that they extend beyond the general rule-making authority of 35 U.S.C. 2(b)(2).

## **II. Proposed Rules to Limit Examination to Ten Claims Based on a Misunderstanding of Federal Court Law and/Or Logic of Patent Prosecution Before the PTO**

In its Supplementary Information section regarding the proposed modifications to 37 CFR limiting of examination to only ten claims, the PTO states:

The Office's current practice for examination of claims in patent applications provides for an initial examination of each and every claim, independent and dependent, in every Office action on the merits of the application. The Office's current practice for examination of claims in patent applications is less efficient than it could be because it requires an initial patentability examination of every claim in an application, notwithstanding that this effort is wasted when the patentability of the dependent claims stand or fall together with the independent claim from which they directly or indirectly depend. Thus, the Office is proposing to delay the patentability examination of most dependent claims until the application is otherwise in condition for allowance. The Office, however, will

examine every claim in an application before issuing a patent on the application. [Note: the PTO has stated publicly that the examination of the delayed claims will only be for utility and definiteness.]

Both the Board of Patent Appeals and Interferences (BPAI) and the courts commonly employ some form of using representative claims to focus and manage issues in a case. The BPAI's representative claim practice provides that if the applicant desires the BPAI to consider the patentability of a claim separately from the other claims also subject to the same ground of rejection, the applicant must include a subheading in the arguments section of the appeal brief setting out an argument for the separate patentability of the claim. See 37 CFR 41.37(c)(1)(vii). If there are multiple claims subject to the same ground of rejection and the applicant argues the patentability of the claims as a group, the BPAI will select a claim from the group of claims and decide the appeal with respect to that group of claims on the basis of the selected claim alone. See *id.*

The Office plans to apply a similar practice to the BPAI's representative claim practice to the examination of patent applications. Specifically, the Office will provide an initial patentability examination to the claims designated by the applicant as representative claims. The representative claims will be all of the independent claims and the dependent claims that are expressly designated by the applicant for initial examination. Thus, each independent claim and each dependent claim that is designated for initial examination will be treated as a representative claim for examination purposes. The examination of the dependent claims that are not designated for initial examination will be deferred until the application is otherwise in condition for allowance. Specifically, applicants will be required to assist the Office in eliminating unnecessary effort by permitting the Office to provide an initial examination to a more focused set of claims; that is, only to the independent and designated dependent claims.

#### **A. PTO is Mistaken: Federal Court's Considering the Validity of a Dependent Claim as Standing or Falling with the Validity of Independent Claim is Reversible Error**

As stated above, the PTO's theoretical justification for its proposed limitation of claims to ten is stated as follows: "[t]he Office's current practice for examination of claims in patent applications is less efficient than it could be because it requires an initial patentability examination of every claim in an application,

notwithstanding that this effort is wasted when the patentability of the dependent claims stand or fall together with the independent claim from which they directly or indirectly depend . . . Both the Board of Patent Appeals and Interferences (BPAI) and the courts commonly employ some form of using representative claims to focus and manage issues in a case."

As shown following, the PTO is absolutely and unequivocally dead wrong on the foregoing regarding what the federal courts may/may not do in assessing the validity of dependent claims. The federal courts DO NOT AND CANNOT, by statute, treat dependent claims as standing and falling together in a validity context. The Federal Circuit's guidance on this point is clear:

Finally, the district court erred in not separately analyzing the validity of claim 14. The district court stated that "[b]ecause Claim 13 is the independent claim and Claim 14 is dependent upon Claim 13, the analysis of Claim 13 will determine the validity of Claim 14."

Invalidity Order at 3. Without separately analyzing claim 14, the district court granted "partial summary judgment regarding the invalidity of claims 13 and 14 . . . because [Wacom and LCS] have provided clear and convincing evidence that claim 13 was anticipated by the Seiko Driver. Because the claims are invalid, there can be no infringement." Id. at 7.

**When determining the validity of the claims of a patent, each claim must be separately considered:**

Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. . . . The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting invalidity.

35 U.S.C. § 282 (2000); Sandt, 264 F.3d at 1356, 60 USPQ2d at 1098 ("Because dependent claims contain additional limitations, they cannot be presumed to be invalid as obvious just because the independent claims from which they depend have been properly so found."). On remand, the

**district court should separately analyze the validity of claim 14.**

*Schumer v. Laboratory Computer Systems, Inc.*, 308 F.3d 1304, 64 USPQ 2d 1832 (Fed. Cir. (Wash) 2002) (emphasis added)

Thus, in the federal courts the validity of dependent claims do not stand and fall with the claims from which they depend. By statute, each dependent claim must be examined and shown invalid on an individual basis. Failure of a lower court to consider each dependent claim individually is reversible error. Hence, the PTO is dead wrong with respect to its rationale underlying limiting examination to ten claims.

**PTO is Mistaken: Failure to Examine and/or Improper Examination of Dependent Claims Will Result in Issuance of Invalid Independent Claims**

The PTO has been doing a "road show" trying to "sell" the public on the proposed rule changes. One of the Powerpoint slides in the road show states that, once a representative independent claim has been allowed, the undesignated dependents will only be examined for compliance with 35 USC §101 and the definiteness aspects of §112. No similar provision was located in the proposed rule 37 CFR 1.75; that is the proposed regulation states that the undesignated will be examined once patentability of a designated claim is determined, but does not give the scope of the examination. As stated above, the PTO is of the opinion that examining dependent claims is "wasted effort" in that the validity/invalidity of a dependent claim will not affect the validity of a claim from which it depends. The PTO is dead wrong on this.

Federal Circuit case law makes very clear that it is important that all dependent claims be examined, because an improperly examined dependent claim can invalidate an examined independent claim. With respect to this issue, the Federal Circuit has stated

Moreover, and most importantly, claims 1 and 5 must also encompass aluminum with up to about 10% silicon, i.e., Type 1 silicon, because claims 3 and 7, which depend from claims 1 and 5, respectively, expressly recite "up to about 10% silicon." Under the doctrine of claim differentiation, dependent claims are presumed to be of narrower scope than the independent claims from which they depend. See RF Del., Inc. v. Pac. Keystone Techs., Inc., 326 F.3d 1255, 1264 (Fed. Cir. 2003) (stating that an independent claim is usually accorded a scope greater than its dependent claims); see also 35 U.S.C. § 112, ¶ 4 (2000) ("[A] claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers."). That presumption is applicable in this case and has not been rebutted. If the dependent claims expressly recite "up to about 10%" silicon, then the independent claims, which must be at least as broad as the claims that depend from them, must include aluminum coatings with "up to about 10%" silicon. Independent claims 1 and 5 therefore also cover at least steel strips hot-dip coated with aluminum containing about 10% silicon, i.e., Type 1 aluminum.

. . . . .  
Given our construction of the '549 patent claims, we turn to the question whether the district court properly determined that those claims have not been enabled.

. . . . .  
We agree with the district court that the claims as construed have not been enabled.

. . . . .  
Finally, we dispel the notion that the failure of the PTO to issue an enablement rejection automatically creates an "especially weighty presumption" of compliance with 35 U.S.C. § 112. AK Steel cites language in Brooktree Corp. v. Advanced Micro Devices, Inc., 977 F.2d 1555, 1574-75 (Fed. Cir. 1993), to that effect. However, whether a patent complies with the enablement requirement depends upon a factually intensive inquiry regarding the amount of experimentation required, see Wands, 858 F.2d at 737, an issue to be evaluated on a case-by-case basis. Indeed, the presumption is far from determinative, and we have on occasion invalidated patent claims as not having been enabled, despite the PTO's having allowed those claims.



E.g., Genentech, 108 F.3d at 1368. This is another such case. The specification here itself plainly tells us that use of aluminum up to about 10% silicon is not enabled. To conclude, the specification does not enable a significant portion of the subject matter encompassed by the contested claims of the '549 patent, as properly construed. Accordingly, we affirm the district court's judgment of invalidity of those claims on the ground of noncompliance with 35 U.S.C. § 112, ¶ 1.

*AK Steel Corp. v. Sollac*, 344 F.3d 1234, 68 USPQ 2d 1280 (Fed. Cir. 2003)

Thus, as shown by *AK Steel*, AN IMPROPERLY EXAMINED DEPENDENT CLAIM CAN RESULT IN issuance of an INVALID INDEPENDENT CLAIM. Specifically, the independent claims of *AK Steel* appeared valid on their faces, but due to examiner error some of the dependent claims were not substantially enabled. Since the dependent claims were not substantially enabled, it followed logically that their respective independent claims that were presumed broader in scope were likewise not enabled. Consequently, all claims were invalid for lack of enablement. Hence, the strength of the independent claims depends upon the dependent claims and the PTO should thus examine the dependent claims to ensure that the independent claims in an issued patent are not rendered invalid by their dependent claims.

**C. PTO is Mistaken: Current Practices at PTO of Claims Standing or Falling Together are Based on Fact that PTO Bears Burden of Establishing Prima Facie Unpatentability**

As stated above, the PTO's theoretical justification for its proposed limitation of claims to ten is stated as follows: "The Office's current practice for examination of claims in patent applications is less efficient than it could be because it requires an initial patentability examination of every claim in an application, notwithstanding that this effort is wasted when the

patentability of the dependent claims stand or fall together with the independent claim from which they directly or indirectly depend . . . Both the Board of Patent Appeals and Interferences (BPAI) and the courts commonly employ some form of using representative claims to focus and manage issues in a case."

It is true that in patent prosecution, such as in appeals before the BPAI, an applicant will argue the patentability of one or more parent claims and then state that their dependent claims are patentable for at least the reasons why the parent claims are patentable. The reason for this practice is NOT, as the PTO states, because the validity of the dependent claims stands or falls with the independent. Rather it is because, as stated above, a patent should issue unless and until the PTO meets its burden of establishing a prima facie case of unpatentability. That is, unless and until the PTO meets its burden on the underlying claims, there is no duty on the part of an advocate to come forward with anything beyond that of a representative claim. Furthermore, many advocates will state for the record that they do not believe that the PTO has met its duty of establishing a prima facie case of the unpatentability of the dependent claims and that such advocates reserve their rights to argue same at a later date. Hence, the PTO completely misunderstands the rationale underlying the use of representative claims in the appeal and patent prosecution processes. Accordingly, the PTO is dead wrong on its rationale underlying its proposed limitation of examination to ten claims.

### **III. Proposed Rules Purporting to Limit Examination to Ten Examined Claims Will Lower Quality and Result in More Cases Filed**

As referenced herein, the PTO's proposed 37 CFR 1.75 rule is geared toward limiting examination on the merits to only ten claims. The logically obvious consequence of this rule is that such limited examination will LOWER the QUALITY of all non-examined dependent claims as was indicated by the just-discussed case of AK Steel. In addition, it seems likely that applicants, in order to get proper examinations of their inventions, will be forced to file applications that incorporate each secondary feature into its own separately filed application. It also follows that there will be a weakened presumption of validity for non-examined claims, which will likely increase uncertainty regarding the validity of issued patents and a concomitant increase in litigation. There is a strong possibility that advocates will be forced to resort to gamesmanship (e.g., genus, species, Markush-types, system, component, program products, etc.) arising from a contrived selection of features to include in the ten claims.

**IV. Proposed Rules Purporting to Limit Scope of Continuing Applications are in Opposition to Statutory and Case Law in that they Strip the Applicant of Their Rights to Maintain Their Doctrine of Equivalents and/or Avoid Dedication of Subject Matter to the Public**

Proposed Rule 37 CFR 1.114(f) (emphasis added) states as follows:

(f) An applicant may not file more than a single request for continued examination under this section in any application, and may not file any request for continued examination under this section in any continuing application (§ 1.78(a)(1)) other than a divisional application in compliance with § 1.78(d)(1)(ii), unless the request for continued examination also includes a petition accompanied by the fee set forth in § 1.17(f) and a showing to the satisfaction of the Director that the amendment, argument, or evidence could not have been submitted prior to the close of prosecution in the application. Any other proffer of a request for continued examination in an application not on appeal will be treated as a submission under § 1.116. Any other proffer of a request for continued examination in an application on appeal will be treated only as a request to withdraw the appeal.

**A. Proposed Rules Purporting to Limit Scope of Continuing Applications are in Opposition to Law in that they Strip the Applicant of Their Rights to Avoid Dedication of Subject Matter to the Public**

The Federal Circuit has stated that continuing applications may be used to avoid dedication of subject matter to the public, and the PTO has no authority to take away this valuable right by restricting continuation practice. With respect to use of continuations to maintain intellectual property rights the Federal Circuit has stated as follows:

[W]hen a patent drafter discloses but declines to claim subject matter . . . this action dedicates that unclaimed subject matter to the public. Application of the doctrine of equivalents to recapture subject matter deliberately left unclaimed would "conflict with the primacy of the claims in defining the scope of the patentee's exclusive right."

A patentee who inadvertently fails to claim disclosed subject matter, however, is not left without remedy. Within two years from the grant of the original patent, a patentee may file a reissue application and attempt to enlarge the scope of the original claims to include the disclosed but previously unclaimed subject matter. 35 U.S.C. § 251 (2000). In addition, a patentee can file a separate application claiming the disclosed subject matter under 35 U.S.C. § 120 (2000) (allowing filing as a continuation application if filed before all applications in the chain issue). Notably, Johnston took advantage of the latter of the two options by filing two continuation applications that literally claim the relevant subject matter.

*Johnson & Johnston Associates, Inc. v. R.E. Service Co.*, 285 F.3d 1046 (Fed. Cir. 2002)(en banc).

Thus, the Federal Circuit has indicated that filing of a continuing application is a way for the applicant to maintain their claim to broader subject matter of the patent under the patent statutes. A patentee can file a continuation application under 35 U.S.C. § 120 to claim subject matter that is disclosed but not claimed in a pending case. Under the proposed rules, the PTO purports to take away this right by limiting continuation practice. The PTO has no authority to strip the applicant of this valuable patent right, granted under the statutes, and thus the proposed rules limiting continuation practice are in opposition to law and thus should be withdrawn.

**B. Proposed Rules Purporting to Limit Scope of Continuing Applications are in Opposition to Law in that they Strip the Applicant of Their Rights to Maintain Their Doctrine of Equivalents**

The Federal Circuit has stated that continuing applications may be used to maintain doctrine of equivalents, and PTO has no authority to take away this valuable right by restricting continuation practice. As

has been stated by Federal Circuit Judge Rader, continuations are a viable and valuable strategy by which a patentee may maintain their patent rights with respect to the Doctrine of Equivalents:

In response to the demise of the flexible rule [regarding the Doctrine of Equivalents] and the rise of new rules [regarding the Doctrine of Equivalents], an applicant must now avoid amendments, file more and increasingly specific claims (at the risk of prolonging the backlogged prosecution process), resort to less precise functional claims to preserve a statutory equivalent, or perhaps even use continuation strategies to protect claim scope. This court and the Supreme Court necessarily disturbed some settled expectations in the prosecution process, Warner Jenkinson, 520 U.S. at 41 (Ginsburg, J., concurring), to achieve more certainty in the enforcement process. Doctrinal changes in enforcement rules almost invariably affect as well the patent acquisition process.

*Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 344 F.3d 1359 (Fed. Cir. 2003).

As shown, the Federal Circuit has clearly stated that filing a continuing application is a way for the applicant to maintain their claim to broader subject matter of the patent under the Supreme Court's latest guidance regarding Doctrine of Equivalents. As Judge Rader has recognized, under the current rules a patentee can file a continuation application under 35 U.S.C. § 120 in an effort to maintain claims to subject matter under United States Supreme Court precedent regarding Doctrine of Equivalents. Under the proposed rules, the PTO purports to take away this right by limiting continuation practice. The PTO has no authority to strip the applicant of this valuable patent right, granted under the statutes, and thus the proposed rules limiting continuation practice are in opposition to law and should thus be withdrawn.

**V. Proposed Rule 37 CFR § 1.78(f) Purporting to Establish Presumption that Claims in Cross-Referenced Cases are Patentably Indistinct And Requiring An Applicant To Elect Between Rebutting The Presumption, Eliminate Claims, Or Submit A Terminal Disclaimer is in Opposition to Law**

Proposed rule 1.78(f)(2) (emphasis added) states as follows:

(2) If a nonprovisional application has the same filing date as the filing date of one or more other pending or patented nonprovisional applications, taking into account any filing date for which a benefit is sought under title 35, United States Code, names at least one inventor in common with the one or more other pending or patented nonprovisional applications, is owned by the same person, or subject to an obligation of assignment to the same person, and contains substantial overlapping disclosure as the one or more other pending or patented nonprovisional applications, a rebuttable presumption shall exist that the nonprovisional application contains at least one claim that is not patentably distinct from at least one of the claims in the one or more other pending or patented nonprovisional applications. In this situation, the applicant in the nonprovisional application must either: (i) Rebut this presumption by explaining to the satisfaction of the Director how the application contains only claims that are patentably distinct from the claims in each of such other pending applications or patents; or (ii) Submit a terminal disclaimer in accordance with § 1.321(c). In addition, where one or more other pending nonprovisional applications have been identified, the applicant must explain to the satisfaction of the Director why there are two or more pending nonprovisional applications naming at least one inventor in common and owned by the same person, or subject to an obligation of assignment to the same person, which contain patentably indistinct claims.

(3) In the absence of good and sufficient reason for there being two or more pending nonprovisional applications naming at least one inventor in common and owned by the same person, or subject to an obligation of assignment to the same person, which contain patentably indistinct claims, the Office may require elimination of the patentably indistinct claims from all but one of the applications.

**A. Proposed Rule 37 CFR §1.78(f) Purporting to Establish Presumption that Claims in Cross-Referenced Cases are Patentably Indistinct Contrary To Statutory Law**

35 U.S.C. § 131 states that, “[t]he Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefore” (emphasis added). 35 U.S.C. § 132 states, “[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement is made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined” (emphasis added).

Contrary to the patent statutes (and case law as discussed following), the proposed rule changes to 37 C.F.R. § 1.78 establish an automatic rebuttable presumption of double-patenting without requiring the PTO to state any reason for the rejection, objection or requirement to the applicant or applicants. The proposed rule changes to 37 C.F.R. § 1.78 establish this automatic rebuttable presumption of double-patenting for one or more patent applicants merely by the one or more patent applicants filing two or more patent applications on the same day that have a common inventor and/or assignee. The effect of this rule change is to shift the burden of proving patentability onto a patent applicant because, under the proposed rule, the applicant is obligated to overcome the presumption of double-patenting by either showing that the claims are patentably distinct or by filing a terminal disclaimer.



This shift of burden to the applicant is contrary to 35 U.S.C. § 132 (and well-established case law, discussed following) which clearly indicates that a patent application filed by an applicant for patent is presumed patentable until the PTO is able to prove the opposite. Accordingly, the proposed rule is contrary to established statute.

**B. Proposed Rule 37 CFR §1.78(f) Purporting to Establish Presumption that Claims in Cross-Referenced Cases are Patentably Indistinct Contrary To Case Law**

The proposed rules indicate that the automatic rebuttable presumption that a nonprovisional application contains at least one claim that is not patentably distinct from at least one of the claims in the one or more other pending or patented nonprovisional applications can be overcome by filing a terminal disclaimer. This indicates that the rebuttable presumption is based on obviousness-type double patenting as this type of rejection can be overcome with a terminal disclaimer.

Any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. M.P.E.P. § 804 (citing *In re Bratt*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985)). Accordingly, an examiner is required to present a *prima facie* case of obviousness in support of an obviousness-type double patenting rejection before the burden shifts to the applicant to rebut the *prima facie* case (*In re Longi*, 759 F.2d 887, 225 USPQ 645, 651 (Fed. Cir. 1985)). If the examiner does not produce a *prima*

*facie* case, the applicant is under no obligation to submit evidence of nonobviousness. M.P.E.P. § 2142.

**C. Proposed Rule 37 CFR §1.78(f) Creates Undue Burdens and Complexities for Applicant and USPTO**

Proposed Rule §1.78(f)(2) in conjunction with proposed Rule 1.78(f)(3) create a rebuttable presumption that effectively "merges" claims of separately filed applications having at least one common inventor based upon a presumption that the claims are patentably indistinct. These proposed rules also allow the USPTO to eliminate what the USPTO presumes to be patentably indistinct claims from all except one application in the absence of a good and sufficient reason advanced by an applicant. Proposed rule §1.75(b)(4) dovetails with Proposed Rules §1.78(f)(2) and (3), and provides:

If a nonprovisional application contains at least one claim that is patentably indistinct from at least one claim in one or more other nonprovisional applications or patents, and if such one or more other nonprovisional applications or patents and the first nonprovisional application are owned by the same person, or are subject to an obligation of assignment to the same person, and if such patentably indistinct claim has support under the first paragraph of 35 U.S.C. §112 in the earliest of such one or more other nonprovisional applications or patents, the Office may require elimination of the patentably indistinct claims from all but one of the nonprovisional applications.

The USPTO may decide certain claims are patentably indistinct, supported by the earliest of another application, and force an applicant to cancel claims in a later application. In such case, no clear mechanism exists for an applicant to amend the specification of the earliest application to include what the applicant believes to be adequate §112 support. These proposed rules do not provide any avenue for a speedy and economical administrative

relief when the USPTO incorrectly determines claims across several applications are patentably indistinct, or when the USPTO incorrectly determines there is supporting language for a "merged" claim into the remaining application. These proposed rules mistakenly establish another level of complexity under a guise of providing simplicity. These proposed rules will either require more work for the Examiner Corps, or require hiring a lower level of bureaucracy that is unlikely to be able to deal with the complexities inherent in these rules.

The proposed rules create an automatic rebuttable presumption that the applicant has the burden to overcome. This is in direct contrast with established and previously cited case law requiring the USPTO carry the burden of presenting a *prima facie* case that an applicant is not entitled to a patent. Accordingly, the proposed rule as amended directly conflicts with well established case law.

Further, these rules do not provide a readily available mechanism for appeal with respect to USPTO decisions enforcing these rules. Occasionally, the right hand of the USPTO does not know what the left hand is doing. One part of the USPTO could force cancellation of claims from an application as patentably indistinct, and another part of the USPTO could deny an applicant's request to amend the specifications of the remaining application as new matter. This would leave an applicant in an impossible situation where it would be difficult to achieve a satisfactory resolution with an Examiner or any other individual USPTO employee. These rules unsatisfactorily leave an applicant with only the existing, slow, and expensive appeal process. This is a major omission of

these proposed rules rendering them not capable of reasonable implementation.

In addition and/or in the alternative to the foregoing, the proposed rule is ambiguous because it lacks a clear definition for "substantially overlapping disclosures." Such a definition is necessary to allow applicants to determine if the rule as amended applies to one or more pending patent applications.

In addition and/or in the alternative to the foregoing, the proposed rule as amended is ambiguous because it lacks a clear definition for "patentably distinct." Such a definition is necessary to provide applicants with direction.

**VI. Proposed Rule Changes Will Force Advocates Away From Negotiating Compromise With Examiner To Take Allowed Narrower Claims and Toward All-Or-Nothing Multiple-Appeal Style Of Patent Prosecution; Appeals Process Will Become Defacto Continuation Practice**

Under the current rules (unamended), advocates for applicants can cancel non-allowed claims in a pending case to gain issuance of claims that are allowed, and thereafter file a continuing application to continue prosecution of the non-allowed claims. Under the proposed rules that purport to limit continuing applications, this process may no longer be feasible in a large number of cases. Accordingly, practitioners will be forced to file appeals to gain allowance for non-allowed claims as opposed to cancelling the claims from a pending case and refiling the non-allowed claims in a continuation application. This will cause a very large increase in the number of appeals. Since advocates for applicants are typically charged under their respective State Bar rules to vigorously represent

their clients' interests, insofar as that the proposed rules are attempting to limit the number of continuations, advocates will have no choice but to fight tooth and nail on every point and every issue through the appeals process, thereby converting the appeals process to a defacto continuation practice.

Notwithstanding the foregoing, and as described elsewhere herein, it is well established that disclosing but declining or failing to claim subject matter dedicates the unclaimed subject matter to the public and that "application of the doctrine of equivalents to recapture subject matter deliberately left unclaimed would 'conflict with the primacy of the claims in defining the scope of the patentee's exclusive right.'" *Johnson & Johnston Associates, Inc. v. R.E. Service Co.*, 285 F.3d 1046 (Fed. Cir. 2002)(en banc) (quoting *Sage Prods. Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1424, 44 USPQ2d 1103, 1107 (Fed. Cir. 1997) and citing *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 39 USPQ2d 1001 (Fed. Cir. 1996)). Under the current rules, a patentee can file a continuation application under 35 U.S.C. § 120 to claim subject matter that is disclosed but not claimed in a pending case.

As previously described, under the current scheme, it is accepted practice for practitioners to cancel non-allowed claims in a pending case to gain issuance of claims that are allowed and then file a continuation application to continue prosecution of the non-allowed claims. The proposed rules limit continuation practice to filing one continuation application as of right. This practice may place applicants and practitioners in an intractable

position because, in many instances, they will be forced to either dedicate disclosed subject matter to the public or file an appeal. Accordingly, the proposed rules may impose a great hardship on the public, such as less fortunate applicants and small businesses, who may lack the time and financial resources necessary to go through an appeals process in order to obtain patent protection commensurate in scope with their invention.

In addition and/or in the alternative to the foregoing, the proposed changes to 37 C.F.R. § 1.78(f) may cause undue hardship on groups that file large numbers of patent applications that include common inventors or that are assigned to a common assignee. That is, the proposed rule changes impose undue hardship on applicants because their implementation will potentially cause applicants to lose patent rights due to the cancellation and merger of separately patentable subject matter. In addition, the proposed rules force applicants to characterize the scope and nature of their claimed subject matter without reference to cited art in order to avoid merger of separate applications. Such a requirement may cause increased uncertainty in litigation as potential copyists look to see how applicants classify their claimed subject matter in response to PTO inquiries with regard to patentable distinctions among separately pending applications. Such a scenario may cause current patent filers to decrease patent filings and maintain patentable inventions as trade secrets.

For these and other reasons, we the undersigned oppose the proposed rule changes such as those described herein in

their totalities and respectfully ask that they thus be  
withdrawn.

Respectfully submitted this 2nd day of May 2006:

Dale Cook  
Attorney  
PTO Reg. No. 42,434  
3723 N. 34<sup>th</sup>  
Tacoma, WA 98407  
infiniteprogrss@comcast.net

Fred Kaseburg  
Attorney  
PTO Reg. NO. 47,695  
11036 Riviera Place NE  
Seattle, WA 98125  
freddmann@comcast.net

Charles Claunch  
Attorney  
PTO Reg. No. 51,221  
Rockdale, Texas 76567  
cclaunch@earthlink.net

David Romney  
Attorney  
PTO Reg. No. 24,266  
20 Crockett Avenue  
Logan, Utah 84321

Jonathan Olson  
Attorney  
PTO Reg. No. 41,231  
3523 25<sup>th</sup> Avenue SE  
Issaquah, WA 98029  
jonathan\_e\_olson@hotmail.com

Leif Stordal  
Attorney  
PTO Reg. No. 46,251  
Kirkland, WA 98033  
lfstordal@yahoo.com

Glenn Foster  
Attorney  
PTO Reg. No. 32,676  
14204 SE 79<sup>th</sup> Drive  
Newcastle, WA 98059  
gbfoster888@msn.com

Corrie Vaa  
Agent  
PTO Reg. No. 56,595  
421 30<sup>th</sup> Avenue East  
Seattle, WA 98112  
corrievaa@yahoo.com

R. Alan Burnett  
Attorney  
PTO Reg. No. 46,149  
Bellevue, WA 98006  
ralanburnett@hotmail.com

Margaret M. Anderson  
Attorney  
PTO Reg. No. 44,182  
Austin, TX 78759

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