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From: Derek Freyberg [mailto:dfreyberg@telik.com]
Sent: Wednesday, May 03, 2006 8:27 PM
To: AB93Comments; AB94Comments
Subject: Comments of Derek P. Freyberg on the Notices of Proposed Rulemaking

I enclose my comments in response to the Notices of Proposed Rulemaking at 71 FR 48 and 71 FR 61.

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3 May 2006

By e-mail

The Honorable Jon W. Dudas
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Mail Stop Comments
P. O. Box 1450
Alexandria, VA 22313-1450

Re: Comments on Proposed Rules:
"Changes to Practice for Continuing Applications, Requests for Continued Examination
Practice, and Applications Containing Patentably Indistinct Claims", 71 Fed. Reg. 48;
and
"Changes to Practice for the Examination of Claims in Patent Applications",
71 Fed. Reg. 61

Dear Under Secretary Dudas:

I write to comment on the U.S. Patent & Trademark Office ("Office") proposed rules.

By way of background, I am presently the in-house patent counsel at Telik, Inc., a biopharmaceutical company of 180 employees in Palo Alto, California, developing drugs to treat cancer. I have more than 25 years' practice as a patent agent and attorney at a specialty manufacturing company, a major oil company, and a major pharmaceutical company, and as a special counsel and shareholder at a major law firm. The views I express here are my own and not those of Telik.

The systems in the Office ("compact prosecution" and the examiner productivity compensation scheme) encourage examiners to make multi-way restriction requirements, to make Office Actions final, and to refuse entry of after-final amendments, all often inappropriately under the controlling statute and rules.

Applicants' "solution" to inappropriate restriction requirements largely has been to file divisional applications, not to petition – better to move forward and prosecute claims in a divisional than waste energy on the petition and time waiting for it to be decided, especially in this post-URAA world. Similarly, applicants' "solution" to inappropriate final rejections and refusals of after-final amendments largely has been to file continuations or, more commonly, RCEs – all too often the examiner will allow the application when the RCE is filed, so why petition or appeal unless he/she won't? I believe that this is the source of the vast majority of the continuing or "rework" applications complained of in the Notices of Proposed Rulemaking.

What the Office is proposing now, though, will penalize applicants who have gone along with the Office's system, and force applicants to contest restriction requirements, finality, and non-

entry of post-final amendments, and appeal final rejections in a way that is surely not conducive to an efficiently operating patent system.

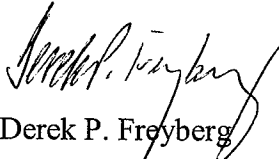
I hope that the proposed rules, if adopted, with the possible exception of changes in Markush practice, would have limited effect on many of the cases I handle. When a patent applicant knows what aspect of an application is of greatest value (certainly not always knowable at time of filing), and the examiner handling the application conducts a good search and cites the best art in the first Office Action, prosecution tends to proceed rapidly. I do not often file continuation applications or RCEs; and, like most practitioners, I prefer RCEs to continuations because they maintain focused prosecution – I don't want the examiner to start over, I want him/her to consider my amended claims and argument in light of the experience he/she and I have already gained by our previous exchange. I don't believe in filing CIPs if they can be avoided; because if the new claims find support only in newly added disclosure, the priority assertion as to these new claims has no value and I have given away patent term by making it.

However, I do not know which if any of the applications that I handle and may handle in the future will not fit nicely into this new world, and how valuable any of these applications may be to my client, and so I will be forced to prosecute applications in ways that will vastly increase the burden to the Office as well as to me. For example, in an application covering new compounds, I may not yet know which compound will be of greatest interest, and if I am faced with an arguably improper restriction requirement and a schema in which all divisionals must be filed during pendency of the parent, surely I must petition the restriction requirement and must file all divisionals to avoid the risk of losing the one that matters. If I am permitted only one continuation or RCE, surely I must petition any arguably improper final rejection or denial of after-final amendment, and must appeal that final rejection, before I use up my one chance to reopen prosecution. This cannot be an efficient use of Office resources.

I believe that a scheme in which the standard for restriction is truly "independent and distinct" as mandated by statute, and in which applicants and examiners are given full opportunity (and examiners fair reward) to advance prosecution of applications – through as many non-final office actions as necessary so long as there is a *bona fide* attempt to advance prosecution – to allowance or a final rejection that will not require re-opening and will withstand appeal is a scheme that will benefit the Office, applicants, and the public. These proposed rules are not such a scheme.

I respectfully urge that the proposed rules be withdrawn and reconsidered in light of the concerns expressed by the AIPLA and such eloquent commentators as Samson Helfgott, Ted Apple, and Anonymous [Anonymous, "Major USPTO Prosecution Proposals for Spring 2006", found at http://patentlaw.typepad.com/patent/Major_20USPTO_20Prosecution_20Proposals_1.doc]; and that the Office engage with the patent Bar to clearly identify the problems experienced by the Office and propose solutions and rules more carefully tailored to address them in a way that does not impinge so drastically on the rights of inventors to seek patents for their inventions.

Sincerely,



Derek P. Freyberg