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Attached are my comments to this proposed rulemaking.

These are my personal opinions and are not those of my company.

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Comments on PTO Proposed Rulemakings Regarding
Changes in Continuation Practice
And
Changes in Examination of Claims

General Thoughts

The proposed rules shift the burden for the PTO's backlog from the PTO to the users of the system. The PTO wants you to believe that the causes of the backlog lie with applicants and their attorneys. This is what the PTO's road show is all about. Yet the PTO fails to address its own causes for this backlog.

Right now the PTO is on a "quality" kick. Quality to the PTO means make sure fewer patents issue. It does NOT mean make sure you don't reject applications that should be allowed. There is no "quality review" of a percentage of abandoned applications to see if they should have been issued. The examiners got the message and are making it increasingly difficult on applicants. This only leads to longer prosecutions, increased numbers of continuing applications and an increased backlog.

In another area solely under the PTO's control, the PTO gives lip service to its activities in examiner hiring and retention, but the numbers show how poor its efforts are. Why does the PTO have so much trouble keeping its examiners when we never hear of such problems at the JPO or the EPO?

More importantly, the PTO refuses to address the 800 pound gorilla; PAPA. Until the PTO is willing to take a hard-nose position that examiner efficiency must increase (i.e. hours per balanced disposal be reduced) due to the advances in search capabilities and the fluff built into the examiner production quotas, the PTO will never reach an efficiency level necessary to meet the users' needs down the road. As a former examiner I know how easy it was to meet quotas while studying for law school at the same time. Under law, PAPA cannot strike. The PTO should force productivity increases or it's time for dealing with the examiners like Reagan dealt with the air traffic controllers. There might be some additional defections among junior examiners in the short term, but what else can a 10+ year primary examiner with no experience actually writing applications and amendments do?

It also appears that the PTO does not read, or at least does not care about, CAFC decisions and why applicants and their attorneys act as they do in prosecution. The CAFC's position on file wrapper estoppel is the equivalent to the Miranda warning "anything you say can and will be used against you in a court of law." Applicants and their attorneys are taught to put as little into the file history as possible while still getting the case allowed. The PTO, through proposed rules limiting continuation practice to try to force as much information

out of applicants as early as possible and requiring expanded prior art discourses, is trying to build up a record in support of its action. The poor applicant is stuck in the middle, with no good option.

Finally, it is not understood how these two rulemakings mesh. On one hand, the PTO wants all claims of interrelated cases presented in a single case. On the other hand, the PTO wants only 10 representative claims to examine. It appears that the PTO is just asking for less work.

Rule 78

Any rule that takes over three pages in the Federal Register is inherently flawed. The rule tries to capture and prohibit any scenario that would allow applicants to get more than two bites at the apple for a given claim without a petition and (surprise!!!) an additional fee. Even worse, there is no assurance that the newly filed application and petition will be granted, so all those fees may be for nothing.

The whole basis for this rule change is to force applicants to present all possible arguments and evidence for patentability as early in the prosecution as the PTO thinks it can get away with. The current practice of addressing each rejection with only enough evidence to overcome the rejection would now work in favor of the examiner, who could reject you out of continuations, forcing applicants to overload with evidence to overcome rejections not yet made. I again note my above comments on what this does to file wrapper estoppel.

Especially troubling are the requirements of proposed Rule 78(f). By what right should the PTO presume that two applications filed by a given inventor contain overlapping subject matter until the inventor proves otherwise, just because the filing dates happen to be within two months of each other, as in proposed Rule 78(f)(2)? How can a corporate assignee that files many cases with different law firms and different in-house counsel responsible for different cases possibly keep track of its filings in the manner necessary to provide the information required by proposed Rule 78(f)(1)?

Rule 75

If applicants are willing to pay the claims fees, they are entitled to an examination of the claims, and should not have to do the examination for the PTO to get the claims examined. Once again, I note the file wrapper estoppel issues raised by the requirements of this rule and the case law that has developed since the PTO last required “prior art statements”. If the PTO believes it does not receive sufficient revenue under its current fee structure, raise the claim fees until it is satisfied (assuming, or course, that the PTO gets to keep the fees and do something useful for inventors with them).

Perhaps the PTO does not understand why applicants need to file many claims. The CAFC decisions on unclaimed subject matter, limitations on doctrine of equivalence for amended claims, and the need for claims of varying scope to protect against undiscovered prior art in litigation require more than ten representative claims to properly protect an important invention. An attorney could be accused of malpractice for failing to present all possible claims.

Further, under this proposal the PTO may actually extend prosecution. Many times an examiner will indicate that claim X would be allowable if put in independent form. If claim X is claim 11 or more, that claim may never be examined and what could have been an allowable application winds up in an appeal, or worse, a CONTINUING APPLICATION to add the subject matter of this unexamined claim into the “representative” claims.

One point that is either not covered by the proposed rule, or that I have missed. If I elect claims 1-10 as representative and receive a rejection, can I add subject matter of claims 11+ into claims 1-10 in an amendment for allowance of these claims, or will the examiner refuse entry of such an amendment as “requiring additional search” or other such rational. Bottom line: under this proposed rule, is an amendment to a claim after non-final office action still open to ANY changes, or will the changes have to conform to the representative claims subject matter alone?