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From: Dan Polley [mailto:Dan@Danpolley.com]

Sent: Tuesday, February 14, 2006 1:03 PM

To: Strategic Planning1

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Subject: Comments to proposed changes in Patent Prosecution process and TTAB rule changes

Hello:

Here are my brief comments with respect to proposed changes to the patent prosecution process and TTAB rule changes:

PATENT

1. The proposed revision to the current continuation practice conflicts with the proposed changes to the number of claims:

By limiting the number of continuation applications that will be permitted, the PTO is effectively requiring the applicant to increase the amount of claims in the original application to ensure that everything that is considered novel is covered by claims in the original application, as the number of continuations may be severely limited. However, the proposed changes to the number of claims conflicts with the need to increase the number of claims in the original application. Though, I do not believe either change is needed, instituting both revisions will seriously affect the ability of an inventor to obtain full patent claim coverage for all novel aspects of the invention.

2. The proposed revisions to the current continuation practice will significantly and negatively affect the patentee in view of the Festo decision:

In view of the Festo decision, claims are not automatically amended upon receipt of an Office Action. Often, arguments are only first presented and sometimes the claims are only slightly amended with each response so not to have or raise any unnecessary Festo estoppel issues. To accomplish this strategy, more than one continuation or RCE is often required. The proposed revision would defeat this strategy, thus causing the claims to be significantly narrowed from the issuance of the first office action and quite possibly reducing the amount of claim coverage an applicant could have obtained for the invention. Thus, the patent is worth less, easier to design around and the whole patent system suffers as a result.

3. The current pendency of some applications is in view of the issuance of Non-Compliant Notices for significantly minor and harmless errors:

Some applications are pending longer than necessary in view of the issuance of Non-Compliant Notices for trivial matters. For example, a recent response I submitted had numerous pages of claim amendments. Of all these pages of amendments, two words were inadvertently not underlined. As such, I receive a Non-Compliant Notice to underline these two words. This will result in the examination of the response on the merits and keep the application pending an additional two to three months. Was this Notice necessary? Is the increase in pendency of this application justified? Changing PTO policy on when to send a Non-Compliant notice will help to decrease pendency of many applications.

TRADEMARK

1. Petitioner's service requirement for a Petition to Cancel:

I believe the requirement of service by the Petitioner itself can create an undue burden on the Petitioner in certain instances. Where a Registrant has gone out of business or fails to inform

the Trademark Office of its current address, it should not be the extra responsibility and costs of the Petitioner to try to find the party. The consequence should be on the Registrant. Additionally, if the Registrant is out of business and unavailable then most likely there is nobody to serve. In this scenario, all of these extra steps required on the Petitioner, only cause the abandoned mark and invalid registration to remain pending for a longer period of time, all to the detriment of the Petitioner and the Petitioner's rights.

2. Service of a Notice of Opposition:

Where the mark is involved in an Opposition, there is a much better chance that the Applicant is still in business and/or at the address listed at the time of filing. However, rather than requiring a formal service of process of a Notice of Opposition, the filing of an application can be revised to make the Applicant or its legal representative obligated to accept a Notice of Opposition by certified mail (i.e. Fed Ex, UPS, DHL, Registered Mail, etc.). The Opposer can then file proof of receipt with the TTAB.

I hope the above comments are helpful.

Sincerely,

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