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General Comment:I am responding to your Notice of Proposed Rulemaking published January 3, 2006,
71 Federal Register 48.

I am an inventor having claimed small entity status. With all due respect, I believe the agency has significantly underestimated the impact of this proposed rulemaking on small businesses. The reasons apparently presented by the agency for this claim are that the number of continuation applications received from small entities in 2005 number in ?only? the tens of thousands.

The impact on those tens of thousands each year in the past and in the future would be devastating and the changes would be felt far more severely by small businesses than by larger businesses.

The proposed rulemaking makes reference to Patent Office fees required in an apparent effort to show that these fees will not severely impact small businesses. But, the Patent Office fees are just a tiny fraction (indeed, less than the tip of the iceberg) of the impact on small businesses. The far greater costs are the legal fees and time commitments that the rules changes would impose. It is clear to me that the new rules would require a far greater expenditure of time and money very early in the patent prosecution process. Attaining the right claims ? claims specific enough to be justified by the inventor?s novel disclosure but general enough to capture everything that is novel ? is a daunting process. There is far less room for error or uncertainty given the far more limited ability to seek continuations. This puts much greater emphasis on the input of top notch (and top cost) legal advice early on in the process. It is simply unrealistic to assume that an inventor could realistically attain the strongest justifiable claims either through the inventor?s own drafting or by relying on the PTO to draft claims for the inventor. As a pragmatic matter, the proposed rules would require that the inventor navigate this daunting process with a much greater commitment of time and money upfront.

Big businesses have the luxury of deep pockets to finance huge legal fee budgets. Also, the immediate time cost of keeping inventors involved in the application process (in order to clearly, solidly, and extensively establish all the possible claims that the inventor could be allowed) can be much more easily absorbed by big business. Small businesses and solo inventors do not have this luxury. Currently, small inventors might submit a specification with claims that just don?t properly capture the essence of their invention ? the claims might be too broad to be justified upon close inspection and/or too narrow to give the strength justified by the inventor?s description of the invention. The process of deriving the appropriate claims can be long and complex. Under current rules, if a small inventor is able to devote only little (if any) funds to high-priced legal talent, the prospect of continuations allows the inventor to make attempts at capturing the right claims while also giving further time to further commercialize the invention in order to raise additional funds to complete the patent process. These smaller entities would now be hit with a double blow ? not only will they need far more money for legal fees upfront, they will also be required to put much greater time into the patent prosecution early on, taking them away from the process of actually trying to commercialize their invention. This double blow could easily preclude many small inventors from seeking or continuing the prosecution of patents and without this crucial patent protection, the invention may never be commercialized. Inventions and patents will become even more something that only big businesses can afford to entertain.

As a case in point, I will this week be submitting a non-provisional utility patent application, having submitted a provisional application almost a year ago. In that interim period of time, I have been attempting to further develop my technology, making it into an actual commercial product, while also trying to sell the product. I could find myself competing against huge, multi-billion dollar companies once knowledge of my invention becomes known. I am simply not

in a position to change my strategy in order to devote the tens of thousands of dollars (or more) that would be needed to seek the best claims that I would reasonably be entitled to. I will make an attempt to draft claims that, based on what I know, are appropriate to what I have disclosed. But, I know the limitations of my own ability in this regard. I have taken some solace in the thought that if I don?t get it right, I am not precluded from eventually getting the patent rights that I am entitled to. I of course realize that the longer the delay in getting claims allowed the shorter the effective term of the patent rights granted. This is a tradeoff I am compelled to face. I am deeply concerned that if the proposed rules are finalized and I cannot commercialize the invention quickly enough, then I will be forever precluded from receiving whatever patent rights I am entitled to and, therefore, the big companies will w in.

I should further note that while the proposed rules would severely harm small inventors in general, those rules would be particularly harmful to the small inventors, like myself, that did not have the opportunity to factor in the proposed changes in developing a strategy for commercializing their inventions. These inventors would now be forced to scramble to find the money and devote the additional time to seek appropriate patent protection quickly. For many of us, we will simply not be able to do so and our dreams will be lost.

I would urge you to either drop your proposed changes or, alternatively, to revise your proposals to lessen the blow. One possibility would be to exempt small entities from the proposed changes. If the agency believes that the proposed changes would have a minor impact on small entities because these entities do not seek many continuations, then granting an exemption to those small entities that do seek continuations should not have much impact on what the agency is seeking to accomplish. Another possibility would be craft a financial hardship exemption from the proposed rule changes. While such an exemption could create a further level of administrative complication (and uncertainty), safe harbors could be created for such an exemption (e.g., the hardship is automatically allowed for entities with less than 5 employees or for small entities with less than $1,000,000 of assets or revenues). A further possibility would exempt small entities from the proposed changes for applications filed prior to the time that the rules become final (i.e., a grandfather clause). This would almost entirely eliminate the unfair burden that arises due to the lack of opportunity to plan for the new rules. And, in time, these applications would be removed from the system. At a minimum, I would urge that you allow present applications some minimum period of time (e.g., at least five years from the time that the rules become final) before the ability to seek continuations is limited. While this possibility stops short of adequately addressing the severe impact of the proposals, it would at least give small inventors some time to plan, budget and adjust to the changes.

Respectfully submitted,

Walter Antognini
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