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From: William B. Slate [mailto:slatew@bachlap.com]
Sent: Wednesday, May 03, 2006 3:54 PM
To: AB93Comments; AB94Comments
Subject: Comments by Bachman & LaPointe, P.C.

The attached .pdf file contains the comments of Bachman & LaPointe, P.C. to the following notices:

Notice of proposed rule making: Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims, Docket No.: 2005–P–066 71 Fed. Reg. 48 (03 January 2006)

Notice of proposed rule making: Changes to Practice for the Examination of Claims in Patent Applications, Docket No.: 2005–P–067 71 Fed. Reg. 61 (03 January 2006)

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May 3, 2006

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Re: Notice of proposed rule making: Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims, Docket No.: 2005–P–066 71 Fed. Reg. 48 (03 January 2006)

Notice of proposed rule making: Changes to Practice for the Examination of Claims in Patent Applications, Docket No.: 2005–P–067 71 Fed. Reg. 61 (03 January 2006)

Dear Sirs:

BACKGROUND

Bachman & LaPointe, P.C. (the firm) is an Intellectual Property boutique firm in New Haven, Connecticut. The firm submits the following comments regarding these two proposed rule packages (for brevity hereafter, "the continuing applications package" and "the claims package"). The comments are submitted in a single document because a reasonable analysis of the effects of each package can only be made in the context of the other.

The firm has six attorneys, all registered to practice before the U.S. Patent and Trademark Office (the PTO/the Office). The firm has a diverse patent practice representing both domestic and

foreign clients and large and small entities. The firm has recently averaged approximately 200 patents issued per year, making the firm the largest patent practice in the New Haven area as so measured. PTO records for 2005 show this to exceed the number of patents issued for the four law firms whose template-based, pro-package, comments, were initially posted.[1]

SUMMARY

The firm believes the packages would be both disadvantageous to patent applicants, generally, and the relationships between such applicants and their patent practitioner representatives. The packages are ill-advised attempts to mask systemic problems in the Office's examination of applications by scapegoating patent applicants and utterly devastating patent practice before the PTO. The packages appear to have been created without the slightest reference to any realities of patent prosecution and the relationships between practitioners and their clients.

The two packages will have a particularly egregious synergy. The convenient bifurcation of the packages (rather than presenting the changes in a single package) allowed the Office to effectively ignore this synergy in its published analyses, thereby further deceptively under-predicting the effects. On the one hand, the claims package greatly limits the ability of applicants to present issues at a given time. On the other hand, the continuing applications package limits serial consideration. The latter, in turn, includes what is, in effect, an impossibility standard for presenting further amendments, arguments, or evidence. Applicants are provided no relief for situations in which, although the impossibility standard is not satisfied, the applicants could not reasonably have been expected to have acted otherwise or, at least, have *bona fide* reasons for acting in the ways they did.

Increased costs inescapably caused by the packages would be both a burden and a source of tension. The increased stakes at every stage in the process may potentially turn every actual or hindsight-perceived departure from perfection into a grievance. Private practitioners would be forced to engage in practices akin to defensive medicine, thereby driving up costs and increasing tensions both between practitioners and the Office and between practitioners and their clients.

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[1] Specifically, the Office posted comments from Caven & Aghevli LLC, Grossman, Tucker, Perreault & Pfleger, PLLC, Kacvinsky LLC, and LeMoine Patent Services, PLLC. All four comments clearly arise from a common template. All four firms appear to have received this template from a common client, Intel Corporation.

THE CONTINUING APPLICATIONS PACKAGE

The focus of the continuing applications package is to limit applicants to a single continuation, continuation-in-part (CIP), or request for continued examination (RCE) after filing an original application. Other provisions largely appear directed to closing off perceived loopholes to such limit and, thus, do not require separate discussion.

The Office has proposed a draconian impossibility standard for permitting a filing beyond the limit. Applicants must show "that the amendment, argument, or evidence could not have been submitted" previously. Applicants have no opportunity to submit reasons for the submission of an otherwise barred filing. Applicants only have the opportunity to demonstrate the impossibility of the amendment, argument, or evidence having been previously submitted. An applicant's actual reasons for submitting the amendment/argument/evidence are irrelevant, no matter how reasonable. For example, if the amendment, etc. is in response to an examiner's claim interpretation that could not reasonably have been expected, the applicant is still out of luck.[2]

At page 48, in the paragraph spanning cols. 2 & 3, it was asserted that "each continued examination filing…requires the" Office "to delay taking up a new application and thus contributes to the backlog of unexamined applications before the Office." This gives the false impression of a 1:1 correspondence between continued examination filings and new applications. Experience indicates that the overwhelming number of RCE filings appear to require little more than a rubber stamp action by the examiner. The implementation of the RCE has largely killed after-final practice and has led to count-fishing by examiners. Similarly, for continuation and CIP filings (at least those that are not equivalent to voluntary divisionals), there will be a substantial economy of scale. For example, if truly patentably indistinct, there would be no or little further searching required.

In that same paragraph, it was asserted that each filing "becomes less beneficial and suffers from diminishing returns…" There is no support for this. Due to gaming of the system by examiners, poor examiner English language skills, poor examiner art familiarity, and other factors, often the marginal return of early steps in prosecution is low. Once one has cut through these problems, the further filings may actually have a high return.

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[2] Question answer from Robert J. Spar, Director, Office of Patent Legal Administration, at the March 29, 2006 meeting of the Connecticut Intellectual Property Law Association.

Finally, the reference in that paragraph to the public notice function is also dubious. Especially when restrictions on continuing applications are combined with limits on the number of claims, the result may be a proliferation of gray areas of infringement and validity that might otherwise have been resolved by more claims and further continuations. These gray areas would not improve fulfillment of the public notice function. This is discussed further below.

At page 48, col. 3, first full paragraph, and repeated later, the Office asserts that it "is making every effort to become more efficient…" However, the Office has not articulated any efforts to reform their own examination practices insofar as those practices may be contributing to the filing of continuing applications and, especially, RCEs.

In that same paragraph, the Office asserts that the restrictions "will make the exchange between examiners and applicants more efficient and effective." This is wrong. The restrictions will raise the stakes of each stage of the prosecution process. If anything, each stage will become more complicated and more contentious.

It was further asserted that the "revised rules should also improve the quality of issued patents, making them easier to evaluate, enforce, and litigate." However, this is by no means clear. For example, continuing applications are often used to obtain claims that do not suffer from possible invalidity and non-infringement arguments from which a first application or its resulting patent suffer. In such a situation, the patent issued from the continuing application may be very clear as to validity and infringement by an accused product. Thus, by precluding such continuing applications, the present rules would have the effect of forcing unneeded litigation of validity and noninfringement issues relating to the first patent.

The discussion of the burden of examination of applications with "patentably indistinct claims" in the second full paragraph and repeated later is largely a canard. In reality, a large number of applications that are presently identified as continuations will become divisionals under the proposed rules. This is because examiners tend to use very different standards in: (a) issuing restriction requirements; and (b) issuing double patenting rejections. Whereas two nearly identical independent claims (whether of the same type or different types) presented at filing can often be the subject of a restriction requirement, two very different claims presented in two different applications (whether two unrelated applications or an original and a continuing application) will often be subject to a double patenting rejection. Applicants will adapt to the revised rules by presenting a large

number of claims initially so as to draw a manifold restriction requirement so that further applications may be filed as involuntary divisionals.

In the first paragraph of page 49, it was asserted that the revised system would run "without any additional work on the applicant's part." This is clearly wrong. An extraordinary level of work will be required to present all possible claims, amendments, evidence and arguments at each stage. This would involve having to anticipate every position the examiner might take, whether reasonable or unreasonable. Applicants would be required to petition against every procedural failing by examiners so as to best preserve each bite at the apple. Appeals would also increase dramatically.

In the second column, the Office asserts "a crippling effect" of "continued examination". Such conclusory statements could be made (often more accurately) by inserting any other semi-randomly chosen noun in place of "continued examination". In many situations poor examination quality has lead to a proliferation of non-final actions. Examination quality issues are also responsible for a large number of the continued examination filings (especially RCEs).[3]

Later in that second column, in support of the package, the Office invokes "[c]ommentators" generally, and Lemley and Moore, specifically. In their cited article[4], Lemley and Moore propose the one continuation limit. Nothing of record indicates that these commentators are in any way authoritative on this issue. Neither of these commentators is even registered to practice. This emphasizes the Office's utter disregard for prosecution realities in proposing the rules packages.

On pages 49-51, it appears that the Office is bootstrapping an asserted authority to limit conduct that is not "a *bona fide* attempt to claim the applicant's invention" into the authority to ban even *bona fide* attempts that fail to meet an impossibility standard. This along with denials of setting "a *per se* limit on the number of continuing applications" would be laughable if involving less serious subject matter. The impossibility standard has the substantial effect of a *per se* limit.

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[3] Personal experience suggests that a general decline in examination quality has several manifestations, often greatly differing. The increase in non-final actions among some examiners does not evidence extreme gaming of the system. If any gaming is present there, it is usually manifested in a cursory first action preceding later non-final actions. Extreme gaming occurs when a cursory first action is followed by an action made final. For example, examiners often sandbag details of interpretation, presenting them only in an action made final after the applicant responds to a first action. Any clarifying amendment then introduced (no matter how trivial and often merely reaffirming that a claim term is used in its ordinary sense and not in some hyperextended sense) will be denied entry as raising a new issue. An RCE is then required to have the amendment considered (often in a rubber stamp operation).

[4] Mark A. Lemley and Kimberly A. Moore, *Ending Abuse of Patent Continuations*, 84 B.U. L. Rev. 63 (2004)

On page 50, the Office engages in more of the abuse of statistics characteristic of the two packages. This includes the unsupported assertion of a 1:1 correspondence between the effort involved in handling continued examination filings and that involved in examining new applications.

Starting with the first full paragraph of col. 1 on page 52, the Office discusses application types and takes a very narrow view, reflecting ignorance of the scope of 35 U.S.C. 120. For example, the Office has failed to consider that 35 U.S.C. 120 permits a situation wherein an application is in effect, if not name, both a divisional application and a continuation-in-part. For example, an original application may have claims to first and second inventions and the first may be elected responsive to a restriction requirement. A continuing application may be filed to present the second group of claims. Thus, the continuing application is a divisional application. The continuing application may, however, add new matter and even claim such new matter. For example, the new matter might be an additional species of the second invention. The continuing application might present dependent claims to that species. Other examples may be found in William B. Slate, *The Real Security of Continuation-in-Part Applications*, 83 J. PAT. & TRADEMARK OFF. SOC'Y 551 (2001). Such a situation is clearly contemplated by 35 U.S.C. 121 which reads "…If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing…" Thus, Congress has: (1) clearly provided for divisional-CIP hybrids, generally; and (2) actually used the designation of "divisional application" for at least some such situations (e.g., this seems most appropriate in the new species situation). Any rule or practice to the contrary is void.

Furthermore, by designating all divisional-CIP hybrids as CIPs rather than as divisionals, the PTO removes the applications from the safe harbor created by the original restriction requirement. This may, for example, induce an applicant to file both a pure divisional application and a new original application to the new matter rather than file a divisional with new matter. This is hardly an efficient situation. Applicants will also be barred from filing such hybrids for any of many other valid reasons.

Starting in the third column of page 56, the Office continues down the road of statistical abuse in its Rule Making Considerations. It reports an FY2005 total filing of 317,000 applications, but does not there report the number of those filings which were by small entities. This draws into question all subsequent assertions of no disproportionate impact on small entities. That number is later reported as

93,000 which we note is 29.3%. This appears consistent with a previously reported percentage of about 28% by small entities.[5]

In the first full paragraph of page 57, the Office asserts that the "proposed rule change [regarding continuations and CIPs] will not affect a substantial number of small entities." It also asserts that the "proposed change would not disproportionately impact small entity applicants." Similar statements are made regarding the restrictions on RCEs and other asserted patentably indistinct filings. The Office has not adequately supported these assertions.

First, the Office selectively and misleadingly cited separate numbers for each of several situations rather than citing combined numbers. Second, the Office failed to identify at least one highly relevant situation. Third, the Office failed to consider the combined impacts of the claims and continuing applications packages. Fourth, the actual statistics do not bear out at least some of the Office's assertions of proportionality. Fifth, there is an inherent conflict between the predictions of not affecting substantial numbers of applicants (whether small entity or not) and the assertion that the conduct sought to be restricted has substantially contributed to any examination backlog.

Regarding the first, the Office individually cited statistics regarding the number of situations in which there are: (a) more than one continuation or continuation-in-part (first paragraph of col. 1); (b) more than one RCE (first paragraph of col. 2); and (c) patentably indistinct claims (paragraph spanning cols. 2 and 3). The Office failed to identify the total percentage of situations in which there was at least one of those situations.

Regarding the second, the Office also failed to identify the number of situations in which there were bothone RCE and one continuation or C-I-P.

Regarding the third, the Office failed to consider the impact of the claims package. For example, had the claims package been independently implemented sufficiently prior to FY2005, it presumably would have greatly increased the number of FY2005 RCEs, continuations, and continuations-in-part. Thus, the Office uses an incorrect baseline.

Regarding the fourth, of applications designated continuations or CIPs, 35.2% were by small entities. Of those which were a second or subsequent such filing, 37.9% were by small entities. When

[5] GAO-04-603 Patents: Information about the Publication Provisions of the American Inventors Protection Act, page 10 (reporting filings 11/29/2000-11/29/2003) http://www.gao.gov/new.items/d04603.pdf

contrasted with the 29.3% overall figure, that clearly is disproportionate impact on small entities. The terminal disclaimer and multiple RCE statistics, however, do favor large entities.

Regarding the fifth, the Office has not substantiated how an asserted insubstantial number of situations contribute substantially to the Office's examination backlog (let alone substantiated that these situations are so disproportionately responsible for the backlog as to merit the scornful approach taken by the Office). This tends to highlight the scapegoating nature of the proposals. Some commentors will offer compromise for compromise's sake in the form of raising the allowed number or imposing progressive fees for further filings. There is no legitimate basis for such compromise. By further decreasing the number of affected applications, the effects on backlog will be reduced to triviality. However, applicants with *bona fide* reasons for further filing will be punished merely for the sake of allowing the Office to punish someone. A trivial effect on backlog may be associated with a major disruptive effect on prosecution practice. For example, if only one in 200 applications were barred, the Office would show imperceptible direct backlog benefit. Nevertheless, that one case might represent one malpractice claim per year for a modest size prosecution practice. Defensive prosecution costs (along the lines of defensive medicine) would be incurred by applicants in the 199 others as well. The effects of defensive prosecution might well increase the examination burden on the Office.

In that same first paragraph of col. 1 and repeated later, the Office asserted that "[t]he primary impact of this change would be to require applicants to make a *bona fide* attempt to advance the application to final agency action by submitting any desired amendment, argument, or evidence prior to the close of prosecution after a single continuation or continuation-in-part application or single request for continued examination…" This is another falsity. The impossibility standard for further RCEs, continuations, and CIPs will require far more than a *bona fide* attempt. It will require a Herculean attempt to anticipate every hypothetical piece of art or examiner interpretation, whether reasonable or not.

THE CLAIMS PACKAGE

At page 61, the office asserts that "[t]he changes proposed in this notice will allow the Office to do a better, more thorough and reliable examination since the number of claims receiving initial examination will be at a level which can be more effectively and efficiently evaluated by an

examiner." To the contrary, the changes will tend to decrease efficiency by causing a piecemeal prosecution in that the impact of vagaries of interpretation are increased and the chances of getting an early indication of allowable subject matter are reduced.

The page 62 analogy to grouping of claims on appeal is wrong. First, at the time of appeal, the Applicant/Appellant already possesses all the prior art which will be considered in the appeal. Second, the Applicant/Appellant also already possesses the examiner's interpretation of such art in applying such art to the claims. Thus, for example, in the appeal situation, a cited 35 U.S.C. 102 reference may clearly possess the added elements of a dependent claim. In such a situation, the Applicant/Appellant has no qualms about grouping that dependent claim along with its base and/or intervening claim when Applicant/Appellant contests the presence in the reference of an element of such base and/or intervening claim. The Applicant has neither such luxury in the pre-examination identification of representative claims. Even a well-known added element of a dependent claim might not be found in and might not be obvious to combine with a reference cited against the intervening and/or base claim(s). This might especially be the case where the cited reference is a non-analogous, yet anticipatory reference. It may also be the case where the examiner reads out certain elements of the base and/or intervening claim (e.g., on grounds of mere statements of intended use, functional limitations in an apparatus claim, apparatus limitations in a functional claim, and the like).

Additionally, the analogy ignores a simple fact that the BPAI practice is a rare one, only occurring when there is an appeal. The aggregate burden of imposing a similar practice on all applications is substantial.

Additionally, the proposed practice is relatively unduly restrictive. The BPAI practice does not contain any arbitrary limit on the groupings. The proposed practice contemplates a highly restrictive quantity. The identified number in the present practice is misleading when compared to BPAI groupings. Quite a number of independent claims might be properly grouped together under the BPAI practice (for example: various combinations of structural and means plus function analogues; various combination of apparatus, method of manufacture, and method of use claims; and various combinations of different target infringers (e.g., when different independent method claims in an e-commerce application are written from the points of view of a vendor, a consumer, and an intermediary, respectively)). The presence of different such independent claims which might be

expected to stand or fall together in a BPAI context, however, detracts from the ability to designate even substantial dependent claims in the proposed practice.

The page 63, first paragraph, analogy to the number of cases on which an Appeal Brief was filed having more than ten representative claims is again misleading. As noted above, at the appeal stage, the number of possible issues has been so drastically whittled down that it is improper to analogize numbers to the pre-examination context.

The page 63, second paragraph *et seq.* analogy of the proposed Examination Support Document (ESD) to the existing Petition to Make Special (PTMS) practice is also incorrect. The proposed ESD is substantially more burdensome. First, the search and ESD must separately address every claim for which examination is sought. PTMS practice requires only a more broad application and report of "how the claimed subject matter is patentable over the references." Col. 1, fifth paragraph. Second, proposed 35 U.S.C. 1.261(a)(3)-(6) contains substantial additional burdens. Subsection (3) appears to require a full claim chart applying all off the references to all of the limitations of all of the independent/designated claims. This makes the ESD seem like a validity opinion. The requirements in subsections (5) and (6) for statements of the utility of each of the independent claims and identification of the support in specification for every element of every claim for which examination is sought are without cited precedent anywhere in patent practice. Section (b) also appears to present several additional burdens, including searching of disclosed but unclaimed subject matter that “may be claimed.”

In the second column of page 66, the Office asserts that the “proposed rule change will not affect a substantial number of small entities.” In the third column, the Office denies disproportionate impact on small entities. These assertions suffer from similar defects as do those of the continuing applications package.

First, the analysis, in several places, references only the independent claims and does not reference the effect on dependent claims. The cited numbers are misleading. In reporting statistics of applications having more than ten independent claims, the Office ignores how many total claims had to be presented to lead to those independent claims. Thus, the Office failed to consider and report how many cases required the consideration of more than ten claims in order to yield the number of independent claims ultimately presented. By way of example, a patent may have issued with five independent claims. Those independent claims may, however, represent five of twenty (or more) total

claims considered. It may well have been that five or more dependent claims were found patentable while others were not. The five may then have been re-presented in independent form.

Second the reported numbers of 1.3% of small entity filings vs. 1.2% overall does evidence a disproportionate impact.

Third, in a synergy issue between the two packages, the Office also has failed to consider the number of claims considered, in total, in a group of continuing applications or in the initial examination combined with any requests for continued examination. For example, in a case identified as having less than ten independent claims, it may well have been that more than ten independent claims (and a much yet greater number of total claims) were considered, in total amongst continuing applications and requests for continued examination. Thus, the cited numbers understate the effect of the claims package and further understate the combined effect of the claims and continuing applications packages.

Fourth, the Office greatly understates the impact of the ESD. Regarding the cost issue, the first full paragraph of col. 3 cites the 75th percentile charge from the AIPLA Report of the Economic Survey 2003 for a novelty search as being $2,500 and asserted that "pre-filing preparation... should [already] involve obtaining such a patent novelty search..." The additional cost of providing an examination support document would not present "a significant economic impact..." First, there is no basis for asserting that small entities are already, typically, incurring the 75th percentile charge as opposed to a much lower number. Second, as noted above, the substantial burdens of an ESD make it essentially a validity search and opinion (if not more) rather than a novelty search. It is instructive that the 2005 Report identifies the median and 75th percentile fees of a “Validity/Invalidity Only Opinion, per patent” as $10,000 and $18,000. AIPLA Report of the Economic Survey 2005, p. I-101 (the novelty search figure is unchanged relative to 2003). That same report identifies median and 75th percentile fees for a “relatively complex electrical/computer” application as $10,000 and $13,000. Id., p. I-95. Using the 75th percentile numbers, even with a maximum economy of scale, costs will be doubled for an applicant that already does a novelty search: present fees of $2,500 for the search and $13,000 for the application total $15,500 whereas the additional fees for the ESD would also be $15,500 ($18,000 minus the $2,500 if all the novelty search work can be applied to the ESD).

Finally, the retroactivity provisions will require extensive revisiting of applications already filed. The impact of this, generally, has not been discussed. The particular impact on small entities is

also not addressed. For example, the presence or lack of an in-house patent department may be relevant to the cost of retroactivity.

MEANINGFUL ALTERNATIVES AND OPTIONS

Any Requirement for a Showing of Cause for further Filings is Impractical

No form of a showing of cause for continuations and continued examination is likely to be efficient. Although the particular impossibility standard proposed by the Office for further RCEs, continuations, and CIPs illustrates the absurdity of the Office's proposals, even a moderately lower standard would have a deleterious effect on the relationship between practitioners and their clients. A low standard, such as merely providing a showing of a reasonable justification for the filing, would presumably address the rare situations of abuse. However, the burden of processing such showings might be significant. It is perhaps for this paperwork reason that the PTO chose an absurdly high standard. By doing so, the PTO preserves the illusion of reasonable procedures with the unreasonableness of the procedures making them unlikely to be pursued.

Any Substantial Limit on Continuations is also Impractical

As noted above, compromises in the form of raising the allowed number or imposing progressive fees for further filings have no legitimate basis. If the number of affected applications is reduced, the effects on backlog will be reduced to triviality. However, applicants with *bona fide* reasons for further filing will be punished merely for the sake of allowing the Office to punish someone.

Any Substantial Limit on Claims is also Impractical

As noted above, given the uncertainty of the art to be found by the examiner and the vagaries of examiner interpretation of such art, limits on the number of claims will often have the effect of prolonging prosecution. Thus, further limits are believed impractical.

Search/Examination Bifurcation may be Useful

A meaningful bifurcation of search and examination could achieve the key benefits sought by both packages. This might require that the Office actually embrace some concepts of piecemeal examination.

If any procedural options exist for implementing a bifurcated search/examination system, an important role of such a system would be to reduce effort currently expended in preparing the detailed rejections of claims in one or more of several situations. One area involves situations of clear anticipation. The advantages attend not only the elimination of examiner arguments regarding the clearly anticipated claims but also an elimination of arguments regarding claims that may be obvious variations (when such claims are truly obvious variations). Faced with such prior art, an Applicant would be expected to cancel the truly obvious dependent claims and introduce argument regarding other dependent claims.

In an exemplary situation, an applicant could be presented with a reference asserted to anticipate an independent claim. For a truly anticipatory reference, an applicant could be expected to amend or argue only with regard to dependent claims that meaningfully distinguish. For an incidentally anticipatory reference, the applicant might more properly argue for patentability of more of the dependent claims. For an erroneously applied reference, the applicant could argue alone. In fact, the last two situations scream of the appropriateness of an interview that might lead to the allowance of all claims with no amendment or minor amendment to the independent claim

Accordingly, it may be desirable that the search report include at least brief notes regarding any interpretational issues. For example, one note might read: "although claim 1 identifies 'a leg' and the reference discloses 'an arm', the claim term is interpreted broadly so as to encompass the arm of the reference." In this way, the applicant will know that making an argument merely that an arm is not a leg will be insufficient and that the applicant would have to either further amend or accompany the argument with evidence (e.g., a declaration that the examiner’s interpretation is unreasonable and inconsistent with usage in the art). Thus, the applicant would not waste its first opportunity to respond by presenting argument alone.

CONCLUSION

The packages individually, and especially in combination, are wholly misdirected. The packages are based upon a variety of false assumptions. They would be both disadvantageous to patent applicants, generally, and to the relationships between such applicants and their patent practitioner representatives.

Respectfully Submitted,
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