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Sent: Wednesday, May 03, 2006 4:39 PM
To: AB93Comments
Subject: Comments on AB93

<<Grace Bonner PTO Rules response.doc>>

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May 3, 2006

Mail Stop Comments – Patents
Commissioner for Patents
P.O. Box 1450
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Attention: Robert W. Bahr

The following are my personal comments (and not necessarily those of my employer Monsanto Company) to Notices of Proposed Rulemaking: *Changes to Practice for the Examination of Claims In Patent Applications* (Fed Reg. Vol 71 No. 1 page 61, Jan. 3, 2006), and *Changes to Practice for Continuing Applications, Request for Continued Examination Practice, and Applications Claiming Patentably Indistinct Claims,* (Fed Reg Vol 71 No. 1 Page 48, Jan. 3, 2006).

I have been practicing as a registered patent attorney since 1988 and practicing in the biotechnology field since 1993. I believe that the above-referenced proposed rules are detrimental to long-established and judicially sanctioned patent practice, particularly in the field of biotechnology.

I also believe that the proposed rules on continuation practice will exacerbate, rather than correct the current problems at the Patent Office. I urge the Office to carefully and seriously consider the thoughtful comments that have been presented by AIPLA and BIO substantiating these points.

In addition, please consider the following responses and suggestions:

- It is improper and unfair to impose the rules retroactively because currently pending patent applications are overwhelmingly directed to products that are years from commercialization.
- The rationale for the changes is illogical and, arguably, unlawful.
- Cutting patent claims into pieces that are calculated to be readily examined in a common unit of time creates the necessity of filing continuation applications if applicants hope to obtain patents on the full scope of their inventions. It is not uncommon for applicants to be required to elect a single sub group of claims that are divided into 20, 50 and sometimes 100 or more subgroups of allegedly "independent and distinct" inventions by examiners. Especially onerous are restrictions to a single DNA sequence in a family of related genes that provide a common effect.
- The filing of multiple continuation applications is a legitimate business practice in many industries when research and development typically covers a decade or more. As a result, the effective patent term is already about one-half of the statutory term enjoyed by the fast-development and regulatory-free industries.

Restricting the long-standing right to file continuing applications would further reduce the opportunity for the currently limited patent term.

- A pilot study should be conducted in patent examining groups that serve industries that favor the proposed rules.
- If the Director is seriously interested in reducing pendency, alternatives that could benefit applicants, instead of penalizing them, should be investigated, e.g. outsourcing searches at cost to the applicant, formalizing deferred examination and radically changing restriction practice.
- If the PTO is interested in addressing the small number of cases where applicants take advantage of the system to prolong patent prosecution until a competitor commercializes a product that is covered by the patent application, the PTO should find a remedy that does not punish legitimate patent applicants. In the biotechnology sector the need for multiple continuations is a legitimate business practice and should be recognized as such. Reform of current patent enforcement procedures would better address this issue.
- I also understand the proposed rules would limit a priority claim back to a single preceding application this could cause a publication from an earlier application (from which priority cannot be claimed) to be Section 102(b) prior art. Such a situation would effectively negate patentability for unpatented inventions subject to continuing restriction. Preservation of patent rights in applications subject to restriction to hundreds of "independent and distinct" inventions may require filing thousands of divisional applications on potentially valuable inventions. This situation would be extremely costly to applicants and only exacerbate the problem of pendency in the Office.

I urge the Director and Commissioner to study the detailed comments submitted by BIO and AIPLA and reconsider implementation of these proposed rules.

Very truly yours

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GLB/ab