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From: Brient, Scott [mailto:SBrient@alston.com]

Sent: Wednesday, January 04, 2006 9:36 AM

To: AB93Comments

Subject: FW: Federal Register Notice of January 3, 2006 - Proposed Rule Regarding Continuing Applications

<<71fr48.url>> I am writing to comment on the proposed "Changes To Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims". While I agree with the goal of these changes (e.g., to expedite processing of patents applications and reduce backlog within the patent office), I have concerns that the changes: (1) may not produce the intended results; and (2) may be unduly harsh to patentees.

In particular, my sense is that, with enough time and effort, a patentee will almost always be able to come up with some reason as to why some new amendment, argument, or evidence could not have been previously submitted. Accordingly, I don't see this approach as being an effective barrier for preventing long strings of continuation applications - especially in cases where the technology at issue is highly valuable, and legal fees are not an issue for the client. What I would predict is that the proposed rules would add a new layer of bureaucracy (both for the patent office and for patentees) that would most likely increase the patent office's workload, as well as the overall cost of pursuing patent applications for patentees.

In addition, the rules may be unduly harsh to patentees. Please consider, for example, a case in which an Examiner has allowed 15 commercially valuable claims in a first official action for a particular patent application, and has unreasonably rejected 15 other claims. Under current practice, it often makes business sense to a patentee to simply accept the 15 commercially valuable allowed claims, which may result in the patent issuing quickly (perhaps in 2-4 months), and to pursue the rejected claims in a separate, continuation application. Alternatively, due to patent office delays, it may take 3-8 additional months after filing a response to receive a second official action from the patent office (I had one case recently in which it took over a year to receive a second official action). In many cases such a delay may have a huge impact on the patentee's business. Under the proposed rules, it appears the above option of accepting a set of allowed claims in response to a first official action would essentially end, because it would be difficult to argue (at least under these circumstances) that any new amendment, argument, or evidence presented

could not have been previously submitted (e.g., in a response to the first office action).

As another comment, it appears that the practice of issuing multi-part restriction requirements has become quite popular in recent years at the patent office. (We recently received a 40+ way restriction requirement in which the examiner asserted that each claim in an application was directed to a separate invention). On a conceptual level, it seems difficult to reconcile the proposed continuation rule changes with what is perhaps an informal policy among examiners to issue restriction requirements at every possible opportunity. The end result could actually turn out to just be the same number of applications as before - just more divisionals and less continuations.

Best regards,

Scott Brient

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From: Costanza, Kay

Sent: Wednesday, January 04, 2006 7:48 AM

To: GRP-IP-Patents

Subject: Federal Register Notice of January 3, 2006 - Proposed Rule Regarding Continuing Applications

Below is a Summary of this Proposed Rule. If you want to read the whole Federal Register Notice, see the attachment.

Changes To Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims

ACTION: Notice of proposed rule making.

SUMMARY: Continued examination practice, including the use of both continuing applications and requests for continued examination, permits applicants to obtain further examination

and advance an application to final agency action. This practice allow applicants to craft their claims in light of the examiner's evidence and arguments, which in turn may lead to

well-designed claims that give the public notice of precisely what the applicant regards as his or her invention. However, each continued examination filing, whether a continuing application or request for continued examination, requires the United States Patent and Trademark Office (Office) to delay taking up a new application and thus contributes to the

backlog of unexamined applications before the Office. In addition, current practice allows an applicant to generate an unlimited string of continued examination filings from an initial application. In such a string of continued examination filings, the exchange between examiners and applicants becomes less beneficial and suffers from diminishing returns as each of the second and subsequent continuing applications or requests for continued examination in a series is filed. Moreover, the possible issuance of multiple patents arising from such a process tends to defeat the public notice function of patent claims in the initial application. The Office is making every effort to become more efficient, to ensure that the patent application process promotes innovation, and to improve the quality of issued patents. With respect to continued examination practice, the Office is proposing to revise the patent rules of practice to better focus the application process. The revised rules would require that second or subsequent continued examination filings, whether a continuation application, a continuation-in-part application, or a request for continued examination, be supported by a showing as to why the amendment, argument, or evidence presented could not have been previously submitted. It is expected that these rules will make the exchange between examiners and applicants more efficient and effective. The revised rules should also improve the quality of issued patents, making them easier to evaluate, enforce, and litigate. Moreover, under the revised rules patents should issue sooner, thus giving the public a clearer understanding of what is patented. The revised rules would also ease the burden of examining multiple applications that have the same effective filing date, overlapping disclosure, a common inventor, and common assignee by requiring that all patentably indistinct claims in such applications be submitted in a single application.

The changes proposed in this notice will also allow the Office to focus its patent examining resources on new applications instead of multiple continued examination filings that contain amendments or evidence that could have been submitted earlier, and thus allow the Office to reduce the backlog of unexamined applications. This will mean faster and more effective examination for the vast majority of applicants without any additional work on the applicant's part. Additional resources will be devoted to multiple continued examination filings only where necessary.

Comment Deadline Date: To be ensured of consideration, written comments must be received on or before May 3, 2006. No public hearing will be held.

ADDRESSES: Comments should be sent by electronic mail message over the Internet addressed to

AB93Comments@uspto.gov. Comments may also be submitted by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O.Box 1450, Alexandria, VA, 22313-1450, or by facsimile to (571) 273-7735, marked to the attention of Robert W. Bahr. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via the Internet. If comments are submitted by mail, the Office prefers that the comments be submitted on a DOS formatted 3 1/2 inch disk accompanied by a paper copy. Comments may also be sent by electronic mail message over the Internet via the Federal eRulemaking Portal.

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