

-----Original Message-----

From: Dever, Chad [mailto:CDever@CantorColburn.com]

Sent: Wednesday, May 03, 2006 2:50 PM

To: AB93Comments

Subject: Cantor Colburn LLP response to proposed continuation rule change

Dear Under Secretary Dudas,

Please find attached response to the proposed continuation rule change

-Chad Dever

Chad Dever, Ph.D.

Cantor Colburn LLP

55 Griffin Road South

Bloomfield, CT 06002

Phone: 1-860-286-2929 (ext. 1209)

Fax: 1-860-286-0115

e-mail: cdever@cantorcolburn.com



Cantor Colburn LLP

Intellectual Property Attorneys

HARTFORD

55 Griffin Road South
Bloomfield, CT 06002
phone: 860-286-2929
fax: 860-286-0115

DETROIT

201 W. Big Beaver Road
Suite 370
Troy, MI 48084
phone: 248-524-2300
fax: 248-524-2700

ATLANTA

1170 Peachtree Street
Suite 750
Atlanta, GA 30309
phone: 404-607-9991
fax: 404-607-9981

www.cantorcolburn.com

May 3, 2006

Via E-mail and First Class Mail

The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Mail Stop Comments
P.O. Box Comments
Alexandria, VA 22313-1450

Attention: Robert W. Bahr
Senior Patent Attorney
Office of the Deputy Commissioner for
Patent Examination Policy

Dear Under Secretary Dudas:

The following comments are presented in response to the request for public comment by the U.S. Patent and Trademark Office (PTO) concerning the notice of proposed rulemaking related to Continuing Applications, Request for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims, appearing in the Federal Register Vol. 71, No. 1 (71 Fed. Reg. 48) dated Tuesday, January 3, 2006.

We are a law firm specializing in intellectual property law with offices in Hartford, Detroit, and Atlanta. We are aware of the comments submitted by the American Intellectual Property Law Association (AIPLA) on April 24, 2006 in response to the notice of proposed rulemaking listed above and concur with that organization's position on the proposed rules. In particular, we support the PTO's efforts to increase the efficiency and quality of the examination process, but we are concerned that the proposed rules will not achieve these goals, and may significantly adversely affect the scope of protection currently allowed by statute.

Rather than reiterate AIPLA's arguments regarding the proposed rules, we have limited our response to a specific point on which AIPLA did not comment.

According to proposed 37 C.F.R. § 1.114, which is directed to Requests for Continuing Examination (RCE), an applicant may not file more than a single RCE in any application, and may not file any request for continued examination in any continuing application other than a divisional application unless they could make a showing that the amendment, argument, or evidence, could not have been submitted prior to the close of prosecution in the application.

This proposed rule does not address the propriety of filing an RCE upon receipt of foreign search reports and cited art after the close of prosecution. While 37 C.F.R. 1.98(d) states that an information disclosure statement "shall be considered" by the PTO if filed by the applicant after prosecution has closed (provided that certain other requirements are met), it has been our experience that the administrative difficulties associated with recalling the file often necessitates the filing of an RCE in order to have such late-arriving information actually considered. If the proposed rules will not allow filing of an RCE for such late-developed art, the quality of issued patents may be adversely affected.

Applicants and other individuals associated with the filing and prosecution of a patent application have a duty to bring to the attention of the Office any material prior art or other information cited or brought to their attention in any related foreign application. *MPEP* 2001.06(a), Eighth Edition (2006). There is no requirement that applicants conduct a prior art search. However, even with the most careful and thorough prior art search, foreign patent offices will often cite references not previously identified by the applicant or examiner as relevant to patentability. Such search reports often appear after a final action on the merits, the mailing of a notice of allowance, or even after payment of the issue fee.

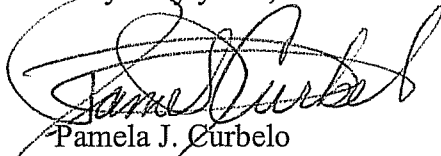
Even when such late-arriving art is promptly submitted, we have found that delays presently inherent in the administrative process often prevent consideration of the art, and that the only way to guarantee such consideration is by the filing of an RCE. For applications with corresponding national phase filings in more than ten countries, it is sometimes necessary to file several sequential Requests for Continued Examination in order to have all foreign-cited art considered. The proposed limit on the number of Requests for Continued Examination accordingly places an unfair burden on applicants making numerous national phase filings, and may compromise the quality of the issued patent.

We recognize that repeated examination of an application, particularly after issuance of a notice of allowance, places a burden on the resources of the PTO. However, rather than a strict limit on the number of Requests for Continued Examination as a matter of right, we submit that an increased fee schedule for each additional RCE filed after the issuance of a notice of allowance would be an appropriate remedy. An increased fee would create sufficient incentive for patent practitioners to avoid making unnecessary requests for continued examination,

and would properly place the financial burden only on applicants whose multiple requests for continued examination after a notice of allowance are necessitated by multiple foreign search reports.

We appreciate the opportunity to provide comment on the proposed rules as well as this Office's consideration of our response.

Very truly yours,



Pamela J. Curbelo
for Cantor Colburn LLP