

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

From: dcrisman@morganlewis.com [mailto:dcrisman@morganlewis.com]

Sent: Mon 5/1/2006 12:54 PM

To: AB93Comments

Cc: Gary Williams

Subject: Comments on Proposed Rule Making AB93

To the Commissioner of Patents,

The attached comments address the Proposed Rule Making published in the Federal Register, Vol. 71, No. 1, Tuesday, January 3, 2006 and identified therein as follows:

37 CFR Part 1

[Docket No.: 2005-P-066]

RIN 0651-AB93

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

Regards,

Douglas Crisman, Reg. 39,951, and

Gary S. Williams, Reg. 31,066

Comment Concerning Proposed Rule Making RIN 0651-AB93
May 1, 2006

Department of Commerce
Patent and Trademark Office
37 CFR Part 1

Comments by
Douglas Crisman, Reg. 39,951, and
Gary S. Williams, Reg. 31,066

Brief Summary of Recommendation:

Replace the proposed rule changes with rule changes that are more narrowly focused on applications that exhibit objective indicia of bad faith in prosecution.

Comments on Statutory Mandates as they relate to Continuation Applications

35 U.S.C. 131

Title 35 mandates that the USPTO examine patent applications and issue patents on inventions that meet the substantive requirements of novelty and non-obviousness (as set forth in sections 102 and 103), as well as the written description requirements of 35 U.S.C. 112. See 35 U.S.C. 131.

35 U.S.C. 131 Examination of application.

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor. (emphasis added)

Rules that prevent inventors from obtaining patents on inventions that meet the substantive requirements of novelty, non-obviousness and written description must be consistent with the "entitled to a patent under the law" requirement of 35 U.S.C. 131. Stated in another way, the rules promulgated by the USPTO must enable inventors to obtain patents on every patent application whose claims are directed to an invention that meets the substantive requirements for patenting, which is timely filed, and which is prosecuted in a manner consistent with good faith adherence to the law and rules.

Many of our most important inventions are complex inventions, groups of inventions or "visionary" inventions, bringing together multiple improvements or inventions to produce a new product or process. These inventions typically require the filing of multiple patent applications. For reasons that include economic efficiency as well as satisfaction of the enablement and best mode requirements of 35 U.S.C. 112, it is common for such applications to either have identical specifications that describe multiple inventions, or to have large portions that are identical. In addition, the very nature of team efforts to develop complex inventions results in the presence of one or more common inventors in multiple applications.

The combined effect of the proposed changes to rules 1.75, 1.78 and 1.114 will be to prevent the effective protection of many such inventions. Proposed rule 1.78(f) creates a presumption that groups of applications filed on the same date, or having the same priority date, with substantially the same specifications, contain patentably indistinct claims, and furthermore requires that such claims be confined to a single application. However, the proposed changes to rule 1.75 limits substantive examination of an application to ten designated claims, unless the applicant is willing to make the admissions against interest required by proposed rule 1.261. As a result, claims directed to distinct inventions, but filed in such a group of applications will be presumed to be patentably indistinct, and the requirement that all such claims be confined to one application will effectively require the applicant to forgo protection of many of these inventions. Added on top of this, the applicant will be unable to pursue applications on the distinct inventions through the filing of continuation applications due to the restrictions imposed by proposed rule 1.78(d).

35 U.S.C. 120

35 U.S.C. 120 requires that any patent application be granted an effective filing date of its parent application "if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application."

35 U.S.C. 120 Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

First Generation Continuation Applications

The first portion of the phrase from section 120 quoted above applies to all patent applications that are filed during the pendency of a first application and that contain a specific reference to the first application. These may be called "first generation continuation applications."

The "shall have the same effect" language in section 120 is a mandate. Section 120 mandates that applications filed during the pendency of a parent application and that explicitly claim priority to the parent application shall have the same effect as though filed on the date of the parent application.

The only qualification of this mandate concerns applications that do not contain a specific reference to the earlier filed application at the time the application is filed. This portion of section 120 reads as follows:

No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

There is no authorization in section 120, or elsewhere in Title 35, to limit claims of priority in patent applications, except with respect to the timeliness with which such claims are submitted.

Good Faith in Prosecution

The introductory portion of the AB-93 Notice of Proposed Rule Making states that "applicants face a general requirement of good faith in prosecution." It is submitted that the filing of multiple first generation continuation applications cannot be presumed to be bad faith prosecution, because such applications cannot be used to delay prosecution. Stated differently, first generation continuation applications, regardless of their number, fall outside the scope of the *In re Bogese* decisions. While filing a truly excessive number of first generation continuation applications (e.g., a large number of applications that all contain patentably indistinct claims) might amount to bad faith, the commenter doubts that this has occurred sufficiently often to warrant the issuance of the currently proposed rule changes.

Similarly, the simultaneous filing of multiple applications having at least one common inventor and specifications that have identical portions, cannot be presumed to be bad faith prosecution, because the simultaneous filing of such applications cannot be used to delay prosecution. To the contrary, the most common reason for simultaneous filings of multiple applications is entirely appropriate: the multiple applications are directed to multiple distinct inventions, all of which relate to the same product, service or the same group of products or services.

Furthermore, the standard of proof required in the proposed rules "that the amendment, argument or evidence could not have been submitted during the prosecution of the initial application or the first continuing application" makes little sense when the object of the continuation applications is to obtain patents on distinct inventions. Each patent application is, both by law and regulation, to be directed to a single invention. Patent applications directed to multiple inventions are subject to restriction, per 35 U.S.C. 121. Therefore filing multiple applications to claim multiple inventions is actually evidence of good faith compliance with the "one invention per application" requirements of Title 35, regardless of whether those applications are filed simultaneously or as continuations of a parent application.

Summary. We recommend replacing the proposed rule changes with rule changes that are more narrowly focused on applications that exhibit objective indicia of bad faith in prosecution (e.g., patent applications containing patentably indistinct claims with respect to other applications in the same patent application family).