

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

From: Mark Harrington [mailto:mharrington@hspatent.com]

Sent: Wednesday, January 04, 2006 11:12 AM

To: AB93Comments

Subject: Comments on Proposed Changes to Practice

Dear Sirs:

This is in response to the 1/3/2006 Notice of proposed rule making "Changes To Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims".

As a patent practitioner with over 20 years of experience, I want to ask: Who was the [BEEP] that proposed this rule change? If you wanted to make patent practitioners angry, you have succeeded. If you attempt to make this proposed rule change final, we will go to Congress to have it changed.

Whoever proposed the rule change fails to realize that patent examiners are not perfect; especially new patent examiners who are very inexperienced (supervisory examiners are often times overworked and cannot catch everything). It is not just patent practitioners that cause RCEs to be filed; it also is because of inexperienced examiners (and sometimes examiners who simply do an initially poor job). RCEs are often filed merely to give the examiner another chance to understand a claimed invention better, or fine tune claim language before an appeal is filed; perhaps even adding whole new sets of claims because of newly discovered art. Only about 5% of office actions are first office action allowances. This should tell you something.

Rarely do I ever have to file more than one RCE. However, I do file continuations and continuation-in-part applications quite often to get better claims based upon the client's actual product (most patent applications are filed before an actual product is finalized). Continuations and continuation-in-part applications allow the ability to protect an actual product.

Your proposed rule will increase filings of appeals. Are you ready to handle the new volume of appeals which will be filed? How are you going to handle filings of RCEs and continuations and CIPs after appeal? (from the BPAI ?, from the CAFC?)

What is to prevent someone from filing a continuing application and merely calling it a "divisional" when in fact it might be considered a "continuation"? The guidelines you propose for defining a "divisional" versus a "continuation" are amateurish at best. Do patent practitioners now need to file hundreds of claims in order to get restriction requirements based upon disclosed subject matter rather than claimed subject matter?

Are you going to establish special rules for "pro se" applicants who are not admitted patent agents or patent attorneys? Isn't your proposed rule unfair to "pro se" applicants?

The proposed rule making appears to have been proposed by a "bureaucratic paper pusher" rather than someone familiar with the give and take between examiners and applicants' attorneys/agents; and the inherent complexities of dealing with the English language. "Efficiency" of the USPTO should not be used as an excuse for failing to give an applicant a full and fair examination. Not every examination is the same. Some take longer than others. It seems unfair to penalized cases which take a longer to examine by imposing additional bureaucratic showing requirements on the applicants.

Sometimes applicants are unsatisfied with their attorney/agent's work. Applicants change attorney/agent to address this problem. Wouldn't it penalize applicants' new attorney/agent by not allowing him/her to file an RCE/continuation? Is change of attorney/agent sufficient to allow a third or subsequent RCE/continuation to be filed? Isn't this going to promote "attorney/agent skipping around" to get around your attempted number limitation?

Examiners can issue as many office actions as they like (I have had cases where the examiner has issued 5 or more office actions before I had to file an RCE/appeal). Isn't it inequitable to impose number limitations on applicants, but not the same limitations on examiners? The MPEP rule for a second office action to be "final" is often reversed because of it being "premature".

What appeal procedures will be in place if a RCE/continuation/CIP is denied filing by the USPTO?

Why are CIPs included? They have new matter and should not be considered the same as an RCE or continuation.

You are requested to reconsider your proposed rule changes.

Mark F. Harrington
Harrington & Smith, LLP
4 Research Drive
Shelton, CT 06484-6212
USA
Telephone: 203-925-9400
Facsimile: 203-944-0245
Email: MHarrington@HSpatent.com