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From: Ann McCrackin [mailto:AMcCrackin@slwk.com]

Sent: Wednesday, May 03, 2006 8:49 PM

To: AB93Comments

Subject: Comments on Proposed Changes to Continuation Practice

Please see the attached letter for comments on the Proposed Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims, Notice of proposed rulemaking (03 Jan 2006). If you have any problems opening the attachment, please call 612-373-6900.

Thank you,  
Ann McCrackin

SCHWEGMAN ■ LUNDBERG ■ WOESSNER ■ KLUTH

Intellectual Property Attorneys

PATENT PROTECTION FOR HIGH TECHNOLOGY

May 3, 2006

Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

*VIA E-MAIL TO [AB93Comments@uspto.gov](mailto:AB93Comments@uspto.gov)*

Dear Commissioner Doll:

The following comments are in response to the United States Patent & Trademark Office's Notice of proposed rule making entitled "Changes to Practice for Continuing Applications . . ." published on January 3, 2006, at 71 Fed. Reg. 48. These comments do not necessarily represent the opinions of other members of our firm or our firm's clients.


We support the spirit of the proposed regulation of continuation applications because we think that wasteful patent litigation needs to be reduced. The presence of continuations inhibits resolution of patent disputes through negotiations. Today, if a patentee has continuations still pending for a patent that it has asserted, the accused infringer cannot explain its non-infringement defense because the patentee will merely re-write its claims in a continuation application. At that point, the patentee's only solution is to sue when in fact the lawsuit may be misguided. By requiring that later continued examination filings be shown to be necessary, the proposed rules will eliminate continuations merely being filed to cover products unknown at the time of the prosecution of the original application. Greater legal certainty to negotiations between patent holders and others will result from the elimination of the not uncommon practice of a perpetual, unnecessarily delayed stream of continued examination filings. We approve of the greater legal certainty in licensing negotiations that will result from the Office preventing unnecessary delay during prosecution.

We think that there are good practical and policy reasons behind the proposed regulation of continuation applications. We recommend that the Office enact the proposed rules; however, we suggest the following revisions:

- Allow a limited number of additional continuation applications to be filed but implement filing fees for such additional continuations that are large enough to discourage filings except for compelling reasons.
- Allow additional continuation-in-part applications to be filed for a limited time period (such as within 1 year of the original application's filing date.)
- Allow unlimited RCEs within a 3-year time period of the original filing date if prosecution of the original application is accelerated by filing a petition to make special.
- Allow additional RCEs for purposes of citing art from foreign search reports or office actions in related applications.
- Automatically publish appealed claims without charge to the Applicant.
- Refund 80% of the filing fee for claims that are not examined in an application because the claims are withdrawn in response to a restriction requirement.
- Permit the filing of one continuing application after a PCT application has been filed in the US under 35 U.S.C. §111 and §120 (the "bypass route") so that the "bypass" applications are treated the same as National Stage applications filed 35 U.S.C. § 371.

Thank you for consideration of these comments.

Respectfully submitted,



Steven W. Lundberg



Ann M. McCrackin