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Sent: Wednesday, May 03, 2006 11:11 AM

To: AB93Comments

Subject: Proposal regarding CONTINUATION PRACRICE

The attached proposal is my personal statement and is not to be attributed to any other practitioner or to any law firm. It was also submitted to a working group of the Boston Patent Law Association, and is being submitted in abbreviated form by that working group.

Joseph B. Milstein

Proposal to reduce USPTO workload – Joseph B. Milstein

This proposal may require a change in the law, which would have to be passed by Congress.

It is apparent that one of the motivations for the recently proposed changes in patent continuation practice is a reduction in workload for the USPTO. This can be accomplished without negatively impacting the rights of inventors or of the public as is outlined in the following proposed changes.

1. Currently, the patent fee structure has been changed to three fees due upon filing an application, including a filing fee, a search fee and an examination fee. These three fees are due for any of utility applications, design applications, and plant applications.
2. There is therefore already a legal basis for changing the fees and the activities of the USPTO as follows:
3. At filing, only the filing fee is due.
4. The publication fee is due before the 18th month, and the patent application is published (and becomes 102(b) art).
5. Until the search fee and the examination fee are paid, no search and no examination are to be conducted. As indicated below, an applicant can delay exam for an indeterminate period. Delaying the search and examination of some portion of filed applications will clearly reduce the workload of the USPTO.
6. Change the maintenance fee structure as follows: 4th year, 8th year and 12th year maintenance fees shall be due based on the filing date, rather than the issue date. This requires a change in the law, and will work cooperatively with the other changes proposed to reduce the work load of the USPTO. As now, failure to timely pay the maintenance fee will result in the abandonment of the application.
7. Upon payment of the search fee, a prior art search is performed. The examination fee need not be paid until the result of the search is known. The search can be carried out in more depth and using more extensive data bases than has been the common practice of the USPTO in the past. The search results become part of the public record of the patent prosecution, e.g., is listed on PAIR as a workpaper. A more thorough and careful search will help the applicant determine what economic value an issued patent may provide.
8. Upon payment of the examination fee, a substantive examination is performed. The examination fee might be raised to a significant amount such as \$2,500 or \$5,000 to provide funding for a more deliberate examination of an application, rather than measuring productivity of an examiner against a specified number of dispositions per quarter. More deliberate examination will provide higher-quality issued patents, and will reduce the necessity for filing RCE or continuation applications to force amendments into an application where an examiner is being unnecessarily restrictive by failing to enter *bona fide* amendments offered after a final rejection.

This proposal will allow inventors who want their patent application to be examined immediately to pay the examination fee at filing. It is believed that in general, those inventors who believe that there is immediate economic value to the patent if issued will immediately pay such fees. Those who want to better understand the economic value of an issued patent, including a review of potential available claim scope, can delay examination and the associated expense.

The work load of the USPTO will be reduced because there are a portion of applications that are filed without a clear concept of the economic value of the application at filing. If there is no reason to believe that the application needs to mature into a patent, the applicant under the present situation has a choice of either abandoning the application at the first office action or obtaining a patent of unclear value with the associated expenses. Under the proposal, some fraction of patent applications will remain unexamined until their economic merit is clear.

The work load of the USPTO will also be reduced because a more deliberate examination will obviate some of the present common situation of repeated communications between an examiner and an applicant or the applicants attorney/agent based on the results of a less deliberate examination.

The collected maintenance fees can be used to support the activities of the USPTO. The collection of maintenance fees for an unexamined application will also serve to prod an inventor to make a determination as to whether the application is worth the continuing cost. Some applications will become abandoned when the inventor determines that there is not likely to be economic merit in actually obtaining a patent, or when the search results provided by a more in depth search indicate that the scope of obtainable claims is narrow.

It is also believed that a more careful and deliberate examination process will help to eliminate some of the restriction requirements that have become more common of late. It appears that examiners are using restriction requirements to accomplish either or both of: reducing the effort required to examine an application if there are fewer claims pending; and augmenting the numbers of related applications that they are handling so as to increase their total number of dispositions without having to study a new application from the beginning. If the metric for evaluating productivity is changed from the present disposition count, the incentives to issue restriction requirements will be eliminated.